93-862

No. 93-___

Supreme Court, U.S.
FILED
NOV 30 1993
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IN THE
Supreme Court of the United States
OCTOBER TERM, 1993

BELLSOUTH ADVERTISING
& PUBLISHING CORPORATION,
Petitioner,

v.

DONNELLEY INFORMATION PUBLISHING, INC., and
THE REUBEN H. DONNELLEY CORPORATION,
Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

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PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Whether the court below erred in concluding that the selection, coordination, and arrangement of the headings and the listings under those headings in a yellow pages directory are not sufficiently creative to qualify for copyright protection, so that a rival publisher does not violate the registered copyright in the yellow pages when it engages in wholesale copying of that compilation, rather than use more current listings made available to it by the telephone company.

PARTIES TO THE PROCEEDING

Petitioner BellSouth Advertising & Publishing Corporation was plaintiff, counterclaim defendant, and appellee below. Respondents Donnelley Information Publishing, Inc., and The Reuben H. Donnelley Corporation were defendants, counterclaim plaintiffs, and appellants below.

Pursuant to this Court's Rule 29.1, petitioner notes that its parent is BellSouth Corporation. A list of BellSouth Corporation's non-wholly-owned subsidiaries appears at App. 115a.

TABLE OF CONTENTS

	Page
QUESTION PRESENTED	i
PARTIES TO THE PROCEEDING	ii
TABLE OF AUTHORITIES	v
OPINIONS BELOW	1
JURISDICTION	2
PERTINENT CONSTITUTIONAL AND STATUTORY PROVISIONS	2
STATEMENT OF THE CASE	3
REASONS FOR GRANTING THE WRIT	11
I. THE DECISION BELOW CONFLICTS WITH A RECENT DECISION OF THE SECOND CIRCUIT	12
II. THE DECISION BELOW IS CONTRARY TO THIS COURT'S DECISION IN *FEIST*	16
III. THE INTERPRETATION OF *FEIST* BY THE COURT BELOW CONFLICTS WITH THAT OF OTHER CIRCUITS	21
IV. THE QUESTION PRESENTED IS IMPORTANT AND RECURRING	28
CONCLUSION	30
APPENDICES	
Appendix A: En Banc Opinion of the Court of Appeals	1a
Appendix B: Panel Opinion of the Court of Appeals	52a

TABLE OF CONTENTS—Continued

		Page
Appendix C:	District Court Opinion	68a
Appendix D:	Order Granting Rehearing En Banc	107a
Appendix E:	District Court Injunction	109a
Appendix F:	Pertinent Constitutional and Statutory Provisions	113a
Appendix G:	Rule 29.1 Statement	115a

TABLE OF AUTHORITIES

Cases Page

Atari Games Corp. v. *Oman*, 979 F.2d 242 (D.C. Cir. 1992) 15, 22-24, 29
Feist Publications, Inc. v. *Rural Telephone Service Co.*, 499 U.S. 340, 111 S. Ct. 1282 (1991) ..... *passim*
Harper House, Inc. v. *Thomas Nelson, Inc.*, 1993 WL 346546 (9th Cir. Sept. 10, 1993), *prior opinion*, 889 F.2d 197 (9th Cir. 1989) 24-25
Key Publications, Inc. v. *Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991) ..... *passim*
Kregos v. *Associated Press*, 937 F.2d 700 (2d Cir. 1991), *on remand*, 795 F. Supp. 1325 (S.D.N.Y. 1992), *aff'd*, 3 F.3d 656 (2d Cir. 1993) 23, 24
Los Angeles News Service v. *Tullo*, 973 F.2d 791 (9th Cir. 1992) 26
Mason v. *Montgomery Data, Inc.*, 967 F.2d 135 (5th Cir. 1992) 26
Nester's Map & Guide Corp. v. *Hagstrom Map Co.*, 796 F. Supp. 729 (E.D.N.Y. 1992) 26
Penelope v. *Brown*, 792 F. Supp. 132 (D. Mass. 1992) 26

Constitutional and Statutory Provisions

U.S. Const. art. I, sec. 8, cl. 8 2
17 U.S.C. § 101 ..... 2, 18, 20, 21
28 U.S.C. § 1254(1) 2
28 U.S.C. § 1291 2
28 U.S.C. § 1292(a)(1) 2
28 U.S.C. § 1331 2

Other

Abrams, Howard B., *Originality and Creativity in Copyright Law*, 55 Law & Contemp. Probs. (1992) 27
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TABLE OF AUTHORITIES—Continued

Page

McDonald, John P., *The Search for Certainty*, 17 U. Dayton L. Rev. 521 (1992) 27

Miller, Philip H., *Life After* Feist: *The First Amendment and Copyright Status of Automated Databases*, 60 Fordham L. Rev. 507 (1991) 27

Oman, Ralph, Register of Copyrights, *Reflections on the Changing Shape of Database Protection*, 40 Fed. Bar News & J. 232 (1993) 27

VerSteeg, Russ, *Rethinking Originality*, 34 Wm. & Mary L. Rev. 801 (1993) 27

Wolf, David B., *Is There Any Copyright Protection for Maps After* Feist?, 39 J. Copyright Soc'y USA 224 (1992) 26

Yen, Alfred C., *The Legacy of* Feist: *Consequences of the Weak Connection Between Copyright and the Economics of Public Goods*, 52 Ohio St. L. J. 1343 (1991) 27

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Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

PETITION FOR A WRIT OF CERTIORARI

Petitioner BellSouth Advertising & Publishing Corporation respectfully prays that a writ of certiorari issue to review the judgment and opinion of the en banc United States Court of Appeals for the Eleventh Circuit entered in the above captioned case on September 2, 1993.

OPINIONS BELOW

The en banc opinion of the United States Court of Appeals for the Eleventh Circuit is reported at 999 F.2d 1436 and is reprinted in the appendix hereto ("App.") at 1a.[1] The panel opinion reversed by the en banc court

[1] The appendices to the majority opinion could not be reproduced in legible fashion for inclusion in the petition. Pursuant to guidance from the Clerk's Office of this Court, the exhibits constituting the appendices to the opinions have been lodged with the Clerk.

is reported at 933 F.2d 952 and is reprinted at App. 52a. The opinion of the United States District Court for the Southern District of Florida is reported at 719 F. Supp. 1551 and is reprinted at App. 68a.

JURISDICTION

Petitioner BellSouth Advertising & Publishing Corporation initiated this case by filing a complaint for copyright infringement, trademark infringement, and unfair competition against respondents in the United States District Court for the Southern District of Florida on October 2, 1985. Jurisdiction was based on 28 U.S.C. § 1331. The District Court granted summary judgment for petitioner on its copyright claim on October 27, 1988, App. 68a, and on January 5, 1989, entered a negotiated injunction barring infringement by respondents. *Id.* at 109a.

Respondents filed a timely notice of appeal from the injunction, basing jurisdiction in the Court of Appeals for the Eleventh Circuit on 28 U.S.C. §§ 1291, 1292 (a)(1). That court affirmed the district court judgment on June 18, 1991. App. 52a. Seventeen months later, on November 4, 1992, the Court of Appeals granted respondents' suggestion for rehearing en banc. *Id.* at 107a. On September 2, 1993, the en banc court overturned the panel decision and reversed the district court judgment. *Id.* at 1a. Judge Hatchett filed a dissenting opinion. *Id.* at 19a.

The jurisdiction of this Court to review the judgment below is based on 28 U.S.C. § 1254(1).

PERTINENT CONSTITUTIONAL AND STATUTORY PROVISIONS

Article I, section 8, clause 8 of the United States Constitution, and the pertinent provisions of the Copyright Act of 1976, 17 U.S.C. §§ 101 *et seq.*, are set forth at App. 113a-114a.

STATEMENT OF THE CASE

Petitioner BellSouth Advertising & Publishing Corporation ("BAPCO"), a subsidiary of BellSouth Corporation, is the world's largest publisher of classified business directories, creating and distributing more than 44 million directories in 550 different editions annually. The issue in this case is whether respondents' admitted acts of copying BAPCO's 1984 Miami Yellow Pages directory infringed BAPCO's copyright in the directory. In deciding that these acts did not constitute infringement, the court below concluded that yellow pages publishers are not entitled to copyright protection for their selection, coordination, and arrangement of business listings under the classified headings they select for their directories, because the resulting compilation lacks the minimal degree of creativity necessary to qualify for copyright protection.

1. *Creation of BAPCO's Directory*

BAPCO produced the Miami Yellow Pages—"a typical yellow pages directory," App. 2a—in the same manner it produces its other yellow pages directories. First, Southern Bell, the local telephone service provider, transmits telephone service information to BAPCO. The information includes a business subscriber's name, telephone number, and address. *Id.* at 70a & n.4, 80a. In some cases the information also includes one business classification for the subscriber, but often—40 percent of the time in the case of the 1984 Miami Yellow Pages—no such classification is provided. Those classifications that are furnished often prove to be incorrect and have to be changed by BAPCO. Affidavit of Bob P. Johnson ("Johnson Aff."), at 2.

A number of editorial judgments by BAPCO guide the development of its directory. First, BAPCO limits listings to businesses using business telephone service. App. 80a. Many businesses, particularly service-oriented ones, oper-

ate out of a home and use residential telephone service for business needs. Many other publishers, such as the respondent in this case, will include listings for such businesses in their directories. BAPCO does not, based on its judgment that (1) businesses using merely residential service do not evince a sufficient commitment to remaining in the marketplace, and (2) the presence of obsolete entries in the directory contributes to user dissatisfaction.

A second editorial judgment affecting the compilation of BAPCO's yellow pages is its decision to provide one free listing for every business with business telephone service, but to insist on payment for additional listings under other categories ("Hair Stylist" as well as "Barber") or within the same category under a different name ("T. Jones Warehouse" as well as "Jones, T., Warehouse"). Johnson Aff., at 2, 4. Other publishers, such as the respondent in this case, offer more than one free listing, and prior to 1950 Southern Bell offered no free listings in its yellow pages.

BAPCO next decides on the geographic scope of each particular yellow pages directory.[2] This decision has two components: a determination of the general geographic boundaries of the directory, and judgments about which businesses outside those boundaries should nonetheless be contacted for possible inclusion. The scope of BAPCO's yellow pages directories—unlike that of a white pages directory—turns on BAPCO's evaluation of shopping patterns, and does not correspond to and is not dictated by the accompanying white pages.

After the general scope of a directory is established, BAPCO personnel make decisions about contacting certain businesses outside that area for possible inclusion. For example, in compiling the 1984 Miami Yellow Pages, BAPCO decided to contact certain businesses located out-

[2] The service information provided to BAPCO by Southern Bell is not sorted by geographical area. App. 80a.

side the Miami directory area—typically in Hollywood or Ft. Lauderdale—for inclusion in the Miami directory. Only selected businesses in such outlying areas were contacted. Sales people may, for example, call upon a swimming pool contractor located 30 miles outside the Miami area, reasoning that such a business might be interested in customers that far away, but would not call upon a shoe store next-door to the swimming pool contractor, judging it unlikely that such a listing would be useful to the store owner or consumers in the Miami area. The Miami Yellow Pages contained no fewer than 1,772 such listings from selected businesses outside the general geographic scope of the directory. *See* Johnson Aff., at 10-11. BAPCO also made the decision to solicit listings from national advertisers (*e.g.*, Hertz or American Airlines) for inclusion in specific directories. The Miami Yellow Pages contained 2,215 such listings. *Id.* at 11. Not all yellow pages directories include such national advertising.

BAPCO then determines the headings that will be used in its directory, from the familiar ("Attorneys") to the obscure ("Juice Extractors"). It also determines the subheadings to be included (*e.g.*, "Automobile, Plate, Window," "Beveled, Carved, Ornamental" and "Block—Structural" under "Glass"). BAPCO has developed a "Heading Book" which it uses in its publication efforts, *id.* at 7, but not all headings in the Heading Book are made available in every BAPCO yellow pages. BAPCO's list of appropriate headings is continually evolving, with hundreds of additions and deletions occurring each year after review by BAPCO's Heading Committee. Continuous revision is necessary because too many or too few headings would make the book less useful to the consumer and advertiser. Only BAPCO decides how many and which headings to offer in a particular BAPCO directory.

BAPCO's next step in compiling a yellow pages directory is to coordinate particular business listings with an appropriate heading classification or classifications. In

undertaking this task, BAPCO initially determines which businesses to contact and in which manner. BAPCO selects some businesses to be visited on their premises, others to be telephoned, and some not to be contacted at all. *Id.* at 5-6.

When contacting a business concerning its listings in the yellow pages, BAPCO personnel use their experience and expertise to develop with the customer a strategy for advertising through the yellow pages. *See id.* at 7-9. The decision on how to list a particular enterprise is seldom a mechanical one, instead involving judgments among related but quite distinct categories. It may well be unclear whether to list a particular business under "Grocers," "Delicatessens," or "Gourmet Shops," another under "Restaurants," "Sandwiches," or "Foods-Carryout," and yet another under "Loans," "Mortgages," or "Financial Planning." Using the authorized headings for the particular directory from the Heading Book and their accumulated experience, BAPCO personnel discuss additional listings with the customer. A business appearing under "Books" in its one free listing may be encouraged, if appropriate, to purchase an additional listing under "Magazines". A business appearing only under "Rental" may be alerted to the advantages of placing an additional listing under "Tents", if the BAPCO representative believes that tent rentals form or could form a significant part of that particular rental store's business.

In compiling its yellow pages BAPCO adheres to rules it has devised to ensure the integrity of the directory for its users. For example, businesses selling balloons often want to be listed under "Florists," in an effort to attract customers who might send a bouquet of balloons rather than flowers. A carryout sandwich shop may want to appear under "Pizza," in the hopes of attracting customers more interested in the fact that the food is take-out rather than of any particular variety. Even though a customer may request such an appearance, BAPCO policies do not

permit such practices, because they would cause confusion and reduce the utility of the directory. *See* 5SR-Tr. of Oct. 1985 Prel. Inj. Hearing, at 133-134.

The cumulated results of the foregoing decisions by BAPCO and the thousands of sales calls by BAPCO personnel on the businesses selected by them are then compiled and arranged to create a specific yellow pages directory.

2. *Copying of the Directory by Donnelley*

After release of the 1984 Miami Yellow Pages directory, respondents (collectively "Donnelley") undertook to publish their own directory in Miami. Although Donnelley had obtained a list of all business telephone subscribers from Southern Bell pursuant to a licensing agreement, App. at 71a—a list more current than the listings in BAPCO's 1984 directory—Donnelley did not rely on that list in launching its effort. Instead, it obtained a copy of BAPCO's copyrighted directory and, employing a data entry company, "keyed" the directory into a computer database. A keypunch operator input into a computer every listing in BAPCO's directory by name, address, telephone number, and classified heading code. *Id.* at 82a. The data base resulting from this activity was a copy of the BAPCO directory, excluding graphic advertising, in machine readable form. The computer then generated from this database what are known as "sales lead sheets". These sales lead sheets reproduced the keyed material from the BAPCO directory—every name, address, telephone number, and corresponding classified heading—arranged by telephone number. *Id.* at 3a, 83a. The sales lead sheets were used by Donnelley to solicit advertising for its directory, and the material from the database was used in the publication of the Donnelley directory. *Id.* at 3a-4a.

3. *The Proceedings Below*

BAPCO filed suit against Donnelley for, *inter alia*, copyright infringement, and the District Court granted

summary judgment in favor of BAPCO on its copyright claim. The court concluded that "BAPCO has created a unique directory due to its method of selecting, coordinating and arranging its material" and that "BAPCO's compilation is an original work of authorship which is subject to a valid copyright." *Id.* at 81a (footnote omitted). Noting that "Donnelley has offered no evidence to refute the fact that it copied BAPCO's directory," *id.* at 83a-84a, the District Court found Donnelley liable for three acts of copying: keying the material from BAPCO's directory into the computer, generating the sales lead sheets, and publishing the Donnelley directories. *Id.* at 84a.

Donnelley appealed to the Court of Appeals for the Eleventh Circuit, and a unanimous panel of that court affirmed. *Id.* at 52a. The panel considered the case in light of this Court's decision in *Feist Publications, Inc.* v. *Rural Telephone Service Co.*, 499 U.S. 340, 111 S. Ct. 1282 (1991). In that case this Court determined that a telephone white pages directory was not entitled to copyright protection, because no creativity went into the selection of which listings to include in that directory (all subscribers) or how to arrange them (alphabetically). *Id.* at 1295-97. The panel below concluded that "[t]he format of the Yellow Pages before us is sufficiently distinct from the 'white pages' phone directory involved in *Feist* to meet the minimal level of independent creativity required to qualify as original." App. 59a. As the panel explained:

> If Donnelley had been interested only in the *information* contained in the directory, they could have extracted all the information that they needed from the list furnished to them by Southern Bell. Instead, Donnelley copied the formatted information from the Yellow Pages because they were interested in the format and organization of the information in the Yellow pages which was authored by BAPCO. [*Id.* at 62a.]

After rehearing en banc, the Eleventh Circuit overturned the unanimous panel opinion.[3] Writing for the majority, Judge Birch rejected the District Court's conclusion that BAPCO showed originality in selecting the scope for its directory, and concluded that the various acts of selection that the District Court and panel had found to be original were "not acts of authorship, but techniques for the discovery of facts." *Id.* at 8a. According to the majority, BAPCO simply "discovered" how businesses wished to be listed, and such activity was not protected by the Copyright Act. *Id.* at 8a-9a.

The en banc Eleventh Circuit ruled that BAPCO's coordination and arrangement of the particular listings under its selected headings also failed to exhibit the requisite degree of creativity, because this general structure "did not deviate from the arrangement of the typical business directory." *Id.* at 10a n.13. The majority further concluded that Donnelley had not copied the particular heading structure used by BAPCO, but instead "determine[ed] the type of business of each subscriber by observation of the BAPCO directory and translat[ed] that business type into an encoded heading of its own creation." *Id.* at 13a. The court also found that the selection of particular headings did not constitute original expression warranting copyright protection. *Id.* at 14a.

Judge Hatchett dissented. He began by noting that the majority's decision "establishes a rule of law that transforms the multi-billion dollar classified publishing industry from a business requiring the production of a useful di-

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[3] Due to recusals, only seven of the eleven Eleventh Circuit judges participated in the rehearing en banc. In addition, because the author of the panel opinion—Senior Circuit Judge Edward S. Smith—was a visiting judge from the Federal Circuit, and because another panel member—Circuit Judge Frank Johnson—took senior status while the suggestion for rehearing en banc was pending, only one of the three panel members participated in the rehearing en banc.

rectory based on multiple layers of creative decision-making, into a business requiring no more than a successful race to a data processing agency to copy another publisher's copyrighted work-product." *Id.* at 19a. He noted that the majority reached this "incredible result" by misinterpreting this Court's opinion in *Feist*, and by indulging "nothing more than its collective judgment of what ought to be copyrightable." *Id.*

Judge Hatchett found originality in BAPCO's choice of classified headings and in its arrangement of specific businesses under particular headings. *Id.* at 25a, 27a. As he explained, "it defies logic to conclude that BAPCO's grouping over 106,398 business listings from 32,559 different businesses, under approximately 7,000 [sic, 3,795] classified headings amounts to no more than mechanical grouping of data." *Id.* at 28a. Judge Hatchett also concluded that BAPCO's selection of only businesses with business telephone service was an act of selection contributing to the originality of the BAPCO yellow pages. Donnelley itself included other businesses in its directory, confirming that BAPCO's choice was hardly inevitable or mechanical. *Id.* at 31a-32a. Finally, the dissent found originality in BAPCO's selection of the geographic scope of the directory. *Id.* at 32a. The fact that BAPCO and Donnelley made different scoping decisions in this very case demonstrated that the choice was "not an 'obvious' act of selection." *Id.* at 34a (quoting *Feist*, 111 S. Ct. at 1297).

The dissent relied extensively on the Second Circuit's decision in *Key Publications, Inc.* v. *Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991), for the proposition that such activities involved sufficient creativity and originality to render a business directory copyrightable under *Feist*. Indeed, Judge Hatchett cited *Key Publications* for support no fewer than seven times. *See* App. 24a, 27a, 29a, 32a, 35a, 48a.

REASONS FOR GRANTING THE WRIT

This Court should grant certiorari to resolve the direct conflict between the decision of the Eleventh Circuit below and that of the Second Circuit in *Key Publications, Inc.* v. *Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991). The majority below construed this Court's decision in *Feist* as precluding compilation copyright protection for a yellow pages directory; the Second Circuit in *Key Publications* construed *Feist* as affording such protection. The question presented is important and recurring, because the manner in which BAPCO creates its yellow pages is similar to that employed by more than 100 yellow pages publishers around the country in annually compiling more than 5,800 different copyrighted yellow pages directories, and because Donnelley's method of copying BAPCO's directory is increasingly common throughout the industry.

Quite apart from the specific conflict with respect to yellow pages, the decision below also conflicts more generally with the approach of other Circuits to compilation copyright issues after *Feist*. In a wide range of areas—from video games to news footage services to maps—courts of appeals are being asked to re-examine copyright protection in the wake of *Feist*. Most courts of appeals have read *Feist* narrowly, acknowledging this Court's admonition that "the requisite level of creativity is extremely low" and that "the vast majority of compilations will pass this test." 111 S. Ct. at 1287, 1294. The Eleventh Circuit below took the opposite approach, transforming the inquiry into minimal creativity into a quite different test of novelty, and evaluating creativity on an element-by-element basis, rather than judging the compilation as a whole. The question presented is important and recurring not only with respect to yellow pages directories, but also with respect to these broader issues of copyright law. This Court should grant the writ to resolve this conflict and clarify the import of its decision in *Feist*.

I. THE DECISION BELOW CONFLICTS WITH A RECENT DECISION OF THE SECOND CIRCUIT

The decision below conflicts with the recent decision of the Second Circuit in *Key Publications, Inc.* v. *Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991). The court in that case held that a yellow pages directory for New York City's Chinese-American community was entitled to compilation copyright protection. Applying *Feist*, the Second Circuit began by noting that "[t]he requirement of originality * * * is not particularly rigorous. Simply stated, original means not copied, and exhibiting a minimal amount of creativity." *Id.* at 512-513. As the court emphasized, "for purposes of copyright, originality is not synonymous with novelty." *Id.* at 513.

Writing for the Second Circuit, Judge Winter explained that the publishers of the Chinese-American yellow pages exhibited the requisite degree of creativity and originality in the selection of which businesses to include in their directory. *Id.* Responding to the contention that the publishers "slavishly" included every business about which they had information, the court noted that the publishers excluded certain businesses they "did not think would remain open for very long," and that this "alone indicates thought and creativity in the selection of businesses included in the * * * Directory." *Id.*

The court also found the requisite originality in the arrangement of the directory. The court noted that "[t]he format of the * * * Directory is common to most classified directories," but reiterated that "[t]he lack of novelty is * * * not a bar to copyright protection." *Id.* at 514. The question instead was

> whether the arrangement of the * * * Directory, *viewed in the aggregate*, is original. We believe it is. The arrangement is in no sense mechanical, but involved creativity on the part of [the author] in

> deciding what categories to include and under what name. * * * This task entailed the de minimis thought needed to withstand the originality requirement. [*Id.* at 514 (emphasis added).]

The Second Circuit specifically contrasted the foregoing with the alphabetical arrangement of names at issue in *Feist*, which involved "nothing remotely creative." *Id.* (quoting *Feist*, 111 S. Ct. at 1297).[4]

The decision below stands in sharp contrast to the Second Circuit decision in *Key Publications*. The Second Circuit found a yellow pages directory copyrightable under *Feist* because of the acts of selection, coordination, and arrangement that went into compiling the directory; the Eleventh Circuit below held, also in reliance on *Feist*, that such acts did not give rise to copyright protection. While the Second Circuit found originality in the selection of businesses included in the directory, the court below dismissed such activity as involving "not acts of authorship, but techniques for the discovery of facts." App. 8a. Under the Eleventh Circuit's view, the publishers of the yellow pages in *Key Publications* simply "discovered" those businesses of interest to the Chinese-American community that were willing to be listed.[5]

Quite apart from the conflict on the issue of selection, the two Circuits are also in stark conflict on whether the

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[4] The court in *Key Publications* went on to rule that the authors of the rival directory had not infringed the copyright, because the arrangement in their directory "can hardly be described as even remotely similar to the arrangement utilized by the [protected directory]." 945 F.2d at 515.

[5] The cases cannot be distinguished on the ground that *Key Publications* involved a yellow pages for a particular ethnic community. That is clear from Judge Winter's conclusion in *Key Publications* that the decision to exclude certain businesses from the directory on the ground of their questionable longevity in the marketplace, standing alone, evinced the requisite creativity and originality. 945 F.2d at 513.

acts of arrangement and coordination that go into compiling a yellow pages directory are original within the meaning of the copyright laws. The Eleventh Circuit below concluded that "BAPCO's arrangement and coordination is 'entirely typical' for a business directory." App. 9a (quoting *Feist*, 111 S. Ct. at 1296).

> While the listings in BAPCO's yellow pages required somewhat more organization and arrangement than the white pages directory considered in *Feist*, BAPCO's claim of "originality" must be resolved by comparison to other business telephone directories. BAPCO did not deviate from the arrangement of the typical business directory, which employs an alphabetical list of headings to describe the various types of business and then alphabetizes the listings under the appropriate headings. [App. 9a-10a n.13.]

The Second Circuit, in sharp contrast, recognized that although "[t]he format of the * * * Directory is common to most classified directories, and particular categories have, of course, been used in other classified directories," this was not an impediment to copyright protection. A contrary approach would confuse originality with novelty, and, as Judge Winter explained, "[t]he lack of novelty is * * * not a bar to copyright protection." 945 F.2d at 514. The issue was not—as the Eleventh Circuit viewed it—whether anyone had ever thought of the business directory format before, but instead—as the Second Circuit viewed it—whether the particular arrangement, "viewed in the aggregate," was mechanical or rather "involved creativity * * * in deciding which categories to include and under what name." *Id.*[6]

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[6] The distinction between novelty and originality is the core distinction between patent and copyright protection. To be eligible for a patent, an inventor must show novelty—a new invention not previously conceived. A later inventor who independently creates the same invention will nonetheless not be entitled to a patent, because the invention is not novel. In contrast, to be eligible for copyright protection, an author need show only originality—that

Judge Hatchett's dissent highlights the conflict between *Key Publications* and the majority opinion below. The dissent repeatedly relied upon *Key Publications* in support of its explanation of why BAPCO's various acts of selection, coordination, and arrangement were sufficiently creative to constitute acts of authorship under the copyright laws. For example, the dissent cited *Key Publications* as being in accord with its view that BAPCO's choice of classified headings satisfied the originality requirement, noting the Second Circuit's holding that "a publisher's selection of 260 different categories, even if including particular categories that have been used in other directories, involved sufficient creativity to contribute to the overall originality of a classified directory." App. 25a. To cite another example, the dissent also relied on *Key Publications* for the proposition that BAPCO's "grouping 106,398 business listings under approximately 7,000 [sic, 3,795] classified headings, which BAPCO selected from a heading book containing 4,700 primary entries and 34,000 related headings," was hardly "mechanical" under *Feist*, noting the Second Circuit's parallel "holding that a classified publisher's grouping of over 9,000 listings into approximately 260 different categories constituted original arrangement entitled to copyright protection." *Id.* at 29a.[7]

Both the majority below and the Second Circuit in *Key Publications* relied on this Court's decision in *Feist* in reaching their conflicting conclusions. This is therefore

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he has not copied the work in question and that it displays minimal creativity. A later author who independently creates the same work is entitled to a copyright, because the later author's work—though not novel—is nonetheless original. *See Feist*, 111 S. Ct. at 1287-88.

[7] The conflict between the Second Circuit's opinion in *Key Publications* and the majority opinion below is also confirmed by the recent D.C. Circuit opinion in *Atari Games Corp.* v. *Oman*, 979 F.2d 242 (D.C. Cir. 1992) (R. B. Ginsburg, J.). In that case the D.C. Circuit described both *Key Publications* and the panel decision below as holding that a "yellow page telephone directory is copyrightable." 979 F.2d at 246. *See infra* at 22-24.

not a case in which the conflict among the Circuits can be explained away or minimized on the ground that the courts looked to different precedents, where the hope remains that the conflict can be reconciled in the future without intervention by this Court. Only this Court can resolve the conflict.

II. THE DECISION BELOW IS CONTRARY TO THIS COURT'S DECISION IN *FEIST*

The court below erred in its understanding of *Feist*. While the Eleventh Circuit denied copyright protection for BAPCO's directory because a "comparison to other business telephone directories" showed that "BAPCO did not deviate from the arrangement of the typical business directory," *id.* at 10a n.13, this Court in *Feist* emphasized that "[o]riginality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying." 111 S. Ct. at 1287.

This Court's analysis in *Feist* compels the conclusion that BAPCO's creative acts of authorship in compiling its directory were entitled to copyright protection. After explaining that only an "extremely low" and "minimal degree" of creativity was needed to meet the originality requirement, *id.*, this Court denied copyright protection for a white pages directory because the publisher of the directory "simply takes the data provided by its subscribers and lists it alphabetically by surname," a process "devoid of even the slightest trace of creativity." *Id.* at 1296. As the Court explained, the white pages contained simply "uncopyrightable facts" which "existed before [the publisher] reported them and would have continued to exist if [the publisher] had never published a telephone directory." *Id.* The publisher's "selection of listings could not be more obvious" and there was "nothing remotely creative about arranging names alphabetically in a white pages directory." *Id.* at 1296-97.

The opposite is true here. The selection of which listings to include in the yellow pages—in contrast to the white pages—is not obvious. It is not obvious to exclude businesses using residential telephone service, however much they want to be listed. Many classified directories do not draw such a distinction. It is not obvious to seek to include a swimming pool contractor located 30 miles outside the general area covered by the directory, but not a similarly located shoe store. That decision reflects an editorial judgment. It is not obvious to offer one free listing—rather than none or several—and the editorial decision to do so plainly affected the number of listings (paid and unpaid) appearing in BAPCO's directory as a whole.

BAPCO's decisions about which businesses to contact and in what manner were also not mechanical or obvious, and plainly affected the final product. For example, a decision to contact all general contractors to determine whether they would benefit from an additional listing under "Siding Contractors" would likely expand the listings in that area; a judgment not to contact painters about additional listings under "Paper Hangers" will limit growth of the listings under that heading. Donnelley copied the fruits of these editorial judgments when it copied the resulting listings from BAPCO's directory under "Siding Contractors" and "Paper Hangers." If it had compiled its own directory rather than copying BAPCO's, it may have made the opposite choice and come up with a work of authorship with more "Paper Hangers" and fewer "Siding Contractors" listings.

Nor was there anything obvious about selecting the thousands of headings available in BAPCO's yellow pages. *See Key Publications,* 945 F.2d at 513. The court below noted that "many of the selected headings, for example, 'Attorneys' or 'Banks,' represent such an obvious label * * * as to lack the requisite originality for copyright protection." App. 14a. But the question is the original-

ity of the work "as a whole," 17 U.S.C. § 101, and while "Attorneys" or "Banks" may be obvious headings, it is not obvious or mechanical to include headings for "Appliances-Household-Major-Dealers," "Appliances-Household-Small-Dealers," "Appliances-Household-Major Whol & Mfrs," and "Appliances-Household-Small Whol & Mfrs." While BAPCO chose to use these four headings in the 1984 Miami Yellow Pages, another publisher might choose to use only two—"Appliances-Household-Dealers," and "Appliances-Household-Whol & Mfrs"—another publisher six—"Appliances-Household-Major-Dealers," "Appliances-Household-Small-Dealers," "Appliances-Household-Major-Whol," "Appliances-Household-Major Mfrs," "Appliances-Household-Small Whol" and "Appliances-Household-Small Mfrs"—and yet another publisher only one—"Appliances-Household." Whichever choice is made results in a different arrangement or grouping of listings. Hundreds upon hundreds of similar decisions make the directories—"considered as a whole"—creatively original, even if every one contains headings for "Attorneys" and "Banks." [8]

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[8] The majority below sought to avoid the significance of BAPCO's creativity in selecting headings by concluding that Donnelley did not copy the particular hearing structure employed by BAPCO. App. 12a-13a. The majority's conclusion was based on a legal determination that Donnelley could escape liability for infringement on this score simply by associating the material copied from the BAPCO directory with corresponding Donnelley headings. *Id.* at 13a. But that in no way alters the fact that the BAPCO material was copied by Donnelley—it simply goes to what Donnelley did with the copied material. The majority itself acknowledged that Donnelley "admitted" that it "copied the * * * type of business from every BAPCO listing," *id.* at 18a n.23, and Donnelley stipulated that "[k]ind of business" was "obtained from the [BAPCO] Directory." 1SR1-8. *See* 5SR-Tr. of Oct. 1985 Prel. Inj. Hearing, at 140 (Donnelley counsel) ("I have stipulated that the keying people took from [BAPCO's] '84 directory the name, the address, the phone number, *the type of business* and the advertising unit") (emphasis added); Donnelley Answer, at 4, 7, 9 (admitting "heading" or "business classification" was "obtained" from BAPCO directory).

Nor was the arrangement of listings under the various headings a mechanical exercise "devoid of even the slightest trace of creativity." *Feist*, 111 S. Ct. at 1296. Name, address, and telephone number are objective *facts*; the characterization of a specific business is not. If a BAPCO sales person convinces a proprietor that he qualifies for and should purchase a listing as a hair stylist in addition to his free listing as a barber, that element in the directory—the listing of the shop as a hair stylist—is not a "fact" that "existed before" BAPCO engaged in its creative process of authorship. And the listing is not a "fact" that "would have continued to exist if [the publisher] had never published a telephone directory." *Feist*, 111 S. Ct. at 1296.[9] Different BAPCO personnel may make different recommendations as to where and how the same business should be listed, precisely because such judgments are not objective facts waiting to be discovered but creative acts of authorship.

There may be no creativity in deciding how to list J. Jones on Maple Street in the white pages; there is considerable creativity involved in deciding how to list a bakery with a sandwich counter that offers take-out. "Bakers-Retail," "Bagels," "Sandwiches," "Foods-Carry Out," "Wedding Supplies & Services," and "Delicatessens" are simply a few of the dozens of possible choices. J.

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[9] The majority below dismissed as insignificant the fact that Donnelley copied errors introduced into the yellow pages by BAPCO, App. 18a n.23, but Donnelley's actions refute the majority's contention that all Donnelley was copying were noncopyrightable facts. It is not a "fact" that the Fort Lauderdale News sells "Balancing Equipment." *See id.* at 83a n.23. Donnelley's replication of this erroneous listing in its book confirms that Donnelley was copying not facts but BAPCO's selection and arrangement of listings—no matter how fictitious. *See id.* at 47a (Hatchett, J., dissenting) ("Donnelley's assertion that it independently classified businesses using its own heading scheme is wholly unbelievable when one considers the statistical improbability of two publishers independently classifying the same newspaper as a 'Balancing Equipment' dealer").

Jones cannot decide that he would also like to be listed under the "Smiths" in the white pages, but that is precisely the sort of editorial judgments BAPCO makes in authoring its yellow pages directory: advising a toy store, if appropriate, to be listed under the categories for "Party Supplies" and/or "Novelties," as well as "Toys".

Even if the individual listings are considered to be facts, it is plain that BAPCO's grouping of the 106,398 listings in its 1984 Miami Yellow Pages was not obvious or mechanical. As this Court explained in *Feist*, a directory containing "only facts" nonetheless "meets the constitutional minimum for copyright protection if it features an original selection or arrangement." 111 S. Ct. at 1289. As the Copyright Act makes clear, the question is whether the "facts" are "selected, coordinated, or arranged in such a way that the resulting work *as a whole* constitutes an original work of authorship." 17 U.S.C. § 101 (emphasis added).

The white pages in *Feist* failed that test because the arrangement of the facts—even considered as a whole—was entirely predictable. That is not true of the grouping of the 106,398 listings in BAPCO's 1984 Miami Yellow Pages. That group of listings was in no sense pre-existing but instead was created only by the actions of BAPCO in compiling its directory.

In copying BAPCO's directory, Donnelley copied the results of these original acts of authorship as a whole, and not simply objective "facts" BAPCO had discovered. Indeed, as the panel below noted, Donnelley already possessed those elements of the directory that can be characterized as facts—names, addresses, and telephone numbers—pursuant to a licensing agreement with Southern Bell. Donnelley copied BAPCO's original selection, coordination, and arrangement of those facts not because that was the only or even the easiest way to gain access to the facts—indeed, the material from Southern Bell was more current than that in BAPCO's directory—but precisely because Donnelley wanted the benefit of BAPCO's

original and creative compilation of those facts. App. 61a-62a (panel opinion).

The court's error below is confirmed by its invocation of the "merger doctrine" to support its analysis. *See id.* at 10a-12a. The point of the merger doctrine is that if different authors undertake to express a particular idea, they will come up with the same way of expressing that idea. Protecting the authorship of that singular expression would therefore extend protection to the idea itself, contrary to basic principles of copyright law. It is easy to see how the analysis applies to a white pages directory. If different authors independently compile a white pages, their final products—assuming they perform the task well—will be the same. But that is not at all true with respect to a yellow pages directory. One author might arrange listings under headings for "Barbers," "Hair Styling," and "Beauty Salons;" another might simply include the listings under one "Hair Care" heading, or include subheadings for barbers, hair stylists, and beauty salons under the "Hair Care" heading. One approach is not objectively "better" than the other; they are simply different, and result in different "original work[s] of authorship" entitled to compilation copyright protection. 17 U.S.C. § 101.[10]

III. THE INTERPRETATION OF *FEIST* BY THE COURT BELOW CONFLICTS WITH THAT OF OTHER CIRCUITS

In a broad range of areas, defendants in copyright actions are relying on *Feist* to argue that compilations previously recognized as entitled to copyright protection are

[10] This Court in *Feist* also noted that the white pages directory before it may also have failed the originality requirement because the local telephone company was required by state law to publish such a directory as part of its monopoly franchise. 111 S.Ct. at 1296-97. Here no law or regulation of any kind required BAPCO (or the telephone company, for that matter) to create and publish a yellow pages directory. The decision to do so, and the myriad decisions concerning how to go about doing so, were BAPCO's alone.

no longer protected. Most courts of appeals reject such contentions as an overreading of *Feist*'s limited holding, finding that the minimal creativity requirement is satisfied except in those rare instances where a particular selection, coordination, or arrangement of facts is "practically inevitable" or "mechanical." *Feist*, 111 S. Ct. at 1296, 1297. These decisions—unlike the decision below—provide the protection that is critical to the continued viability of industries that create and market factual compilations. The existence of these competing interpretations confirms the need for this Court to address the important issues left unresolved in *Feist*: namely, what type of creativity is required for a factual compilation to receive copyright protection, and how is that creativity to be measured?

For example, in *Atari Games Corporation* v. *Oman*, 979 F.2d 242 (D.C. Cir. 1992), the D.C. Circuit held that the Register of Copyrights abused his discretion in refusing to register a copyright to the video game "Breakout." The Register had rejected the copyright registration application on the grounds that the video game portrayed geometric shapes and colors that were not themselves copyrightable, and that there was "no original authorship in either the selection or arrangement of the images or their components." *Id.* at 243 (quoting Letter Ruling). The D.C. Circuit agreed that the individual graphic elements of the game were not copyrightable, but—relying on *Feist*, *Key Publications*, and the panel decision below—concluded that the selection and arrangement of the shapes taken as a whole satisfied the creativity requirement. *Id.* at 245-246.

In her opinion for the court, then-Judge Ginsburg criticized the Register for focusing on the individual elements rather than on the work as a whole, and for insisting that the selection and arrangement of the elements be "distinctive" and "unique" to qualify for copyright protection. *Id.* at 246. Noting that the issue before her was analo-

gous to the compilation copyright issue in *Feist*, Judge Ginsburg explained that there were no such requirements for copyright protection, and that "Breakout" evinced the "minimal creative spark" required for protection because the assemblage of the graphic shapes was not entirely mechanical. *Id.* at 245-247 (quoting *Feist*, 111 S. Ct. at 1297).

Judge Ginsburg noted that "*Feist* and decisions applying *Feist* confirm[ed]" that " 'distinctive' or 'unique' qualities were [not] requirements for protection." 979 F.2d at 246. The "decisions applying *Feist*" cited by Judge Ginsburg included the Second Circuit's decision in *Key Publications* and the panel decision below,[11] and Judge Ginsburg described each of these decisions as holding that a "yellow page telephone directory is copyrightable." *Id.* at 246.

The Eleventh Circuit took an opposite tack, similar to the approach of the Register of Copyrights that the *Atari Games* court rejected. Like the Register and unlike the D.C. Circuit, the majority below focused on the individual elements of the yellow pages—business names, addresses, and telephone numbers—rather than BAPCO's selection and arrangement of those elements in the directory as a whole. The court below ruled that BAPCO's directory was not original because it "did not deviate from the arrangement of the typical business directory," App. 10a n.13, while the D.C. Circuit emphasized that there were no " 'distinctive' or 'unique' * * * requirements for protection" under the copyright laws. 979 F.2d at 246. The fact that the D.C. Circuit cited not only *Feist* but also the panel opinion below and *Key Publications* for this proposition confirms the conflict between the D.C. Circuit's approach in *Atari Games* and the approach of the en banc majority below, as well as the conflict between

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[11] The other case cited, *Kregos* v. *Associated Press*, 937 F.2d 700 (2d Cir. 1991), is discussed *infra* at 24.

Key Publications and the en banc Eleventh Circuit. *See id.*

The D.C. Circuit is not alone in its deviation from the approach adopted by the court below. The Second Circuit in *Kregos* v. *Associated Press*, 937 F.2d 700 (2d Cir. 1991)—in line with its later decision in *Key Publications*—upheld the copyrightability of a "pitching form" consisting solely of a selection of nine categories of baseball statistics. Even though eight of the plaintiff's categories had appeared in competing pitching forms, the court held that the plaintiff could demonstrate the " 'minimal level of creativity' " required under *Feist* in his selection of the particular categories to include in his form. *Id.* at 703-705 (quoting *Feist*, 111 S. Ct. at 1294). As the court explained, even if there had been only twenty possible pitching statistics, and a selector were limited to choosing nine, there would be more than 167,000 possible combinations. 937 F.2d at 704 n.3. The myriad decisions that go into compiling and arranging a yellow pages directory result in a limitless number of distinctive yellow pages possibilities.[12]

In *Harper House, Inc.* v. *Thomas Nelson, Inc.*, 1993 WL 346546 (9th Cir. Sep. 10, 1993), *prior opinion*, 889 F.2d 197 (9th Cir. 1989), the Ninth Circuit considered whether an "organizer" was entitled to copyright protection as a compilation. In a pre-*Feist* opinion, the court held that although the different elements that went into the plaintiff's organizers were not copyrightable, "the organizers' selection, coordination, and arrangement are protectable." 889 F.2d at 204, 205. As the Ninth Circuit explained, "[a] copyrightable compilation can consist

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[12] On remand, the district court in *Kregos* granted summary judgment for the defendant, concluding that the defendant's competing pitching form—which relied on ten statistics, four of which were different from the plaintiff's—did not infringe plaintiff's copyright. 795 F. Supp. 1325 (S.D.N.Y. 1992). On September 1, 1993, the Second Circuit affirmed. 3 F.3d 656.

mainly or entirely of uncopyrightable elements." *Id.* at 204.

On remand the district court granted summary judgment for the defendants, but the Ninth Circuit—applying *Feist*—recently reversed. The court of appeals reiterated its earlier holding that "[e]ven though the individual pages of [plaintiff's] organizers were not copyrightable, * * * [the] organizers were still within the subject matter of copyright, protectable as compilations." 1993 WL 346546 at *1. Contrary to the district court, the court of appeals found "the inclusion of additional sections and some limited reshuffling of sections in defendants' organizer insufficient to take [the infringement] issue out of the hands of the jury." *Id.* at *2.

Contrary to the Eleventh Circuit in this case, these courts upheld the copyrights at issue precisely because of the plaintiffs' creative decisions in selecting, coordinating, and arranging the relevant facts, notwithstanding that there were other works utilizing the same general format, and notwithstanding the non-copyrightability of the various elements comprising the compilation. By contrast, under the decision below, a compilation may not receive copyright protection whenever there are other compilations using the same basic format—regardless of the author's selection, coordination, or arrangement within that format. Few compilations, if any, would meet that stringent standard. Such a result is contrary to this Court's ruling in *Feist* that "[t]he vast majority of works make the grade quite easily." 111 S. Ct. at 1287.[13]

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[13] BAPCO has been informed that the defendant in *Harper House* and the plaintiff in *Kregos* intend to file petitions for certiorari with this Court to review the judgments in those cases. While BAPCO believes that both *Harper House* and *Kregos* correctly decided the issues of copyrightability presented in those cases, the petitions for certiorari underscore the conflict in the Circuits that has arisen after *Feist*, confirm that the issue is important and recurring, and demonstrate the need for this Court to resolve the conflict over the meaning of its decision.

Nor are the issues raised by this case limited to compilations of textual material. In *Los Angeles News Service* v. *Tullo*, 973 F.2d 791 (9th Cir. 1992), for example, the Ninth Circuit held that "raw" videotape of news events (film footage without commentary) was entitled to copyright protection because of the "intellectual and creative input" entailed in deciding what events to film and how to position the camera. *Id.* at 794. The court rejected the defendant's reliance on *Feist*, noting this Court's admonition that "the 'requisite level of creativity is extremely low.'" *Id.* at 794-795 (quoting *Feist*, 111 S. Ct. at 1287).

To cite another example, the Fifth Circuit in *Mason* v. *Montgomery Data, Inc.*, 967 F.2d 135 (5th Cir. 1992), held that a map was copyrightable in light of the mapmaker's originality and creativity in deciding what information to include and how to depict it. *Id.* at 141-142. The court of appeals rejected the defendant's reliance on *Feist*, explaining that while "bare facts are never copyrightable 'because facts do not owe their origin to an act of authorship.'" a compilation "may be copyrightable if the author made choices as to 'which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers.'" *Id.* at 141 (quoting *Feist*, 111 S. Ct. at 1288-89).[14]

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[14] To similar effect is *Nester's Map & Guide Corp.* v. *Hagstrom Map Co.*, 796 F. Supp. 729 (E.D.N.Y. 1992). In that case the court, applying *Feist* and *Key Publications*, found sufficient originality and creativity in a map guide for New York City taxi drivers. The court based its ruling on the publisher's selection of which street address listings to include on its map and which destinations to include on a mileage list. *See* David B. Wolf, *Is There Any Copyright Protection for Maps After* Feist?, 39 J. Copyright Soc'y USA 224 (1992). *See also Penelope* v. *Brown*, 792 F. Supp. 132, 135 (D. Mass. 1992) (author's selection and arrangement of preexisting statements of others constituted original, copyrightable subject matter).

Unlike the District of Columbia, Second, Ninth, and Fifth Circuits, the Eleventh Circuit below did not adopt an appropriately limited reading of *Feist*. It instead concluded that the very sort of acts of selection and arrangement viewed by the other Circuits applying *Feist* as warranting copyright protection did not meet the *Feist* standard. This Court should grant the writ to resolve this conflict among the Circuits on the meaning of *Feist*.[15]

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[15] The conflicting analyses employed by the courts of appeals in post-*Feist* cases have not escaped the notice of commentators, who have pointed to the lack of clear direction from *Feist* on the standard for determining whether certain factual compilations meet the requisite standard of creative originality. *See, e.g.*, Howard B. Abrams, *Originality and Creativity in Copyright Law*, 55 Law & Contemp. Probs. 3, 15 (1992) (*Feist* does not promulgate a definition or test for determining whether creativity requirement has been met); Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection of Works of Information After* Feist *v.* Rural Telephone, 92 Colum. L. Rev. 338, 343 (1992) ("The *Feist* opinion is more explicit in describing what is not original than in delineating what is"); John P. McDonald, *The Search for Certainty*, 17 U. Dayton L. Rev. 521, 522 (1992) (changes in copyright doctrine made by *Feist* have created a "conceptual void that needs to be filled"); Philip H. Miller, *Life After* Feist: *Facts, the First Amendment and the Copyright Status of Automated Databases*, 60 Fordham L. Rev. 507, 516 (1991) (*Feist*'s failure to provide explicit guidelines for evaluating whether a compilation satisfies the originality requirement will make it difficult for lower courts to make this determination with any degree of consistency); Alfred C. Yen, *The Legacy of* Feist: *Consequences of the Weak Connection Between Copyright and the Economics of Public Goods*, 52 Ohio St. L. J. 1343, 1376 & n.149 (1991) (noting inconsistency in analytical approaches by lower courts attempting to construe *Feist*); Russ VerSteeg, *Rethinking Originality*, 34 Wm. & Mary L. Rev. 801, 823 (1993) (the Court in *Feist* "did not define 'creativity' in any manner other than by default" and "neglected to articulate a standard"); Ralph Oman, Register of Copyrights, *Reflections on the Changing Shape of Database Protection*, 40 Fed. Bar News & J. 232, 234 (1993) ("Certainly, many directories and related compilations will leap the low originality hurdle described in *Feist* and enjoy protection under copyright. However, *Feist* may generate new uncertainties around the application of the 1976 [Copyright] Act to databases").

IV. THE QUESTION PRESENTED IS IMPORTANT AND RECURRING

As Judge Hatchett noted, the decision below—if allowed to stand—will transform the basic nature of "the multi-billion dollar classified publishing industry." App. 19a. The reason the decision has such broad impact is that, as the majority below recognized, it concerns "a typical yellow pages directory," *id.* at 2a, and the way BAPCO compiled the directory is similar to the way the other operating telephone companies compile their yellow pages directories across the Nation. By the same token, Donnelley's manner of copying is widely prevalent. *See* Affidavit of Gary R. Johnson, ¶ 11. The case is thus a test case for the nature of copyright protection for yellow pages in general. The impact of the decision below on this specific industry alone is reason enough to grant certiorari.

As explained above, however, the impact of the Eleventh Circuit decision cannot be confined to the classified directory industry. The misreading of *Feist* by the majority below calls into serious question the validity of copyright protection across the entire spectrum of compilation works: photographs, maps, charts, databases, news services, and the like. This Court should grant the writ to resolve the conflict not only between the Eleventh and Second Circuits on the copyrightability of yellow pages directories, but also between the Eleventh Circuit and the various other Circuits that have read *Feist* far more narrowly as not precluding copyright protection for other types of compilations.

The present case is an ideal vehicle for resolving the conflict among the Circuits and deciding this important question of copyright law. First, the decision below is in no sense fact-specific. The en banc majority reached its decision that BAPCO's directory was not entitled to copyright protection "as a matter of law." App. 15a. What is at issue is not simply an application of law to particu-

lar facts, but instead, as Judge Hatchett explained, the "establish[ment] [of] a rule of law." *Id.* at 19a.

Second, the legal issues have been fully aired. The Court has the benefit in this case of considered published opinions not only by the district court and a panel of the court of appeals, but by the en banc majority and dissent as well.

Third, the court below specifically considered the conflicting authority, and nonetheless elected to adhere to its position. When it granted rehearing en banc, the Eleventh Circuit directed counsel to address certain decisions from other courts of appeals—including the Second Circuit's decisions in *Key Publications* and *Kregos*. Counsel also alerted the court to the more recent decision of the D.C. Circuit in *Atari Games*. *See* En Banc Brief of Appellee at 40-42. Judge Hatchett's extensive reliance on *Key Publications* in his dissent also ensured its consideration by the majority.

Nor is this a case in which the Court can leave it to Congress to resolve the conflict in the state of the law. As this Court explained in *Feist*, the originality requirement in the Copyright Act tracks the originality requirement discerned by this Court in the Constitution. *See* 111 S. Ct. at 1288, 1290-94. The en banc majority was, therefore, necessarily deciding not only that Congress did not but could not extend copyright protection to directories like BAPCO's. Only this Court can correct the erroneous decision below.

Finally, this is not a situation in which the Court should allow the issue to "percolate" further in the lower courts. Such forbearance may be appropriate when there is a reasonable prospect that the conflict will work itself out as new arguments are raised and considered. There is no likelihood of that here. The Eleventh Circuit expressly considered the Second Circuit's view in *Key Publications* and declined to follow it, though Judge Hatchett did in

dissent. Additional decisions hold no promise of further sharpening the pertinent legal issues, and, in the meantime, "the multi-billion dollar classified publishing industry," App. 19a (Hatchett, J., dissenting), would remain in deep confusion concerning the applicable copyright rules.

CONCLUSION

For the foregoing reasons, this Court should grant the writ and reverse the decision below.

Respectfully submitted,

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APPENDICES

APPENDICES

APPENDIX A

UNITED STATES COURT OF APPEALS
ELEVENTH CIRCUIT

No. 89-5131

BELLSOUTH ADVERTISING & PUBLISHING CORPORATION,
Plaintiff-Counterclaim
Defendant-Appellee,

v.

DONNELLEY INFORMATION PUBLISHING, INC. and
THE REUBEN H. DONNELLEY CORP.,
Defendants-Counterclaim
Plaintiffs-Appellants,

BELLSOUTH CORPORATION, *et al.*,
Counterclaim Defendants.

Appeal from the United States District Court
for the Southern District of Florida

Sept. 2, 1993

Before TJOFLAT, Chief Judge, FAY, HATCHETT, EDMONDSON, BIRCH, BLACK and CARNES, Circuit Judges*.

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* Honorable Phyllis A. Kravitch, Honorable R. Lanier Anderson, III, Honorable Emmett Ripley Cox and Honorable Joel F. Dubina did not participate in this decision.

BIRCH, Circuit Judge:

I. INTRODUCTION

In this appeal we must decide whether acts of copying infringed the compilation copyright registered in a "yellow pages" classified business directory. The parties have stipulated that the directory, which is a typical yellow pages directory, qualifies for compilation copyright protection. Thus, we are called upon to apply *Feist Publications, Inc. v. Rural Telephone Service Co.*, —— U.S. ——, 111 S.Ct. 1282, 113 L.Ed.2d 358 (1991), which addressed copyright protection for a "white pages" telephone directory, to resolve the infringement claims presented to us concerning a directory of a different color.

The pivotal issue in this case is whether that which was copied by the accused infringer was protected by the registered claim of compilation copyright. The parties agree that the only elements of a work entitled to compilation copyright protection are the selection, arrangement or coordination as they appear in the work as a whole. The parties dispute what elements of a classified directory constitute such selection, arrangement or coordination. Mindful that the protection afforded to a whole work by a compilation copyright is "thin," [1] the determination as to whether an infringement of a compilation copyright has occurred is particularly difficult where less than the entire work is copied.

II. BACKGROUND

BellSouth Advertising & Publishing Corp. ("BAPCO") is a wholly-owned subsidiary of BellSouth Corp. ("BellSouth") created for the purpose of preparing, publishing and distributing telephone directories. Using telephone listing information supplied by Southern Bell Telephone and Telegraph Co. ("Southern Bell"), another wholly-

[1] *Feist*, —— U.S. at ——, 111 S.Ct. at 1289.

owned subsidiary of BellSouth. BAPCO publishes a classified, "yellow pages," advertising directory for the Greater Miami area. The BAPCO directory is organized into an alphabetical list of business classifications. Each business-rate telephone service subscriber is listed in alphabetical order under one appropriate heading without charge. A subscriber may purchase cross listings under different business classifications or advertisements to appear along with its business listing.

After BAPCO published its 1984 directory for the Greater Miami area, Donnelley Information Publishing, Inc. and Reuben H. Donnelley Corp. (collectively "Donnelley") began promoting and selling classified advertisements to be placed in a competitive classified directory for the Greater Miami area. To generate a list of business telephone subscribers to be solicited for placement in its directory, Donnelley gave copies of BAPCO's directory to Appalachian Computer Services, Inc. ("ACS"), a data entry company. Donnelley first marked each listing in the BAPCO directory with one alphanumeric code indicating the size and type of advertisement purchased by the subscriber [2] and a similar code indicating the type of business represented by the BAPCO heading under which the listing appeared. ACS then created a computer data base containing, for each listing appearing in the BAPCO directory, the name, address, and telephone number of the subscriber, as well as the codes corresponding to business type and unit of advertising. From this data base, Donnelley printed sales lead sheets, listing this information for each subscriber, to be used to contact business telephone subscribers to sell advertisements and list-

[2] The code corresponding to the type of advertising appearing in the BAPCO directory indicated only the unit of advertising purchased. Donnelley did not record, nor was alleged to have recorded, information regarding the graphic appearance or page location of the advertising material, nor did it copy facts concerning individual businesses, such as product lines, services, hours of operation, contained in the advertisements themselves.

ings in the Donnelley directory. Relying on this information copied from the BAPCO directory. Donnelley ultimately prepared its own competitive directory for the Greater Miami area.

BAPCO sued Donnelley alleging copyright infringement,[3] trademark infringement, and unfair competition. After the district court denied BAPCO's motion for a preliminary injunction. Donnelley answered and counterclaimed against BAPCO, Southern Bell and BellSouth, alleging violations of federal antitrust law. On the copyright infringement claim, the district court granted summary judgment to BAPCO and denied Donnelley's motion seeking partial summary judgment in its favor,[4] 719 F. Supp. 1551.

The district court found, and Donnelley admitted, that BAPCO owned a valid compilation copyright in its classified directory. Donnelley stipulated that, in preparing its data base and sales lead sheets, it obtained from each listing in the BAPCO directory, the telephone number, name, address, kind of business, and unit of advertising for the listed subscriber. As further evidence of copying, the district court relied on affidavits and deposition testimony from Donnelley's representatives and the presence of a number of erroneous listings common to

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[3] BAPCO registered its claim of copyright (attached to this opinion as Appendix A) for the "entire text and compilation" of both volumes of its 1984 Miami yellow pages directory. R1-1-Ex. D. It was upon this registration that BAPCO initiated its action for infringement. *See* 17 U.S.C. § 411(a) (". . . no action for infringement of the copyright in any work shall be instituted until registration of the copyright claim has been made in accordance with this title.").

[4] The district court granted BAPCO's motion for summary judgment on Donnelley's antitrust counterclaim, but denied BellSouth and Southern Bell's motion for summary judgment on the antitrust counterclaim. The only issue presented by this appeal is the district court's resolution of the copyright infringement claims.

the BAPCO and Donnelley directories. From the process by which Donnelley prepared its competitive yellow pages directory, the district court identified three acts of copying: (1) the entry of subscriber information into the computer data base by ACS; (2) the printout of sales lead sheets from this data base; and (3) the publication of Donnelley's directory. Based on these acts of copying, the court granted BAPCO's motion for summary judgment on its copyright infringement claims.[5] Donnelley appealed the district court's resolution of the parties' motions on the copyright claim.[6]

III. DISCUSSION

A. *Feist Publications* and the Requirement of Originality

In *Feist Publications*, the Supreme Court clarified the scope of copyright protection afforded to factual compilations. Rural Telephone Service Company ("Rural") claimed that Feist Publications, Inc. ("Feist") infringed Rural's copyright by using names and telephone number listings from Rural's white pages directory to compile its own white pages directory. Observing the inherent tension between the axiom of copyright law that facts are not copyrightable[7] and the principle that compilations of

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[5] In granting summary judgment in favor of BAPCO, the district court rejected, as a matter of law, Donnelley's fair use and antitrust, or misuse of copyright, affirmative defenses. Because we hold that summary judgment should have been granted in favor of Donnelley on BAPCO's copyright claim, we do not reach the issue of whether Donnelley's defenses were properly rejected on summary judgment.

[6] The judgment of the district court was affirmed by a panel of this court, but was subsequently vacated by a grant of rehearing en banc. *Bellsouth Adv. & Pub. Corp. v. Donnelley Inf. Pub., Inc.*, 933 F.2d 952 (11th Cir.1991), *vacated and reh'g en banc granted*, 977 F.2d 1435 (11th Cir.1992).

[7] *See* 17 U.S.C. § 102(b).

fact generally are copyrightable, the Court identified those components of a factual compilation that may, under certain circumstances, receive copyright protection. —— U.S. at ——, 111 S.Ct. at 1287.

The Court stressed that "[t]he *sine qua non* of copyright is originality." —— U.S. at ——, 111 S.Ct. at 1287.[8] "Facts, whether alone or as a part of a compilation, are not original and therefore may not be copyrighted." —— U.S. at ——, 111 S.Ct. at 1290. Drawing upon the requirement of originality and the definition of "compilation" in the Copyright Act,[9] the Court held that a compiler's selection, arrangement and coordination, if original, are the only protectable elements of a factual compilation. —— U.S. at ——, 111 S.Ct. at 1289.[10]

Applying the requirement of originality to the directory compiled by Rural, the Court noted that the listings, consisting of subscribers' names, towns of residence, and telephone numbers, were uncopyrightable facts. Further,

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[8] Moreover, "[o]riginality is a constitutional requirement" for copyright protection implicit in the grant of power to Congress to "secur[e] for limited Times to Authors . . . the exclusive Right to their respective Writings." *Feist*, —— U.S. at ——, 111 S.Ct. at 1288 (quoting U.S. Const. art. I, § 8, cl. 8).

[9] Section 101 of the Copyright Act of 1976 defines a compilation as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. § 101.

[10] In confirming originality as the focus of copyright protection, the Court rejected an alternative theory to justify the protection of factual compilations. Relying upon a doctrine known alternatively as "sweat of the brow" or "industrious collection," some courts had extended copyright protection to every element of a factual compilation based on the labor expended by the author in compiling the constituent facts. By extending copyright protection in a compilation beyond the author's original selection, arrangement, and coordination, this line of cases "eschewed the most fundamental axiom of copyright law—that no one may copyright facts or ideas." —— U.S. at ——, 111 S.Ct. at 1291.

the selection, coordination, and arrangement of Rural's white pages were not sufficiently original to merit copyright protection. "Rural's selection of listings could not be more obvious: it publishes the most basic information—name, town, and telephone number—about each person who applies to it for telephone service." —— U.S. at ——, 111 S.Ct. at 1296. Rural failed to establish any original elements of coordination or arrangement: "there is nothing remotely creative about arranging names alphabetically in a white pages directory. It is an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course." —— U.S. at ——, 111 S.Ct. at 1297. In short, "Rural expended sufficient effort to make the white pages directory useful, but insufficient creativity to make it original." —— U.S. at ——, 111 S.Ct. at 1296.

B. BAPCO's Claim of Infringement

To establish its claim of copyright infringement, BAPCO must prove "(1) ownership of a valid copyright, and (2) copying of constitutional elements of the work that are original." —— U.S. at ——, 111 S.Ct. at 1296. The validity of BAPCO's copyright in its directory, considered as a whole, was conceded by Donnelley.[11] To demonstrate the second element of infringement, BAPCO must prove that Donnelley, by taking the material it copied from the BAPCO directory, appropriated BAPCO's *original* selection, coordination or arrangement.

The district court found that BAPCO engaged in a number of acts of selection in compiling its listings. For example, BAPCO determined the geographic scope of its directory and the closing date after which no changes in listings would be included. *BellSouth Adv. & Pub. Corp. v. Donnelley Inf. Pub., Inc.*, 719 F.Supp. 1551, 1557-58 (S.D.Fla.1988). The district court erred, however, in

[11] Because of the parties' concession, we do not consider whether BAPCO's yellow pages directory, taken as a whole, is copyrightable.

implicitly determining that these selective acts were sufficiently original to merit copyright protection. Rural obviously established a geographic scope and a closing date for its white pages, which were held uncopyrightable as a matter of law in *Feist*. The district court's analysis would protect such factual elements of every compilation; any collection of facts "fixed in any tangible medium of expression" [12] will by necessity have a closing date and, where applicable, a geographic limit selected by the compiler. The district court found that BAPCO "selected" its listings by requiring its yellow pages subscribers to use business telephone service. *Id.* at 1557. The district court also focused on a number of marketing techniques employed by BAPCO to generate its listings, such as the determination of the number of free listings offered to each subscriber, the selection of which customers to contact by an on premise visit from sales personnel, the selection of the date of commencement of its advertisement sales campaign, and the procedure used to recommend the purchase of listings under multiple headings. *Id.* at 1557. The district court again failed to consider whether these "acts of selection" met the level of originality required to extend the protection of copyright to BAPCO's selection.

More fundamental, these acts are not acts of authorship, but techniques for the discovery of facts. In *Feist*, the Court emphasized the distinction "between creation and discovery: the first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence." —— U.S. at ——, 111 S.Ct. at 1288. By employing its sales strategies, BAPCO discovered that certain subscribers describe their businesses in a particular fashion and were willing to pay for a certain number of listings under certain available business descriptions. To be sure, BAPCO employed a set of strategies or techniques for discovering this data. Any

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[12] 17 U.S.C. § 102(a).

useful collection of facts, however, will be shaped by a number of decisions regarding the optimal manner in which to collect the pertinent data in the most efficient and accurate manner. If this were sufficient, then the protection of copyright would extend to census data, cited in *Feist* as a paradigmatic example of a work that lacks the requisite originality. —— U.S. at ——, 111 S.Ct. at 1288. Just as the Copyright Act does not protect "industrious collection," it affords no shelter to the resourceful, efficient, or creative collector. *See Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1372 (5th Cir. July 1981) ("The valuable distinction in copyright law between facts and the expression of facts cannot be maintained if research is held to be copyrightable."). The protection of copyright must inhere in a creatively original *selection* of facts to be reported and not in the creative means used to discover those facts. *See* 17 U.S.C. § 102 (b) ("In no case does copyright protection . . . extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work"). Ultimately, the district court erred by extending the protection of copyright to the collection of facts in the BAPCO directory based on the uncopyrightable formative acts used to generate those listings.

In addition to these acts of selection, the district court found that BAPCO engaged in feats of coordination and arrangement to generate its yellow pages directory. The court explains that BAPCO arranged its directory into an alphabetized list of business types, with individual businesses listed in alphabetical order under the applicable heading. The Copyright Act protects "original works of authorship." 17 U.S.C. § 102(a). BAPCO's arrangement and coordination is "entirely typical" for a business directory. *Feist*, —— U.S. at ——, 111 S.Ct. at 1296.[13]

[13] While the listings in BAPCO's yellow pages required somewhat more organization and arrangement than the white pages

With respect to business telephone directories, such an arrangement "is not only unoriginal, it is practically inevitable." —— U.S. at ——, 111 S.Ct. at 1297.

BAPCO's claim of copyright in the arrangement of its directory also does not survive application of the "merger" doctrine. Under the merger doctrine, "expression is not protected in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself." *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991).[14] *See also Baker v. Selden*,

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directory considered in *Feist*, BAPCO's claim of "originality" must be resolved by comparison to other business telephone directories. BAPCO did not deviate from the arrangement of the typical business directory, which employs an alphabetical list of headings to describe the various types of business and then alphabetizes the listings under the appropriate headings.

Applying *Feist*, the Second Circuit declined to extend copyright protection to the selection and arrangement of certain charts displaying the results of horse racing. *Victor Lalli Enters. v. Big Red Apple, Inc.*, 936 F.2d 671, 673-74 (2d Cir.1991). "The format of the charts is a convention: Lalli exercises neither selectivity in what he reports nor creativity in how he reports it." *Id.* at 673. Similarly, the Ninth Circuit rejected a claim that two automobile catalogs listing replacement radiators and associated parts were substantially similar. *Cooling Systems and Flexibles, Inc. v. Stuart Radiator*, 777 F.2d 485, 491 (9th Cir.1985). Although both works were arranged into three sections (an illustrations section, an original equipment manufacturer section, and an applications section), the court found that this arrangement was obligatory for a useful radiator parts catalog. "[T]he fewer the methods of expressing an idea, the more the allegedly infringing work must resemble the copyrighted work in order to establish substantial similarity." *Id.* at 491. A subsequent collector is not required to arrange its compilation in a fashion not usable by those for whom it is intended. *Id.* at 492. The format of a typical business telephone directory is even more obvious and well-established than the radiator catalogs at issue in *Cooling Systems*.

[14] *See Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458, 1463-64 (5th Cir.) (applying merger doctrine where idea of locating pipeline along certain route was inseparable from

101 U.S. (11 Otto) 99, 25 L.Ed. 841 (1879). Because this is the one way to construct a useful business directory, the arrangement has "merged" with the idea of a business directory, and thus is uncopyrightable.[15]

The district court's suggestion that BAPCO could have arranged its headings according to the number of advertisers or to list its subscribers under each heading according to the length of time for which that subscriber had appeared under that heading misapprehends the ques-

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expression of the route on a topographical map), *cert. denied*, 498 U.S. 952, 111 S.Ct. 374, 112 L.Ed.2d 336 (1990). *See also Educational Testing Services v. Katzman*, 793 F.2d 533, 539 (3d Cir.1986); *Toro Co. v. R & R Products Co.*, 787 F.2d 1208, 1212 (8th Cir. 1986).

[15] In *Matthew Bender & Co. v. Kluwer Law Book Publishers, Inc.*, 672 F.Supp. 107 (S.D.N.Y.1987), the court considered the application of the merger doctrine to a claim of copyright in a system of charts displaying information regarding the amount of recovery in previous personal injury cases. Both the plaintiff's work and that of the alleged infringer divided the cases into chapters corresponding to the part of the body injured and further divided the cases within each chapter based on whether the recovery was a result of a settlement, or an "adequate," "inadequate," or "excessive" award. 672 F.Supp. at 108. Both works listed the cases according to forum state, arranging awards from the same state from largest to smallest amount. In both collections, information regarding each case was organized into categories for amount, case name, plaintiff, event, injury, and further relevant data. The court rejected the plaintiff's claim of copyright, concluding that the plaintiff's work employed one of the few practical and useful means of organizing data regarding personal injury awards. The idea and the expression of such a work thus "merged." *Id.* at 109-110. Further, the information selected for display about each case was obvious and did not demonstrate the original selection, arrangement or coordination required for copyright protection. *Id.* at 112. *See also Coates-Freeman Assocs., Inc. v. Polaroid Corp.*, 792 F.Supp. 879, 883-84 (D.Mass.1992) (placement of decision-making steps on chart purporting to categorize leadership styles was not copyrightable feature where selection of those particular steps out of a universe of very limited options resulted in merger of any creativity into basic idea of chart).

tion. The relevant inquiry is not whether there is some imaginable, although manifestly less useful, method of arranging business telephone listings. In *Feist,* Rural could have published multiple directories for its service area or listed its numbers in numerical order, by age, or by neighborhood within a single directory. The pertinent inquiry is whether the compiler has demonstrated originality, the *"sine qua non"* of copyright, in *its* arrangement or coordination. The arrangement of BAPCO's yellow pages, like that of Rural's white pages is "entirely typical" of its respective type.

The district court also identified acts of coordination and arrangement in the particular system of headings used in the BAPCO directory. The district court appears to find that, when Donnelley entered the listing information from the BAPCO directory, it also copied the particular heading under which that listing appeared in the BAPCO directory. 719 F.Supp. at 1558-59.[16] BAPCO, however, failed to introduce evidence sufficient to establish a genuine dispute of material fact as to whether Donnelley copied the particular heading structure employed by BAPCO. Donnelley stipulated that it obtained the "business type" for each listing from the BAPCO directory. R1-8. The evidence submitted to the district court in the form of affidavit, deposition, and witness testimony reveals that Donnelley established its own system of headings and that, in constructing its data base, Donnelley en-

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[16] Significantly, BAPCO registered no claim of copyright in the glossary of terms used to describe the types of businesses represented by its listings. BAPCO claims that Donnelley infringed its putative copyright in its directory (the *only* claim of copyright before the court) by somehow copying the directory onto the sales lead sheets (Appendix B). This argument highlights the fundamental misconception of the nature and scope of a compilation copyright. A comparison of the Donnelley sales lead sheets and the BAPCO directory pages (Appendix C) manifests no substantial similarity as to those copyrightable elements of a compilation. The dissent continues to confuse and merge the copying of uncopyrightable data with the replication of the copyrightable elements of a compilation.

tered, with each BAPCO listing, an alphanumeric code that corresponded to the *Donnelley* heading. 5SR2, pp. 183-85; 1SR-434, pp. 76-77, 143-44; 1SR-435, pp. 253-54 and Ex. 278; Deposition of John Notestein, pp. 10, 12, 14-15, 22. Further, the sales lead sheets generated by Donnelley from its database, as well as pages of the respective directories submitted to the district court, illustrate that Donnelley selected a somewhat different category of headings to describe the listings originally appearing in the BAPCO directory.[17] Considering the extent to which the heading structure of a classified business directory is dictated by functional considerations and common industry practice, the differences apparent in the glossary of headings employed by Donnelley are sufficient to rebut any inference of copying that otherwise might be drawn from those terms that are common to both directories.[18] In sum, the evidence before the district court requires the conclusion that, by determining the type of business of each subscriber by observation of the BAPCO directory and translating that business type into an encoded heading of its own creation, Donnelley extracted uncopyrightable information regarding the business activities of BAPCO's subscribers without appropriating any arguably original, protectable expressive element in the BAPCO glossary of headings.

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[17] Despite the dissent's belief to the contrary, our opinion is based on the evidence that was before the district court, including a number of sales lead sheets (Appendix B) and pages from both directories (Appendix C).

[18] Where the form of expression is largely prescribed by functional constraints, the similarity of expression in a subsequent work must be very close in order to establish infringement. "Factual works are different [from works of fiction]. Subsequent authors wishing to express the ideas contained in a factual work often can choose from only a narrow range of expression. . . . Therefore, similarity of expression may have to amount to verbatim reproduction or very close paraphrasing before a factual work will be deemed infringed." *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 488 (9th Cir.1984).

Further, BAPCO failed to present evidence that, even if copied, its heading structure constitutes original expression warranting copyright protection. Initially, many of the selected headings, for example "Attorneys" or "Banks," represent such an obvious label for the entities appearing under these headings as to lack the requisite originality for copyright protection.[19] BAPCO can claim no copyright in the idea of dividing churches by denomination or attorneys by area of speciality. Further, any expressive act in including a category such as "Banks" or in dividing "Attorneys" into categories such as "Bankruptcy" or "Criminal Law" would lose copyright protection because it would merge with the idea of listing such entities as a class of businesses in a business directory.[20] The evidence submitted by Donnelley also establishes that many of BAPCO's headings result from certain standard industry practices, such as the recommendations of the National Yellow Pages Sales Association, with regard to the selection and phrasing of headings in business directories. Finally, as established by the testimony of BAPCO's representatives, the ultimate appearance of a particular subscriber under a certain heading is determined by the subscriber's willingness to purchase those listings in the BAPCO directory. While BAPCO may select the headings that are *offered* to the subscriber, it is the subscriber who selects from those alternatives the headings under which the subscriber will appear in the copyrighted directory. The headings that actually appear in the directory thus, do not owe their origin to BAPCO and BAPCO has claimed no copyright in the

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[19] *See Sem-Torq, Inc. v. K Mart Corp.*, 936 F.2d 851, 854-55 (6th Cir.1991) (copyright law does not protect "forms of expression dictated solely by functional considerations").

[20] *See Matthew Bender*, 672 F.Supp. at 111 (Under merger doctrine, plaintiff could claim no copyright protection in headings used to display data regarding personal injury awards where "terms employed are the most logical and clear way of expressing the idea to be conveyed . . . . [and] these terms, or synonyms for them, are the only way of conveying the desired information.").

larger universe of headings that are offered to subscribers. Thus, the elements of selection, coordination and arrangement identified by the district court, and purportedly copied by Donnelley, as a matter of law, do not display the originality required to merit copyright protection.

Although purporting to consider whether Donnelley copied the original elements of selection, arrangement or coordination from the BAPCO directory, the opinion of the district court rests, at least in part, on a comparison of the appearance of corresponding pages from both directories.[21] For example, the court concluded that "Donnelley used a format nearly identical to that used by BAPCO" and that "although Donnelley's directory is not identical to BAPCO's directory, the material was copied and used to produce a directory substantially similar in both content and format." 719 F.Supp. at 1559. The district court erred, however, by failing to consider the degree to which the similarity between the two directories was due to Donnelley's use of the copyrightable facts, such as name, number, address, and business type, from the BAPCO directory. Further, to the extent that this similarity of format was due to the common arrangement and coordination of the two directories into alphabetized business classifications, with alphabetized listings under each classification, the district court erred by extending the scope of BAPCO's copyright to capture the system of organization common to all classified directories from the

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[21] A comparison of corresponding pages from the two directories, which were before the district court as set out in Appendix C, reveals several obvious differences in type-face and graphic layout. Donnelley included different advertisements, not only in content, but in number and design. BAPCO underlines its headings while Donnelley marks its headings with a sideways triangle. Donnelley uses a different type face. Whatever original authorship is represented by these types of presentation choices was clearly not copied by Donnelley. Further, the sales lead sheets (attached in Appendix B) produced from the ACS data base are obviously not similar in appearance or arrangement to BAPCO's directory, in which its claim of copyright was registered.

public domain. Moreover, the other elements of format common to the two directories, such as the organization of listings into four columns, are also manifestly typical, obvious and unoriginal.

By comparing the overall appearance of the two directories through its comparison of the corresponding pages, the district court effectively failed to consider whether Donnelley copied the "constituent elements of the work that are original." *Feist*, —— U.S. at ——, 111 S.Ct. at 1296. In the case of a factual compilation, a comparison of the copyright holder's work with that of the alleged infringer must distinguish similarities attributable to ideas, which are unprotected *per se*, or to expression not owned by the copyright holder, from those similarities resulting from the copying of the compiler's original elements.[22] We consider this conclusion to be compelled by section 103(b) of the Copyright Act, which directs that "[t]he copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material." 17 U.S.C. § 103(b).

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[22] The Second Circuit has observed:

> Although the test for infringement of original works and compilations is one of "substantial similarity," the appropriate inquiry is narrowed in the case of a compilation. As noted, the components of a compilation are generally in the public domain, and a finding of substantial similarity or even absolute identity as to matters in the public domain will not suffice to prove infringement. What must be shown is substantial similarity between those elements, and only those elements, that provide copyrightability to the allegedly infringed compilation.

Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc., 945 F.2d 509, 514 (2nd Cir.1991) (citations omitted). *See also Cooling Systems*, 777 F.2d at 492-93 ("What is important is not whether there is substantial similarity in the total concept and feel of the works, but whether the very small amount of protectable expression in Cooling Systems' catalog is substantially similar to the equivalent portions of Stuart's catalog.") (citation omitted).

We note that Donnelley did not copy, nor was alleged to have copied, the text or graphic material from the advertisements in the BAPCO directory, the positioning of these advertisements, the typefaces, or the textual material included by BAPCO to assist the user. Unlike the infringer in *Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers*, 756 F.2d 801 (11th Cir.1985), Donnelley did not photocopy, or reproduce by any equivalent means, the page by page arrangement or appearance of its competitor's directory in the process of creating its own work. Although the amount of material taken from the BAPCO directory was substantial in a purely quantitative sense, Donnelley did not, by this process, appropriate whatever original elements might arguably inhere in the BAPCO directory. That a competitor might take the bulk of the factual material from a preexisting compilation without infringement of the author's copyright is not surprising, given that the copyright protection of a factual compilation is "thin." *Feist*, —— U.S. at ——, 111 S.Ct. at 1289. It may seem unfair that a compiler's labor may be used by a competitor without compensation. As noted by the Court in *Feist*, "[t]he primary objective of copyright is not to reward the labor of authors, but '[t]o promote the Progress of Science and useful Arts." —— U.S. at ——, 111 S.Ct. at 1290 (quoting U.S. Const. art. I, § 8, cl. 8). "To this end, copyright assures authors the right to their *original* expression, but encourages others to build freely upon the ideas and information conveyed by a work." *Id.* (emphasis added). *See also Harper & Row, Publishers v. Nation Enterprises*, 471 U.S. 539, 545-46, 105 S.Ct. 2218, 2223, 85 L.Ed.2d 588 (1985).

IV. CONCLUSION

By copying the name, address, telephone number, business type, and unit of advertisement purchased for each listing in the BAPCO directory,[23] Donnelley copied no original element of selection, coordination or arrangement; Donnelley was thus entitled to summary judgment on BAPCO's claim of copyright infringement.[24] We REVERSE the judgment of the district court granting summary judgment to BAPCO on its claim of copyright infringement and enter judgment in favor of Donnelley on this claim.

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[23] The common errors in the BAPCO and Donnelley listings prove only that, as admitted, Donnelley copied the name, number, address, and type of business from every BAPCO listing. The presence of common errors is not probative of whether the portions of the BAPCO directory copied by Donnelley included the copyrightable elements of original selection, coordination and arrangement. In *Feist*, the alleged infringer copied every listing from the compilers' white pages, including four erroneous listings. —— U.S. at ——, 111 S.Ct. at 1287. Because Rural copied only uncopyrightable facts, however, the presence of common errors was not relevant. *See also* Shira Perlmutter, "The Scope of Copyright in Telephone Directories: Keeping Listing Information in the Public Domain," 38 J. Copyright Society 1, 5-6 (Fall 1990) ("Where, as in *Feist*, the defendant has admitted copying, such evidence is simply irrelevant. Copying of erroneous or fictitious entries has no bearing on the question of whether material admittedly copied is protected by the plaintiff's copyright, and if so, whether the taking is substantial."); Alan Latman, "Probative Similarity as Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement," 90 Columbia L.Rev. 1187, 1204-06 (1990) (distinguishing use of common errors as proof of copying from use as proof of substantial similarity of protected material).

[24] Summary judgment in favor of the defendant in an infringement action is appropriate where the similarity between the two works concerns only uncopyrightable elements of the plaintiff's work. *Arica Inst., Inc. v. Palmer*, 970 F.2d 1067, 1072 (2d Cir. 1992); *Warner Bros., Inc. v. American Broadcasting Cos.*, 720 F.2d 231, 240 (2d Cir.1983).

HATCHETT, Circuit Judge, Dissenting:

The majority's holding establishes a rule of law that transforms the multi-billion dollar classified publishing industry from a business requiring the production of a useful directory based on multiple layers of creative decisionmaking, into a business requiring no more than a successful race to a data processing agency to copy another publisher's copyrighted work-product. In reaching this incredible result, the majority forsakes thoughtful analysis of the evidence under the governing principles articulated in *Feist,* and leaps to a conclusion based on nothing more than its collective judgment of what ought to be copyrightable.

Not only does the majority ignore the evidence presented in the district court, but it also allows the appellant to obtain an outright reversal of the district court with new arguments and supplemental evidence that the district court never considered. In doing so, the majority transforms this en banc appellate court into no more than a multiple judge trial court that allows unsuccessful litigants to have the proverbial 'second bite at the apple.' I cannot join the majority in its disregard for the well-established parameters of appellate review; thus, I respectfully dissent.[1]

DISCUSSION

In order to prevail on a claim of copyright infringement, a plaintiff must prove two elements: (1) that the plaintiff owns a valid copyright in the work; and (2) that the defendant copied "constituent elements of the work that are original." *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, —— U.S. ——, ——, 111 S.Ct. 1282, 1296, 113 L.Ed.2d 358, 379 (1991). Donnelley Information Publishing, Inc. and Reuben H. Donnelley Corporation (collectively "Donnelley") concedes

[1] During the discussion of the evidence presented to the district court, I will also discuss the evidence presented and the new theories advanced at the "en banc trial."

that Bellsouth Advertising & Publishing Corporation ("BAPCO") possesses a valid compilation copyright in the *1984 Greater Miami Yellow Pages (1984 Yellow Pages)*, taken as a whole. Donnelley also stipulated that it copied the following information from the *1984 Yellow Pages* in preparing its "sales lead" sheets: "1. telephone number—under the first column; 2. name—under the second column; 3. address—under the third column; 4. kind of business—under the fourth column; and 5. unit of advertising—under the fifth column." Therefore, based on Donnelley's concessions that BAPCO possesses a valid copyright and its stipulation to copying information from the *1984 Yellow Pages*, this court is only asked to determine whether Donnelley substantially copied constituent elements of the *1984 Yellow Pages* that are original.

I. *Copyrightability of Compilations*

It is settled that compilations of facts are copyrightable, even though the facts themselves are not subject to copyright protection. *Feist Publications*, —— U.S. at ——, 111 S.Ct. at 1287, 113 L.Ed.2d at 368 (discussing the inherent tension between these well-established propositions). The Copyright Act of 1976 defines a copyrightable compilation as "a work formed by the collection and assembly of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. § 101 (1988). Therefore, section 101 identifies three requirements for a compilation to qualify for copyright protection: "(1) the collection and assembly of preexisting material, facts, or data; (2) the selection, coordination, or arrangement of those materials; and (3) the creation, by virtue of the particular selection, coordination, or arrangement, of an 'original' work of authorship." *Feist*, —— U.S. at ——, 111 S.Ct. at 1293, 113 L.Ed.2d at 376.

The Court in *Feist* noted that the "selection, coordination, or arrangement" requirement is the key to determin-

ing whether a work qualifies as a copyrightable compilation. *See Feist,* —— U.S. at ——, 111 S.Ct. at 1294, 113 L.Ed.2d at 377 (explaining that "facts are never original, so the compilation author can claim originality, if at all, only in the way that the facts are presented"). The Court in *Feist* emphasized that "the originality requirement is not particularly stringent." *See Feist,* —— U.S. at ——, 111 S.Ct. at 1294, 113 L.Ed.2d at 377 (explaining that originality means only that a compiler selects or arranges independently and displays some minimal level of creativity, even if the compiler settles upon a selection or arrangement that others have used). In addition, the Court in *Feist* noted that a copyrightable compilation is protected only to the extent of the author's "original" selection, coordination, or arrangement. *See Feist,* —— U.S. at ——, 111 S.Ct. at 1295, 113 L.Ed.2d at 378. Accordingly, this court must first determine what particular elements of BAPCO's selection, coordination, and arrangements of preexisting facts in the *1984 Yellow Pages* are sufficiently original to merit copyright protection.

II. *Original Selection, Coordination, or Arrangement*

Based on the undisputed facts, the district court concluded that BAPCO performed the following acts of selection, coordination, or arrangement, which were sufficiently original to merit copyright protection: (1) the selection of the geographic scope of businesses to be covered in the directory; (2) the selection of the number of free listings for businesses in the covered area; (3) the selection of only businesses with business telephone service for advertisements in the directory; (4) the selection of a menu of classified headings that would be available for business listings; (5) the selection of the criteria for determining whether a business may advertise under a particular classified heading; (6) the selection of the classified headings that would be recommended to a particular

business customer; (7) the selection of customers who would receive on-premise sales contact, telephone sales contact, or no contact; (8) the selection of the dates for the beginning and closing of the sales campaign for advertisements in the directory; and (9) the arrangement of all of the business listings under a particular heading, in alphabetical order. *See BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*, 719 F.Supp. 1551, 1557-58 (S.D.Fla.1988).

The panel agreed that the *1984 Yellow Pages* constituted a copyrightable compilation, identifying the following acts of selection, coordination, or arrangement as sufficiently original: (1) selection of the geographic scope of businesses to be included in the directory; (2) selection of a directory close date as a limit on modifications that would be reflected in a pending directory publication; (3) the creation or selection of numerous classified headings that would be available for business listings; (4) the coordination of all the informational components—name, address, and telephone number—of a particular business into one complete business listing; and (5) the arrangement of all coordinated business listings under the appropriate classified headings. *See Bellsouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*, 933 F.2d 952, 957-58 (11th Cir. 1991), *vacated and reh'g en banc granted*, 977 F.2d 1435 (11th Cir. 1992).

Donnelley challenges the district court's and panel's holding that BAPCO performed sufficiently original acts of selection, coordination, or arrangement to merit copyright protection for the *1984 Yellow Pages*. Donnelley argues that the district court erred in identifying BAPCO's alphabetizing of the listings and classified headings as contributing to the originality of the directory. Donnelley also argues that the district court erred in characterizing BAPCO's decisions to offer one free listing, to include

only business telephone service subscribers, and decisions on soliciting advertisements as acts of selection "fixed" in the *1984 Yellow Pages,* as opposed to invisible business decisions. In addition, Donnelley argues that the panel erred in identifying BAPCO's coordination of the informational components—name, address, and telephone number—of a particular business as an original act of coordination. Moreover, Donnelley argues that both the district court and the panel erred in identifying BAPCO's selection of a geographic scope, selection of classified headings, and arrangement of all business listings under a particular classified heading as "original" acts of selection or arrangement.

BAPCO responds that the district court and panel correctly concluded that BAPCO's acts of selection, coordination, or arrangement were sufficiently original to be copyrightable. BAPCO analogizes the so-called "business decisions" with the techniques that a photographer uses in taking a picture. As the techniques of the photographer affect the photograph, BAPCO argues that the published *1984 Yellow Pages* would have been completely different if BAPCO had selected a different geographic scope, permitted residential telephone service subscribers to be listed, chosen a different closing date, elected not to provide a free listing, changed its available menu of classified headings, engaged in different marketing efforts to sell business listings, excluded businesses listings from nearby communities such as Fort Lauderdale, excluded listings of national businesses, or permitted arrangements between the available classified headings and business listings.

Donnelley is correct to assert that the holding in *Feist* precludes this court from concluding that BAPCO satisfied the originality requirement based on the mere alphabetizing of business listings and classified headings, or based on the mere coordination of the name, address, and telephone number of a particular business into one com-

plete business listing. *See Feist,* —— U.S. at ——, 111 S.Ct. at 1297, 113 L.Ed.2d at 380-81 (holding that a telephone company's white pages lack the requisite originality for copyright protection where the telephone company merely published basic subscriber information—name, town, and telephone number—and arranged it alphabetically based on surnames).

Donnelley is also correct to assert that the district court erred in characterizing BAPCO's decision to offer one free listing and decisions on the dates and procedures for soliciting advertisements as original acts of "selection." "Selection implies the exercise of judgment in choosing which facts from a given body of data to include in a compilation." *Key Publications v. Chinatown Today Publishing Enterprises, Inc.,* 945 F.2d 509, 513 (2d Cir. 1991) (citations omitted). BAPCO's decisions regarding a free listing and solicitation procedures did not entail the exercise of judgment in choosing among facts to be included in its directories. "Selection" is not an appropriate term to describe the choices to include *all* of the data in a given body of data, on a given date. Instead of acts of selection, these BAPCO's decisions are more closely analogous to ideas or procedures for reliably and profitably collecting facts. As ideas or procedures, BAPCO's decision to offer a free listing and its decisions regarding soliciting advertisements, are not copyrightable. *See* 17 U.S.C. § 102(b) (providing that no copyright protection for an original work of authorship extends to any "idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work").

However, even ignoring these erroneously identified acts of selection, coordination, or arrangement, BAPCO's other acts of selection and arrangement in compiling the *1984 Yellow Pages* were sufficient originality to merit copyright protection under *Feist.*

A. *Selection of Classified Headings*

The clearest example of BAPCO's original selection is its choice of the classified headings that would be included in the *1984 Yellow Pages. Accord Key Publications,* 945 F.2d at 514 (holding that a publisher's selection of 260 different categories, even if including particular categories that have been used in other directories, involved sufficient creativity to contribute to the overall originality of a classified directory). BAPCO selected the approximate 7,000 classified heading in the *1984 Yellow Pages* from the 4,700 primary headings and approximately 34,000 related headings in the BAPCO headings book. BAPCO presented the undisputed testimony of Gerald Brown that the BAPCO headings book is not standardized to coincide with the menu of classified headings used in National Yellow Page Sales Association (NYPSA) publications. Moreover, even if BAPCO's selection of classified headings is similar to other NYPSA publications, it would still be copyrightable under *Feist* so long as BAPCO selected independently. *See Feist,* —— U.S. at ——, 111 S.Ct. at 1287, 113 L.Ed.2d at 369 (holding that "originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying").[2]

In addition, the testimony of Donnelley's own witness supports the district court's conclusion that BAPCO's selection of headings constituted an original act of selection. Donnelley's corporate representative, Jon Notestein, responded to a question about whether Donnelley created its headings especially for the Donnelley Miami directory, with the following statement: "What we have learned in this business after 99 years is that individual markets may

[2] In reasoning that BAPCO's selection of headings lack originality because many resemble NYPSA headings, the majority completely ignores the *Feist* Court's holding that an independent selection of data need not be "novel" in order to be deemed original. See Majority Slip op. at p. 3097.

have local terminology that reflect differently in different parts of the country. So, yes, I'm sure we have created some headings, classifications to represent types of business that we didn't normally use in Donnelley in the Mid-west, for example." *See Deposition of Jon Notestein*, p. 50. In further describing the process of particularizing headings for a specific directory, Notestein explained that Donnelley maintains a list of over 7,000 headings that are generally applied across the country, but "in the end the type of business appears in our directory is a reflection of the marketing and needs of the market and users of the product. It is an ongoing process changing every day." *See* Deposition of Jon Notestein, p. 51 (also stating that Donnelley probably selected its headings for Miami from "looking at" the *1984 Yellow Pages*).

On appeal, Donnelley appears to concede that copyright protection extends to a publisher's selection of which headings to include in a particular classified directory, arguing instead that it did not copy BAPCO's selection of classified headings. Donnelley asserts that its *1985 Miami North* directory contains approximately 4,000 headings and that its *1985 Miami South* directory contains approximately 4,300 headings, as compared to the 7,000 headings in BAPCO's *1984 Yellow Pages*. Even though more relevant to the separate issue of substantial copying, Donnelley's assertion that it independently selected a substantially smaller and distinct "universe" of classified headings underscores the originality, and thus copyrightability of BAPCO's selection of headings.[3]

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[3] In reaching its over-broad conclusion that none of BAPCO's selection, coordination, or arrangement is copyrightable, the majority merges the issues of originality and substantial copying. In doing so, the majority allows Donnelley to defeat BAPCO's claim of original selection, the first issue before this court, based on new evidence presented for the first time on appeal that relates mainly to the second, substantial similarity issue. Regarding the substantial similarity issue, the majority concludes that Donnelley presented

B. *Categorizing Businesses Under Classified Headings*

The originality of BAPCO's arrangement of business listings under a particular classified heading is also clear under the standard definition of "arrangement" in the copyright laws. "Arrangement 'refers to the ordering or grouping of data into lists or categories that go beyond the mere mechanical grouping of data as such, for example, the alphabetical, chronological, or sequential listings of data.'" *Key Publications*, 945 F.2d at 513-14 (quoting Copyright Office, *Guidelines for Registration of Fact-Based Compilations 1* (Rev. Oct. 11, 1989)). In this case, BAPCO presented the undisputed affidavit testimony of its General Manager-Publishing, Bob Johnson, regarding BAPCO's grouping of listings under a particular classified heading. *See* Exhibit A to Donnelley's En Banc Brief (copy of *Affidavit of Bob Johnson*). Because most business subscribers offer multiple product lines, goods, and services, Johnson testified that BAPCO sales representatives were responsible for itemizing the products or services of a business subscriber, determining the degree of importance or profitability to the business, and recommending an appropriate classified heading for listing the business in the *1984 Yellow Pages*. Johnson further testified that BAPCO annually updates and publishes

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evidence showing that it "established its own system of headings." The majority relies on citations to the record that Donnelley uses in support of its new assertion that it selected "a smaller universe" of classified headings. *See* Majority Slip op. at 3096-97. The majority's reliance on these citations is misplaced for two reasons. First, as BAPCO argues, none of Donnelley's citations actually support the "smaller universe" assertion. *See* BAPCO En Banc Brief at p. 3 (compiling all portions of the record that Donnelley cites as "Exhibit 2"). Moreover, as discussed fully in section III-A, the relevant question is whether Donnelley proved that it selected a menu of classified headings for particular use in compiling its South Florida directories, *not* whether Donnelley entered codes corresponding to a general universe of headings in the Donnelley heading book.

its heading book in order to provide sales representatives with a quick-reference of the approximately 34,000 authorized BAPCO "related headings" for making recommendations to businesses about additional listings.

Moreover, Johnson's statements about the skill and judgment that BAPCO sales representatives exercise in recommending appropriate related headings is supported in the statistics that he provided about the *1984 Yellow Pages*. Johnson testified that the resulting *1984 Yellow Pages* included 56,459 free business listings and 49,939 paid listings from a total of 32,559 local, foreign, and national business subscribers. These statistics on total listings and advertisers highlight the fundamental error in the majority's conclusion that BAPCO's grouping of business listings under classified hearings is not an original act of arrangement. Using Donnelley's figure of approximately 7,000 classified headings in the *1984 Yellow Pages*, it defies logic to conclude that BAPCO's grouping of over 106,398 business listings from 32,559 different businesses, under approximately 7,000 classified hearings amounts to no more than mechanical grouping of data. The numbers alone indicate that BAPCO had numerous options for grouping the 106,398 listings among the 7,000 classified headings.

Beyond statistics, however, BAPCO presented the district court with conclusive evidence concerning the originality of its groupings of business listings under classified headings. BAPCO attached to Johnson's affidavit a sample page from its heading book, which includes the primary heading of "Bakers-Retail" and related headings including "Biscuits," "Cakes," "Pastries," "Bagels," "Candy & Confectionery," "Caterers," "Cookies & Crackers," "Delicatessens," "Donuts," "Food Products," "Foods-Carry Out," "Grocers-Retail," "Health & Diet Food Products-Retail," "Pies," "Pretzels," "Restaurants," "Sandwiches," "Snack Products," "Wedding Supplies & Serv-

ices." Although some primary entries on the sample page contain less related headings than the "Bakers-Retail" example, other primary headings contain more related heading options. Hence, the "Bakers-Retail" example provides a representative illustration of the wide-ranging choices that BAPCO sales representatives made in categorizing the 32,559 businesses under the appropriate related headings from the approximately 34,000 options in the heading book. With so many related headings to describe a business principally known as a bakery, BAPCO's arrangement of the listing of a particular bakery under one, two, three, four, or more headings is neither "obvious" nor "practically inevitable" as defined in *Feist*. *See Feist*, —— U.S. at ——, 111 S.Ct. at 1297, 113 L.Ed.2d at 380. Accordingly, the evidence is clear that BAPCO's arrangement was in no sense mechanical. On the contrary, the *1984 Yellow Pages* reflects several layers of BAPCO choices on grouping 106,398 business listings under approximately 7,000 classified headings, which BAPCO selected from a heading book containing 4,700 primary entries and 34,000 related headings. *Accord Key Publications*, 945 F.2d at 514 (holding that a classified publisher's grouping of over 9,000 listings into approximately 260 different categories constituted original arrangement entitled to copyright protection).

Donnelley challenges BAPCO's evidence of an original arrangement with repeated assertions that the businesses themselves, not BAPCO, selected the appropriate classified heading or headings with which to describe their businesses. In its reply brief to the panel, Donnelley conceded that if BAPCO supported its "belated allegation that *BAPCO* selects the headings, there would result a material issue of fact, making summary judgment improper on the issue of infringement." Donnelley Panel Reply Brief at p. 13. The evidence before the district court not only supports BAPCO's so-called "belated allegation," but the only evidence presented to the district court conclusively

establishes that BAPCO makes the final decisions on whether to list a business under a particular classified heading.[4]

Donnelley does not point to any independent evidence that it presented on the issue, but relies on testimony that it elicited from BAPCO's General Manager-Directory, Gerald Brown, during the October, 1985, preliminary injunction hearing. Specifically, Donnelley relies on Brown's statements that customers generally select additional classified headings in the course of a sales presentation by a BAPCO employee, and his statement that the owner of Havana Welding made the decision to be listed under ten different headings, including "Exporter," with the guidance of a BAPCO sales person. Based on Brown's testimony about a business owner's role and the fact that business owners pay BAPCO for the additional listings, Donnelley argues that "it defies logic to even suppose that [businesses] would leave to a directory publisher any discretion to decide what business they are in."

Donnelley's argument completely ignores the undisputed evidence that BAPCO presented on the editorial role of its Heading Committee in arranging business listings under a particular classified heading.[5] In addition to discussing the role of a BAPCO sales representative in recommending related headings to businesses, Gerald Brown testified via deposition that BAPCO's Heading Committee had the final responsibility for deciding whether a requested classified heading was appropriate for inclusion in the

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[4] The majority summarily concludes that "it is the subscriber who selects" a particular classified heading without any discussion of BAPCO's evidence on this issue. *See* Majority Slip op. at p. 3098.

[5] The majority blindly accepts Donnelley's argument that BAPCO surrenders ultimate editorial authority to advertisers without any consideration of BAPCO's obvious need to maintain final editorial discretion in order to protect the integrity and accuracy of its compilation.

1984 Yellow Pages. Brown further testified that a business's willingness to pay for a listing under a particular classified heading did not influence the Heading Committee's decision on whether to approve the proposed new heading. Moreover, during the October, 1985, preliminary injunction hearing, Brown responded to questions about whether BAPCO allowed businesses to make final decisions on a particular heading based on their willingness to pay for the advertisement. In response to a question on redirect, Brown testified that BAPCO would not allow businesses to select classified headings under a particular category that is totally incorrect, responding to the extreme example of a butcher who asked to be listed as a plumber. *See* 5SR2-4, p. 133. On recross-examination, Brown responded to a more subtle example stating that BAPCO would allow a butcher to be listed as a delicatessen only if the butcher was in fact a delicatessen, regardless of the butcher's willingness to pay for a full-page ad under the "Delicatessen" heading. *See* 5SR2-4, pp. 133-34. Donnelley fails to point to any evidence contradicting Brown's testimony regarding the final editorial authority of the Heading Committee on whether a business would be grouped under a particular classified heading.

Therefore, the uncontroverted testimony in this case proves that BAPCO performed an original act of arrangement in deciding how to group appropriately the 106,398 business listings from 32,559 businesses, under the approximate 7,000 classified headings in the *1984 Yellow Pages.*

C. *Selection of Only Businesses with Business Telephone Service*

BAPCO's selection of only businesses with business telephone service, as opposed to residential service, is also an act of selection contributing to the originality of the *1984 Yellow Pages.* As noted earlier, selection involves "the exercise of judgment in choosing which facts from a

given body of data to include in a compilation." *See Key Publications,* 945 F.2d at 513. BAPCO exercised such judgment in choosing only business service subscribers from the body of data including both business and residential subscribers for inclusion in the *1984 Yellow Pages.* The originality is BAPCO's choice is amply demonstrated in the fact that Donnelley, unlike BAPCO, would accept listings and advertising from residential telephone service subscribers in addition to business telephone service subscribers. For example, the Assistant Vice-President and General Manager of the Southeast Operation of Donnelley Information Publishing, Louis Sudholz, testified about the disparate treatment of a hypothetical prospective customer, "John, the painter." Sudholz testified that Donnelley, unlike BAPCO, would include "John, the painter" in its directory, regardless of Donnelley's discovery that John does not have a business telephone and operates out of a shed in his backyard. *See* 5SR2-4, pp. 194-95. Based on the different choices of two competing classified publishers, it is clear that BAPCO's selection of only businesses with business telephone service represents an exercise of judgment that is in no sense automatic or dictated by functional considerations. Hence, the record also supports the district court's holding that BAPCO's selection of only business telephone subscribers for inclusion in its *1984 Yellow Pages* constitutes an original act of selection contributing to the copyrightability of its compilation.

D. *Selection of a Geographic Area to be Covered Comprehensively*

Although a closer question, BAPCO's geographic scoping also represents an original act of selection. BAPCO asserts that its selection of a geographic scope refers to a choice about what geographic region would be covered comprehensively in the *1984 Yellow Pages.* BAPCO argues that its selection of a geographic area is not determined simply based on the scope of a white-page directory for the same community, but is instead selected based

on BAPCO's evaluation of the shopping habits and desired shopping areas of consumers within a white-pages community. Donnelley responds that geographic scoping merely refers to BAPCO's decision about the geographic area for free distribution of copies of its *1984 Yellow Pages*. Donnelley further asserts that BAPCO did not, in fact, limit advertisements in its directory to businesses in a particular area. Based on Bob Johnson's affidavit testimony that the *1984 Yellow Pages* contains advertisements from 1,772 businesses in nearby cities and from 2,215 national businesses, the evidence supports Donnelley's assertion that BAPCO did not limit classified listings to only businesses in a certain geographic area. Johnson's testimony also demonstrates that BAPCO solicited, not selected, the advertisements from national businesses and businesses in nearby cities. However, the fact that BAPCO did not limit its *1984 Yellow Pages* exclusively to greater Miami businesses does not dispose of the issue, because BAPCO's claim of copyrightability is based on its selection of *an area*, not individual businesses, to be covered comprehensively, not exclusively.

The evidence before the district court supports its conclusion that geographic scoping is an original act of selection. Besides BAPCO's evidence, Donnelley presented evidence on the uniqueness of its different scoping choice to cover the greater Miami area in two North and South Miami regions. In addition, Donnelley elicited testimony from Louis Sudholz on Donnelley's decision to cover the geographic region between Dallas and Fort Worth in a "Mid-City" directory. Based on such evidence of how classified publishers could easily select geographic regions that do not strictly follow the boundaries of cities, it is clear that the selection of a geographic region is not "practically inevitable." *See Feist*, —— U.S. at ——, 111 S.Ct. at 1297, 113 L.Ed.2d at 380 (recognizing that the alphabetizing of names in a white pages is an age-old practice that is unoriginal and practically inevitable).

The evidence before the district court also compels a conclusion that the geographic scoping of a classified directory is not an "obvious" act of selection. *See Feist*, —— U.S. at ——, 111 S.Ct. at 1297, 113 L.Ed.2d at 380 (describing a white-page publisher's selection of basic information—name, town, and telephone number—as "obvious" and lacking sufficient creativity to make it original). On this point, BAPCO presented "Donnelley Directory Publishing Start-Up Business Plan October 21, 1984," which discussed Donnelley's own geographic scoping decisions as being based on "extensive research [leading Donnelley] to scope differently from its competitors." *See* 6SR12-34, *Volume IV—Appendix to Summary Memorandum of Bellsouth Advertising & Publishing Corporation*, p.DM207045 (stating that Donnelley generally will scope to cover areas of two or more telco directories, and stating that "more logical scoping is intended to be a key selling point for [Donnelley]"). Therefore, even though Donnelley now argues that geographic scoping represents an obvious decision lacking a modicum of creativity, the evidence before the district court was uncontroverted that geographic scoping results from thoughtful analysis of research on shopping habits and analysis of how to distinguish one directory from its competitors.[6] Such thoughtful selection is sufficient under *Feist* to contribute to the originality of the *1984 Yellow Pages*. *See Feist*, —— U.S. at ——, 111 S.Ct. at 1294, 113 L.Ed.2d at 377

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[6] The majority reaches the conclusion that geographic scoping is an obvious and inevitable act of selection based on cursory analysis that analogizes the geographic scoping involved in classified directories to the scoping of white pages. However, as the majority points out, this case concerns a "directory of a different color." That distinction requires this court to thoroughly analyze the evidence under the *Feist* principles. Instead of such analysis, the majority's holding appears to be based on the mistaken notion that deciding copyright cases requires no more than an application of the collective common sense of judges.

(explaining that "the originality requirement is not particularly stringent").

In sum, the record on this case demonstrates that BAPCO performed at least four original acts of selection and arrangement: (1) the selection of 7,000 classified headings; (2) the arrangement of 106,398 business listings, from 32,559 businesses under the 7,000 classified headings; (3) the selection of only businesses with business telephone service, as opposed to businesses having either business service or residential service; and (4) the selection of a geographic area to be covered comprehensively in the *1984 Yellow Pages.* Accordingly, I would hold that BAPCO performed four acts of selection or arrangement which are sufficiently original to merit copyright protection. The analysis of BAPCO's infringement claim, however, does not end with a finding of originality. This court must next determine whether Donnelley copied those constituent elements of selection and arrangement which are copyrightable.

III. *Substantial Copying of BAPCO's Original Selection or Arrangement*

Because the copyright in a factual compilation is "thin," a plaintiff must prove "substantial similarity" between the defendant's compilation and the original elements of the plaintiff's compilation. *Key Publications,* 945 F.2d at 514 (adopting the "substantial similarity" test for infringement, and rejecting arguments that *Feist* requires a subsequent compiler to produce an "exact replica" of the copyrighted compilation); *see also* Majority Opinion at n. 21 (citing favorably the *Key Publications* test); *Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers,* 756 F.2d 801, 810-11 (11th Cir.1985) (applying the "substantially similarity" test). Therefore, in order for BAPCO to prevail on its infringement claim, it must prove that Donnelley substantially appropriated the particular elements of selection or arrangement that are orig-

inal. Based on the previous discussion identifying those elements of selection or arrangement that are copyrightable, BAPCO must prove that Donnelley substantially appropriated BAPCO's selection of classified headings, arrangement of business listings under classified headings, selection of only businesses with business telephone service, or selection of a geographic area to be covered comprehensively.

A proper analysis of whether Donnelley substantially appropriated BAPCO's original selection or arrangement requires this court to analyze separately each of the three acts of copying at issue in this case. The district court concluded that Donnelley engaged in the following three acts of copying: (1) hiring Appalachian Computer Services, Inc. (Appalachian), a data entry company in London, Kentucky, to key BAPCO's compilation into a computer database; (2) using the computer database to print out sales lead sheets that represented a reproduction of substantially the entire *1984 Yellow Pages* in inverted or crisscross form; and (3) publishing the *1985 Miami North* and *1985 Miami South* directories based on the information copied into the computer database and onto the sales lead sheets. *See BellSouth*, 719 F.Supp. at 1558-59. Similarly, this court should evaluate each alleged act of copying separately.[7]

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[7] The majority not only merges its analysis of the originality and the substantial similarity issues, as previously noted, the majority also intertwines its slight discussion of Donnelley's first two alleged acts of copying, the computer database and sales lead sheets, with its exhaustive discussion of the lack of similarity between the actual published directories. The majority's focus on the distinguishable features of Donnelley's published directories, with only slight mention of the computer database and sales lead sheets, is not consistent with the development of facts in this case. That is, Donnelley's alleged copying of BAPCO's compilation into the computer database and onto the sales lead sheets occurred before BAPCO filed this action putting Donnelley on notice. Donnelley's actual publication of the 1985 Miami North and 1985 Miami South

A. *Computer Database*

Donnelley does not dispute that it obtained copies of the *1984 Yellow Pages*, separated and mounted each sheet individually, and assigned a classified heading code, advertising code, and directory code for every business listing. It is also undisputed that Appalachian keyed the following information into a computer database: name, address, telephone number, code corresponding to a classified heading, code corresponding to the unit of advertising, and a code for the directory from which the listing came. Appalachian stored this information on magnetic tape and sent it to Donnelley for reproduction in the form of sales lead sheets. The only factual dispute concerning the creation of the computer database derives from Donnelley's assertion that Appalachian entered a code corresponding to a previously chosen Donnelley classified heading, as opposed to a code corresponding to the BAPCO heading directly next to each code.

The record support's Donnelley's version of the alleged factual dispute. Several Donnelley employees testified that Appalachian keyed-in heading codes that corresponded to headings in a Donnelley heading book. For example, Gary Johnson explained that

> if we found a heading on our database that had a heading code which was similar or the same meaning as the BAPCO heading, we used our heading, the Donnelley support file heading. We didn't directly copy the heading from the BAPCO book. We used our heading. This heading code is a Donnelley heading code that applies to a support file, mechanized support file, that we maintain in Terre Haute [, Indiana, a Donnelley Publishing Center].

Directories occurred *after* BAPCO filed this action and after the district court denied BAPCO's motion for a preliminary injunction. Hence, it is not at all surprising that Donnelley's published directories contain a number of distinguishable features.

Deposition of Gary Johnson, at p. 143. Johnson further testified that he sent Appalachian a "Donnelley heading book" and "asked Appalachian to use [the Donnelley heading book] and find alike [sic] or similar, in our book to the BAPCO book." *Deposition of Gary Johnson,* at p. 254. Johnson's testimony, along with that of other Donnelley employees, resolves the alleged factual dispute and makes it clear that Appalachian keyed a heading code that corresponded to a heading in the Donnelley heading book. But, the mere fact that Appalachian entered codes that corresponded to a heading in Donnelley's own heading book does not resolve the issue.

The relevant question is whether Appalachian entered codes that corresponded to Donnelley's previously selected menu of headings for particular use in its Miami directories, not whether Appalachian entered codes corresponding to a heading in a Donnelley heading book that Donnelley uses for compiling directories generally. As discussed earlier, the evidence is undisputed that BAPCO selected approximately 7,000 classified headings from those in its heading book containing 4,700 primary entries and approximately 34,000 authorized related headings. Therefore, the originality of BAPCO's selection of headings is based on its selection of approximately 7,000 headings for inclusion in the *1984 Yellow Pages,* not the selection of the nearly 40,000 authorized headings in the BAPCO heading book. In considering whether Donnelley copied BAPCO's selection of headings from the *1984 Yellow Pages,* Johnson's testimony makes it apparent that Donnelley did not previously select headings from its own heading book for inclusion in its *1985 Miami North* and *1985 Miami South* directories. Instead, Johnson testified that Donnelley merely sent Appalachian its heading book so that Appalachian could assign a code to each BAPCO heading that corresponded to a like or similar heading in the Donnelley heading book.

Johnson's testimony is bolstered in the testimony of Jon Notestein, who made the following statement in response to a question about how Donnelley selected classified headings that reflected needs of the market and users in Miami: "They were probably created by looking at the directories representing Miami, [the BAPCO directory]." *See Deposition of Jon C. Notestein*, pp. 50-52; *see also* Donnelley En Banc Reply Brief, p. 19 n. 14 (conceding that Notestein testified that Donnelley used the *1984 Yellow Pages* in order to refine its preexisting set of headings for use in Florida).

Therefore, even resolving the alleged factual dispute regarding Appalachian's coding of headings in favor of Donnelley's version, Johnson's and Notestein's testimony makes it clear that Donnelley did not previously select a universe of headings for particular use in its Miami directories. Instead, Donnelley copied BAPCO's selection of headings with what can only be described as a high-tech copying process. Donnelley's high-tech copying involved Appalachian keying codes rather than the words of BAPCO headings into a database, from which the wording of the BAPCO headings could be reconstructed later using the Donnelley heading book as a decoder.

Besides the evidence showing that Donnelley substantially appropriated BAPCO's selection of headings, Donnelley's stipulation regarding what information Appalachian keyed into the computer database leaves no factual dispute that Donnelley also substantially appropriated BAPCO's other original acts of selection and arrangement. As previously discussed, BAPCO's original acts of selection or arrangement included the selection of approximately 7,000 headings for particular use in the *1984 Yellow Pages*; the arrangement of 106,398 listings from 32,559 businesses under the approximately 7,000 classified headings; the selection of only businesses with business telephone service; and the selection of a geographic area to be covered comprehensively in the directory. It

is undisputed that Appalachian keyed into the computer database every business listing with a corresponding heading code and a code indicating the directory source for every listing in the *1984 Yellow Pages.*

Although the keying of each code in isolation would amount to the lawful copying of facts, Appalachian's grouping of the business listing with an associated heading code and a directory code amounts to the appropriation of virtually all of BAPCO's original acts of selection and arrangement. That is, Donnelley copied BAPCO's selection of headings based on Appalachian's keying of a heading code, even if it corresponded to headings in Donnelley's own heading book, for virtually every heading used in the *1984 Yellow Pages.* Donnelley copied BAPCO's arrangement of business listings under a particular classified heading based on Appalachian's grouping of the business listing data with a heading code that corresponded to a heading like or similar to BAPCO's. Donnelley copied BAPCO's selection of only businesses with business telephone service based on Appalachian's keying of every business listed in the *1984 Yellow Pages.* In addition, Donnelley copied BAPCO's selection of a geographic area based on Appalachian's grouping of the business listing data and the code indicating the directory source.

Because the keyed information was stored in or on some material object until later printed on the sales lead sheets, Donnelley's creation of the computer database represents an act of "copying" as defined in the Copyright Act. *See* 17 U.S.C. § 101 (defining a copy as a material object "in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device"). Accordingly, I would hold that Donnelley's substantial appropriation of BAPCO's original acts of selection or arrangement in creating the computer database, represented an act of copyright infringement.

B. *Sales Lead Sheets*

Donnelley's substantial appropriation of BAPCO's original act of selection or arrangement is also apparent in the printed sales lead sheets. As discussed previously, Donnelley stipulated in the district court that it prepared the sales lead sheets from the following information obtained from the *1984 Yellow Pages:* (1) telephone number—under the first column; (2) name—under the second column; (3) address—under the third column; (4) kind of business—under the fourth column; and (5) unit of advertising—under the fifth column. A visual examination of the printed sales lead sheets shows that the sales lead sheets also contain rate information under the sixth column and a directory code under the seventh column. Because it is uncontroverted that the sales lead sheets represented merely a printed version of the same information that Appalachian keyed into the computer database, the previous analysis of how Donnelley substantially appropriated BAPCO's original selection or arrangement in creating the database applies equally to its printing of the sales lead sheets. Hence, I would also hold that Donnelley's printing sales lead sheets using the information already copied into the computer database, represented a second act of copyright infringement.

Even though a discussion of the sales lead sheets necessarily turns on analysis of the information keyed into the computer database, the printed sales lead sheets have independent significance because the sales lead sheets, not the actual directories, constituted the chief visual evidence of copying in the district court. In the district court, Donnelley stipulated that the seven lead sheets attached to BAPCO's motion for preliminary injunction were representative of all the thousands of sales lead sheets that Donnelley created. Donnelley now attempts to retreat from its concession concerning the representativeness of the sales lead sheets and to retry this case based on a visual comparison of the *1984 Yellow Pages* and the

1985 Miami North and the *1985 Miami South* directories. In its *En Banc* Reply Brief, Donnelley responds to BAPCO's assertions of substantial similarity based on the seven lead sheets with the following argument: "BAPCO bases this assertion entirely on a chart drawn from just seven of the thousands of lead sheets produced by Donnelley for Miami. However, BAPCO's chart 'conclusively demonstrates' only that a small sample can produce a misleading result." *See* Donnelley En Banc Reply Brief, p. 22 (citations omitted). Donnelley continues its response with its newly created chart comparing the headings in the *1984 Yellow Pages* and those used in the *1985 Miami North* and *1985 Miami South* directories.

Donnelley's arguments are fatally flawed in that they rely on a visual comparison of the actual directories, which Donnelley admits that it only recently, on January 27, 1993, moved for leave to place physical copies of the three directories in the record on appeal. *See* Donnelley En Banc Reply Brief, p. 22 n. 16. Likewise, Donnelley failed to present the chart comparing the headings in the three directories to the district court, attaching it for the first time as an appendix in its En Banc Reply Brief. *See* Donnelley En Banc Reply Brief, p. 22 n. 17 (explaining the results of its new analysis as indicated in Appendix A of the En Banc Reply Brief).[8]

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[8] Contrary to settled principles of finality, the majority permits Donnelley to back away from its stipulation in the district court regarding the representativeness of the seven lead sheets. Instead of considering the seven sales lead sheets and analysis of them as presented to the district court, the majority relies heavily on a visual comparison of selected pages from the three published directories. Indeed, it is unusual that this copyright case proceeded from October, 1985, to October, 1988, in the district court without the parties submitting complete physical copies of the disputed publications. But, it was this court, not the district court, that admitted the directories into the record in response to the parties' joint motion of January, 1993. The majority properly, albeit implicitly, declines Donnelley's request that this en banc court to

Unlike Donnelley, BAPCO did present the district court with a comparative analysis of the seven lead sheets showing the virtual identity between BAPCO headings and Donnelley headings. BAPCO presented the affidavit testimony of Barbara Wiggs, who explained her findings on the similarities between information on the sales lead sheets and that in the *1984 Yellow Pages.* Based on line-by-line comparisons of the sales lead sheets to the *1984 Yellow Pages,* Wiggs concluded that "the listing information on the attached Donnelley Sales Lead sheets were identical to the *1984 Yellow Pages* directories, except for a small number of very minor discrepancies." *See* 6SR10-17, pp. 11-12, *Affidavit of Barbara J. Wiggs,* in *Volume 1—Appendix to Summary Memorandum of Bellsouth Advertising & Publishing Corporation.* Specifically, Wiggs listed her findings of complete identity except for the following entries: (1) Evian associated with the heading

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engage in a side-by-side visual comparison of all pages in three published directories. See Donnelley En Ban Reply Brief, p. 22 nn. 16 & 17. However, the majority's visual comparison of selected pages from the directories is equally unfounded. As discussed fully in section III-C, the record before the district court consisted of a total of approximately forty pages from the published directories. Nothing in the district court opinion indicates that the district court actually made a side-by-side visual comparison of those pages except possibly to verify the conclusions in the Affidavit of Barbara J. Wiggs.

This court generally bases a reversal of a district court on evidence that the district court considered. The majority's outright reversal of the district court based upon its original 'finding' from a visual comparison of selected pages from the published directories, places this court in the novel position of retrying this case rather than reviewing it. Because Donnelley's own stipulation as to the representativeness of the sales lead sheets led the district court to reach what Donnelley now calls a "misleading result," this court must affirm the district court's conclusion on the substantial similarity issue. At a minimum, this court is required to remand to the district court for consideration of Donnelley's new theory of the case which hinges on a comparative analysis of pages from the published directories.

"Water Coolers" instead of "Water Coolers—Renting"; (2) Star Appliances being associated with the heading "Air Conditioning—Room Units" instead of "Air Conditioning Equipment—Room Units"; (3) Star Appliances being associated with the heading "Television Dealers—Retail" instead of "Television & Radio—Dealers"; (4) Star Appliances being associated with the heading "Vacuum Cleaners—YSTEM Household—Dealers" instead of "Vacuum Cleaners—Household—Dealers"; (5) Star Appliances being associated with the heading "Vacuum Cleaners—S Household—Dealers" instead of "Vacuum Cleaners—Household—Dealers"; and (6) Audiotron-High Fidelity Corp. being associated with the address of "145 S.W. 52nd Avenue" instead of "145-147 S.W. 52nd Avenue Second Floor." Wiggs's conclusion that the discrepancies were "minor" is entirely reasonable in light of the fact that the seven lead sheets contain information concerning seven different businesses, appearing under forty different headings in the *1984 Yellow Pages*, for a total of sixty-eight listings, averaging five different headings and ten listings. It is also significant to note that the headings on the lead sheets ranged from "Gas—Industrial & Medical Cylinder & Bulk" to "Antiques—Repairing & Restoring." The identity between the headings on the lead sheets and those in the *1984 Yellow Pages* included even the hyphens and the ampersands.

Based on Donnelley's stipulation that the seven sales lead sheets were representative and Wiggs's testimony on the virtual identity between the headings and other information on the sales lead sheets and that in the *1984 Yellow Pages*, the chief visual evidence in the district court conclusively shows that Donnelley's printing of the sales lead sheets represented a second act of substantial appropriation of BAPCO's original acts of selection or arrangement.

C. *The Donnelley Directories*

As previously discussed, only a small portion of the arguments and evidence before the district court related to a visual comparison of published copies of the actual directories. In its opinion, the district court references a comparison of the directories only three times. The first reference is the district court's statement that "a comparison of the two (2) directories reveal that Donnelley used a format nearly identical to that used by BAPCO. *See* Exhibit P and P Enlarged to BAPCO's Brief." *See BellSouth*, 719 F.Supp. at 1559. In their February, 1993, letters to the clerk of this court regarding requests for certain portions of the record, both parties agreed that the district court did not refer to the BAPCO and Donnelley directories when referencing Exhibit P and P Enlarged.

In fact, Exhibit P and P Enlarged are copies of a sales solicitation form of Associated Telephone Directory Publishers that this court reproduced as Appendix A in *Southern Bell Tel. & Tel. v. Associated Tel. Directory Publishers,* 756 F.2d 801, 813-14 (11th Cir.1985). Donnelley stated in its February 22, 1993, letter to the clerk that "Exhibits P and P enlarged do not involve any yellow pages directory at issue in the present appeal" and that the district court cited the exhibits erroneously. BAPCO responded that the district court correctly referred to the exhibits from the *Southern Bell* opinion, but only for the limited purposes of showing what the *Southern Bell* court considered to be a copyrightable format, and showing that Donnelley's format as evidenced in the sales lead sheets was nearly identical to that of BAPCO. Regardless of why the district court referenced Exhibits P and P Enlarged, the fact that the parties agree that the district court was not referencing pages from the BAPCO or Donnelley directories makes it uncontroverted that the district court was not stating that it performed page-by-page visual comparison of the *1984 Yellow Pages* and the Donnelley directories.

The second suggestion that the district court visually compared the disputed directories, is the district court's discussion of the evidence of "common errors." *See BellSouth*, 719 F.Supp. at 1559 & n. 23. But, in discussing the common errors in the three directories, the district court referenced pages from the directories that BAPCO attached to the *Second Affidavit of Barbara J. Wiggs*. *See BellSouth*, 719 F.Supp. at 1559 n. 23. The district court did not cite pages in complete published copies of the directories. Similarly, in concluding that the directories are substantially similar, the district court cites the Barbara Wiggs affidavit and Gerald Brown testimony rather than pages from the published directories. *See BellSouth*, 719 F.Supp. at 1559-60.

Therefore, none of the references in the district court's opinion provide a basis for this court to engage in side-by-side comparisons of all pages in the *1984 Yellow Pages* with those in the *1985 Miami North* and *1985 Miami South* directories. It is only possible to conclude that the district court examined the pages of the directories that BAPCO attached to the *Second Affidavit of Barbara J. Wiggs*. Because Donnelley failed to present its own comparative analysis of pages from the actual directories and also failed to place physical copies of the directories in the record until January, 1993, this court is required to limit its determination on the substantial similarity of the directories to those pages attached to the *Second Affidavit of Barbara J. Wiggs*, and only to the extent of Wiggs's comparative analysis.

The district court relied on Wiggs's analysis of pages from the directories as support for the following conclusion: "Although Donnelley's directory is not identical to BAPCO's directory, the material was copied and used to produce a directory substantially simliar in both content and format." *See BellSouth*, 719 F.Supp. at 1559-60 (citing Affidavit of Barbara Wiggs and October, 1985, testimony of Gerald Brown). In her affidavit, Wiggs iden-

tified twenty-five errors that were common to both the *1984 Yellow Pages* and the Donnelley directories. *See* 6SR11-18, *Second Affidavit of Barbara J. Wiggs,* pp. 2-19. For example, Wiggs explained that BAPCO incorrectly listed Fort Lauderdale News under the heading "Balancing Equipment" in the *1984 Yellow Pages,* and that Donnelley's *1985 Miami North* directory also lists Fort Lauderdale News under a "Balancing Equipment" heading. *See BellSouth,* 719 F.Supp. at 1559 n. 23 (also noting the example of the common erroneous listing of "Flash Courier Systems" even though the subscriber's telephone was disconnected before January 1, 1984).

The presence of common errors is "one of the most significant evidences of infringement." *Callaghan v. Myers,* 128 U.S. 617, 662, 9 S.Ct. 177, 190, 32 L.Ed. 542 (1888). Based on the earlier conclusions that the *1984 Yellow Pages* constitutes an original selection and arrangement of facts that is copyrightable, Wiggs's testimony regarding the presence of common errors is relevant to rebut Donnelley's repeated assertions that it used the *1984 Yellow Pages* "only to ascertain the fact revealed by BAPCO's heading—the kind of business carried on by the listed firm—so as to enable Donnelley to classify that firm in its own system of classification." *See* Donnelley En Banc Reply Brief at p. 20; *see also,* Donnelley En Banc Brief at p. 12. Donnelley's assertions that it independently classified businesses using its own heading scheme is wholly unbelievable when one considers the statistical improbability of two publishers independently classifying the same newspaper as a "Balancing Equipment" dealer. Therefore, the presence of the common errors in the published directories is significant evidence that Donnelley substantially appropriated BAPCO's original arrangement of business listings under particular classified headings.

As further evidence of Donnelley's substantial appropriation of BAPCO's grouping of listings under particular

headings, Wiggs's affidavit included a heading comparison based on a random selection of Donnelley headings and a comparison of the listings appearing under those headings with the listings appearing under the corresponding headings in the *1984 Yellow Pages.* BAPCO presented the district court with the following chart summarizing Wiggs's findings regarding the percentage of correlation between the listings under particular headings in the Donnelley directories and those in the *1984 Yellow Pages:*

Heading	North Miami	South Miami
"Bail Bonds"	68%	55%
"Boxes, Corrugated & Fiber"	86%	100%
"Ceilings"	64%	50%
"Driving Instruction"	72%	73%
"Engineers—Civil"	88%	86%
"Furniture—Outdoors"	63%	70%
"Gold, Silver & Platinum Dealers"	95%	85%

See 6SR5-3 *Reply to Donnelley's Memorandum in Opposition to Motion for Partial Summary Judgment on Copyright Infringement by Bellsouth Advertising & Publishing Corporation and Memorandum in Opposition to Donnelley's Copyright Partial Summary Judgment Motion,* p. 40 (March 6, 1986).

As the chart indicates, Wiggs found a high (averaging seventy-five percent) statistical correlation of listings under particular headings when comparing the *1984 Yellow Pages* with the Donnelley directories. Donnelley did not respond with its own correlation analysis, and thus, Wiggs's findings represent further undisputed evidence that Donnelley's published directories contain a substantially similar arrangement of business listings under particular classified headings. *Accord see Key Publications,* 945 F.2d at 515, 517 (finding no substantial similarity based on the lack of any evidence that the defendant copied an entire category of the plaintiff's directory, but explaining that a finding of infringement would succeed if the defendant had exactly duplicated a substantial designated

portion of the plaintiff's directory such as all of the listings of professionals such as medical doctors, lawyers, accountants, engineers, and architects).

To the extent that Wiggs's analysis of the directories was misleading, it is an elementary rule on summary judgment that the burden shifted to Donnelley to produce its own comparative analysis of the published directories in order to rebut the undisputed evidence of substantial similarity in Wiggs's affidavit. *See United States v. Four Parcels of Real Property,* 941 F.2d 1428, 1438 (11th Cir.1991) (recognizing that the burden on summary judgment shifts to the non-moving party once the moving party has met its initial responsibility of showing the absence of a triable issue of fact, and that the moving party is entitled to summary judgment if the non-moving party fails to make a sufficient showing on an essential element of the case); Fed.R.Civ.P. 56(e). As a non-moving party opposing a motion for summary judgment which BAPCO supported with affidavits, Donnelley could not simply rely on legal conclusions or evidence which would be inadmissible at trial in order to meet its burden of coming forward with relevant and competent evidence. *See Avirgan v. Hull,* 932 F.2d 1572, 1577 (11th Cir. 1991).

In the district court, Donnelley failed to respond to the evidence in Wiggs's affidavit showing substantial similarity in the arrangement of listings under headings in the published directories. Contrary to Donnelley's assertions to the *en banc* court, Donnelley also failed to present evidence to the district court that the selection of headings in its published directories was substantially smaller and different from those in the *1984 Yellow Pages. Compare* Donnelley En Banc Brief at p. 12 and BAPCO En Banc Brief at p. 3 (attaching as "Exhibit 2" those portions of the record that Donnelley cites). Instead of responding to BAPCO's evidence in the district court, Donnelley waited until January, 1993, before moving to place the published directories in the record. *See*

Donnelley En Banc Reply Brief p. 22 n. 16. Donnelley also waited until its *En Banc* Reply Brief before presenting a comparative analysis of the heading structure in the published directories. *See* Donnelley En Banc Reply Brief, pp. 22-23 & n. 17. Stated simply, Donnelley waited too late to meet its burden of presenting competent evidence to oppose BAPCO's motion for summary judgment. Because Wiggs's affidavit represented the only evidence before the district court concerning the substantial similarity of the published directories, I would affirm the district court's conclusion that Donnelley substantially appropriated BAPCO's original acts of selection and arrangement when publishing the *1985 Miami North* and *1985 Miami South* directories.[9]

In sum, the uncontroverted evidence before the district court shows that Donnelley substantially appropriated BAPCO's original selection and arrangement in the *1984 Yellow Pages* with three separate acts of copying: (1) keying-in that selection and arrangement into the computer database; (2) printing the sales lead sheets from the data in the computer database; and (3) using the computer database and the sales lead sheets to publish the Donnelley directories with a substantially similar selection of headings and substantially similar arrangement or grouping of listings under particular headings. Accordingly, I would affirm the judgment of the district court granting summary judgment in favor of BAPCO on all

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[9] Incredibly, the majority ignores the fact that Donnelley failed to meet its burden of coming forward with relevant and competent evidence to rebut BAPCO's affidavit evidence. In doing so, the majority departs from the settled rule that a non-moving party may lose at the summary judgment stage based on its failure to come forward with competent evidence showing a genuine issue of material fact. *See Four Parcels*, 941 F.2d at 1438. As a replacement for the established rules concerning summary judgment, the majority's reliance on its original fact-finding in a visual comparison of pages from the published directories, establishes a new and absurd rule that a non-moving party failing to meet its burden in the district court may nonetheless win outright judgment with evidence considered for the first time on appeal.

three claims that Donnelley infringed its compilation copyright in the *1984 Yellow Pages*.[10]

Because the majority reaches the opposite result based on an utter failure to analyze the evidence presented to the district court under the controlling legal principles announced in *Feist*, and also based on an unwarranted departure from well-established rules limiting this court's review to arguments and evidence presented in the district court, I must respectfully DISSENT.

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[10] In addition, for the reasons stated in the now vacated panel opinion, *Bellsouth*, 933 F.2d at 960-61, I would affirm the district court's rejection of Donnelley's "fair use" and "antitrust misuse" defenses.

APPENDIX B

UNITED STATES COURT OF APPEALS
ELEVENTH CIRCUIT

No. 89-5131

BELLSOUTH ADVERTISING & PUBLISHING CORPORATION,
Plaintiff-Counterclaim
Defendant-Appellee,

v.

DONNELLEY INFORMATION PUBLISHING, INC., and the
REUBEN H. DONNELLEY CORP.,
Defendants-Counterclaim
Plaintiffs-Appellants.

BELLSOUTH CORPORATION, *et al.*,
Counterclaim-Defendants.

Appeal from the United States District Court
for the Southern District of Florida

June 18, 1991

Douglas C. Broeker, Michael J. Cappucio, Miami, Fla., Fowler, White, Burnett, Hurley, Banick & Strickroot, P.A., David L. Foster, Theodore Case Whitehouse, Francis J. Menton, Jr., Willkie, Farr & Gallagher, Baila H. Celedonia, Roger L. Zissu, Cowan, Liebowitz, & Lat-

man, PC, New York City, for defendants-counterclaim plaintiffs-appellants.

Robert E. Richards, Anthony B. Askew, Jones, Askew & Lunsford, Atlanta, Ga., for Bellsouth Advertising.

John K. Roedel, Jr., Senniger, Powers, Leavitt & Roedel, St. Louis, Mo., for amicus curiae, ANADP.

Robert E. Marsh, Blackwell, Sanders, Matheny, Weary & Lombardi, Kansas City, Mo., for amicus curiae, US WEST.

Robert Alan Garrett, Arnold & Porter, Washington, D.C., for amicus curiae, Bell Atlantic.

Before JOHNSON and HATCHETT, Circuit Judges, and SMITH *, Senior Circuit Judge.

EDWARD S. SMITH, Senior Circuit Judge:

The case before us concerns infringement of copyright. The United States District Court for the Southern District of Florida granted summary judgment to appellee, Bellsouth Advertising & Publishing Corp. (BAPCO), on its claim that appellants, Donnelley Information Publishing, Inc. and Reuben H. Donnelley Corp. (Donnelley), had infringed on BAPCO's copyrights in its phone directory. The district court also granted summary judgment against Donnelley on their fair use and antitrust misuse defenses. To preserve the integrity of BAPCO's copyrights, the district court enjoined Donnelley from copying any of BAPCO's directories in the future. 719 F.Supp. 1551. Donnelley appeals to this Court for review of the grant of summary judgment and the injunction order. We affirm.

Facts

BAPCO and Southern Bell Telephone and Telegraph Co. (Southern Bell) are wholly-owned subsidiaries of

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* Honorable Edward S. Smith, Senior U.S. Circuit Judge for the Federal Circuit, sitting by designation.

BellSouth Corp. (BellSouth). BAPCO was created for the purpose of preparing, publishing and distributing telephone directories. Pursuant to an agreement between Southern Bell and BAPCO, the latter publishes and distributes a classified advertising directory entitled the Greater Miami Yellow Pages (Yellow Pages). The information that BAPCO presents in its directory is supplied by Southern Bell. This controversy concerns the Yellow Pages published in 1984 in which BAPCO owns a valid copyright.

The information embodied in the Yellow Pages is presented in a convenient, organized fashion. A particular directory is organized to have its own geographic scope, so that businesses which have a phone exchange located within the geographic scope are listed in the appropriate directory. Moreover, the Yellow Pages directory is categorized according to business classification. Each business listing is placed within its appropriate business classification in alphabetical order. A business listing comprises the business name, address and phone number. To attract prospective customers, a given business may purchase an advertisement which will appear in the Yellow Pages in addition to its business listing. These advertisements are interspersed within each business classification throughout the Yellow Pages.

After BAPCO published the 1984 Yellow Pages, Donnelley began promoting and selling classified advertisements which were to be placed in a competitive classified directory for the Greater Miami area. Donnelley's vice president wrote to BAPCO concerning the acquisition of listings that could be published in their own directory. Subsequently, Southern Bell and Donnelley entered an agreement pertaining to Donnelley's publication and distribution of a competing classified advertising directory in the Greater Miami area. Pursuant to the agreement, Southern Bell provided Donnelley with the name, address, and telephone number of all of its relevant business subscribers.

However, Donnelley did not utilize the licensed information to generate their own directory. Instead, Donnelley had Appalachian Computer Services, Inc. key the information and the inherent organizational elements embodied in BAPCO's Yellow Pages into a computer and store it on magnetic tape. Donnelley subsequently printed out listings from the computer data base along with some of its corresponding organizational elements onto sales lead sheets. Donnelley's sales representatives used these lead sheets to solicit additional advertising purchases from those businesses listed in their directory. Donnelley also printed the listings onto their own directory in substantially the same format as that inscribed in the Yellow Pages.

On October 2, 1985, BAPCO filed suit against Donnelley alleging three causes of action: (1) copyright infringement, (2) trademark infringement, and (3) unfair competition. BAPCO moved for a preliminary injunction which the district court eventually denied. After the preliminary injunction proceedings, Donnelley answered the complaint naming BAPCO, Southern Bell and Bell South as counterdefendants and alleged: (1) unlawful monopolization, (2) unlawful attempt to monopolize, and (3) invalid trademark registration.

After several salvos of summary judgments were motioned by each party, the district court granted summary judgment in favor of BAPCO on the copyright infringement claim, antitrust counterclaims and affirmative defenses. The district court denied Donnelley's motion for summary judgment on the trademark issues and denied BellSouth and Southern Bell's motion for summary judgment on the antitrust counterclaims. Donnelley appeals to this Court, contesting the district court's decision regarding the copyright infringement and the antitrust and fair use affirmative defenses.

Issues

The district court found that BAPCO was entitled to summary judgment on its claim that Donnelley infringed its copyright and that BAPCO had not committed any antitrust violation. We must determine whether the evidence before the court indicates "that there is no genuine issue as to any material fact" relevant to the copyright infringement claim and the fair use and antitrust defenses.[1] If the law applicable to the undisputed facts entitles BAPCO to the judgment entered by the district court, we must affirm.[2]

Infringement

BAPCO claims that Donnelley infringed its copyright in the Yellow Pages. To prevail on a claim of copyright infringement, the plaintiff must establish two elements: (1) that plaintiff owns a valid copyright in the work; and (2) that defendant copied "constituent elements of the work that are original." [3]

As to the first element, a phone directory is afforded copyright protection if it classifies as a compilation.[4] Donnelley admits that BAPCO possesses a valid compilation copyright in their phone directories because it qualifies as a compilation under 17 U.S.C. § 101.[5] Donnelley's defense to infringement is that although they did copy information from BAPCO's phone directory, they did not copy any constituent elements that make the work original (*i.e.*, protected expression). Instead the defendant maintains that they only "extracted" information which is not protected by copyright.

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[1] Fed.R.Civ.P. 56(c).

[2] *Id.*

[3] *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, —— U.S. ——, ——, 111 S.Ct. 1282, 1296, 112 L.Ed.2d 358 (1991).

[4] 17 U.S.C. § 103(a) (1988).

[5] (1988).

The Courts of Appeal were in disagreement as to the extent that a compilation work is protected. The "sweat of the brow" standard extends copyright protection to the information in a compilation because labor and effort were expended to gather the information that is placed in the work.[6] The Supreme Court has disapproved the "sweat of the brow" standard, explaining that its defect lies in the fact that the copyright laws were never intended to protect information merely for the reason that it may stem from effort or labor.[7] The copyright laws, as part of the overall protection afforded intellectual property, were designed only to protect "original works of authorship fixed in any tangible medium of expression. . . ." [8] Therefore, the *information* contained in the directory which is accumulated by effort or labor does not lie within the hegemony of BAPCO's copyright.[9]

Instead, the proper standard is delineated in the statute itself. "A compilation is a work formed by the collection and assembling of preexisting materials or of data that are *selected, coordinated, or arranged in such a way* that the resulting work as a whole constitutes an *original work* of authorship." [10] Therefore, in the case of com-

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[6] *See, e.g., Hutchinson Tel. Co. v. Fronteer Directory Co.*, 770 F.2d 128 (8th Cir.1985); *Schroeder v. William Morrow & Co.*, 566 F.2d 3 (7th Cir.1977).

[7] *Feist Publications*, —— U.S. at ——, 111 S.Ct. at 1291.

[8] 17 U.S.C. § 102(a) (1988).

[9] *Feist Publications*, —— U.S. at ——, 111 S.Ct. at 1291.

[10] 17 U.S.C. § 101 (1988) (emphasis added). The illuminating statutory distinction is basic to all copyright protection. Words and elements of delineated forms themselves are generally not original; it is the originality of their combination that the law seeks to protect. For example, the notes of the scale from "a" to "g" are preexisting, as one can see. The notes themselves clearly never change, but the manner in which the notes arrange, assembled by an inventive mind, is property of a protected kind. To copy that work is alike to trespass, and will get the infringer a kick off the property.

pilations, the protected expression is the manner of selection, coordination, or arrangement of the information that constitutes the originality, not the information itself that is accumulated by the "sweat of the brow".[11] Hence, copyright protection only extends to the selection, coordination and arrangement which comprises an original *format* of the compilation work.[12] In the case of compilations, to satisfy the second element of the copyright infringement cause of action, there must be a substantial appropriation of the original format of the compilation to constitute the copyright of protected material.[13] Accordingly, we must determine whether there was a substantial appropriation of the format of the plaintiff's compilation.

To determine whether there was a substantial appropriation, we initially determine whether BAPCO's format was original. First of all, BAPCO performed several acts of selection. BAPCO had to select and demark the geographic boundaries that correspond to the scope of each directory. These boundaries determine in which directory or directories a particular business will be listed. BAPCO also had to select a directory close date on which no more listing modifications would be reflected in the pending directory publication. Moreover, BAPCO had to create or select numerous business classifications. A particular business is listed according to its appropriate business classification.

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[11] The labor is more appropriately protected under the law of unfair competition. *Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory*, 756 F.2d 801, 809-10 n. 9 (11th Cir.1985).

[12] *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1369-70 (5th Cir.1981) (decided before the Fifth Circuit split, so binding on this Court, *Bonner v. City of Prichard*, 661 F.2d 1206 (11th Cir. 1981)); *Worth v. Selchow & Righter Co.*, 827 F.2d 569, 572-74 (9th Cir.1987), *cert. denied*, 485 U.S. 977, 108 S.Ct. 1271, 99 L.Ed.2d 482 (1988); *Financial Information, Inc. v. Moody's Investors Serv., Inc.*, 751 F.2d 501, 506 (2d Cir.1984).

[13] *Associated Tel. Directory*, 756 F.2d at 810.

Secondly, BAPCO had to coordinate all the current informational components of a particular business into one complete business listing. The name of the business had to be coordinated with the business' address and the business' phone number.

Lastly, BAPCO had to arrange these coordinated listings according to various categories. All business listings and advertisements had to be arranged under the appropriate business classification. In the final product, all current business listings and advertisements that were arranged according to business classification had to be arranged according to geographical scope. Hence, a particular directory only included those businesses located within the peculiar geographic scope selected for the particular directory. These acts of selection, coordination and arrangement contribute to produce what we agree to be an original format of the directory. The format of the Yellow Pages before us is sufficiently distinct from the "white pages" phone directory involved in *Feist* to meet the minimal level of independent creativity required to qualify as original. The "white pages" format is a simple alphabetical listing of residential names, addresses and phone numbers. Because the Yellow Pages directory published by BAPCO provides a convenient, unique organization of business listings and advertisements, it merits originality. Therefore, only the original format is protected, the bare information itself segregated from the compilational format is not protected.

Next, we decide whether Donnelley substantially appropriated the selection, coordination, or arrangement that comprised the format of the BAPCO directory. The district court found that Donnelley committed three acts of copying: keying the formatted information into the computer, preparing the sales lead sheets and publishing the Donnelley directories. We review these findings to determine if any or all of these acts constitute a substantial appropriation of BAPCO's protected format.

The first alleged act of copying is keying formatted information into a computer. Before proceeding on, we put the legal analysis on hold, in order to determine whether the act of keying this formatted information into the computer to form a data base can be a physical act of copying. A copy is a "material object[] . . . in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device."[14] When the formatted information is first keyed into the computer, it is held in or on some material object. There is no doubt that the work can be perceived by calling up the formatted information on the computer monitor screen. Therefore, such an act is copying if the work is *fixed* in the computer.

"A work is 'fixed' . . . when its embodiment . . . is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration."[15] In the case of a computer, data is not stabilized for more than a transitory duration unless it is stored in or on a material object.[16] Although the record does not indicate whether or how the formatted information was stored in the computer, the district court did find that the formatted information was at some point "stored on magnetic tape and sent to Donnelley." Therefore, the act of keying the formatted information into a computer and storing it on magnetic tape is a physical act of copying.

Knowing that keying the work into the computer is an act of physical copying, we now decide whether Donnelley appropriated enough of BAPCO's format to con-

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[14] 17 U.S.C. § 101.

[15] *Id.*

[16] *See Stern Electronics, Inc. v. Kaufman,* 669 F.2d 852, 855-56 n. 4 (2d Cir.1982).

stitute illegal copying. Donnelley's process involved keying into a computer database the name, address, telephone number, the classified heading code, the advertising code and the directory code for every business listing.[17] The classified heading code corresponds to the type of business classification or classifications under which a particular business is placed. The advertising code represents the number of units of advertising that the particular business has purchased. The directory code signifies the directory or directories in which the business was listed thereby revealing its geographical arrangement. These encoded elements could be readily translated back into its BAPCO counterpart classifications through use of Donnelley's decoding key. Although these codes were authored by Donnelley, they correspond to the selection, coordination and arrangement originally authored by BAPCO.

The district court correctly found that Donnelley expropriated the essence of BAPCO's compilation. In effect, Donnelley has distilled the BAPCO compilation down to its basic elements, but retained the tools that are required to reconstitute the compilation. By utilizing their classification codes and their decoder keys which match particular codes to the corresponding BAPCO classification, Donnelley can reconstruct the format of BAPCO's compilation.[18]

Also probative is the fact that Southern Bell had furnished Donnelley with a list of all Southern Bell business phone subscribers, pursuant to a licensing agreement. The licensed information included the names, addresses and

[17] Donnelley hired Appalachian Computer Services, Inc. of London, Kentucky to key BAPCO's compilation into a computer data base.

[18] Donnelley attempts to evaluate individually each element of the BAPCO directory in asserting that they lack originality and are thereby unprotected by copyright. However, each component must not be evaluated in a literary vacuum but as an integral part of the whole to determine if BAPCO's original format was copied.

telephone numbers for all business subscribers in Greater Miami. If Donnelley had been interested only in the *information* contained in the directory, they could have extracted all the information that they needed from the list furnished to them by Southern Bell. Instead, Donnelley copied the formatted information from the Yellow Pages because they were interested in the format and organization of the information in the Yellow pages which was authored by BAPCO. We agree that Donnelley has copied BAPCO's protected material by substantially appropriating the constituent elements of the original format inscribed in the BAPCO directory.

Although a closer question, we also agree that Donnelley's printing of the sales lead sheets from the formatted information fixed on their magnetic tape constitutes copying. Donnelley's sales representatives use these lead sheets to sell advertisements to listed businesses. A single entry on the lead sheet comprises the telephone number, the business name, the business address, the business classification, the number of advertising units previously purchased from BAPCO, the advertising rate, and the BAPCO directory in which it was listed.

We realize that BAPCO's Yellow Pages and Donnelley's lead sheets were arranged differently. On line one, BAPCO arranged their listings in the phone directory first according to alphabetized business classification and then according to alphabetized business name within each classification. On the other line, Donnelley's lead sheets are arranged in tabular form. However, the protected part of a compilation work is the "selection, coordination *or* arrangement." [19] Although the arrangement of Donnelley's sales lead sheets and BAPCO's phone directory is different, Donnelley's sales lead sheets continue to appropriate the coordination of informational components in a business listing and the selection of categories utilized by the BAPCO format. This appropriation is substantial

[19] 17 U.S.C. § 101 (emphasis added).

and constitutes the copying of constituent elements of originality.[20]

Publication of the Donnelley directories is also an act of copying BAPCO's Yellow Pages. Although some of the additional advertisements interspersed throughout the Yellow Pages may be arranged differently or omitted in Donnelley's directory, the overall format of the Yellow Pages is substantially appropriated in the Donnelley directories. Consequently, we agree with the district court in that Donnelley committed acts of copying protected material from BAPCO's copyrighted compilation work.

Fair Use Defense

The doctrine of fair use permits one to use protected material without infringing the copyright. In determining whether fair use is an applicable defense, we must dial through the two-pronged analysis contemplated by 17 U.S.C. § 107.[21] First, we must determine whether the purpose underlying the use committed by the defendant is condoned by the statute. "[F]air use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching, . . . scholarship, or research, is not an infringement of copyright." [22] Although the list of acceptable purposes enumerated in the statute is not exclusive, it is evident that the purpose envisioned by the statute must be of a salutary nature. If, and only if, the purpose is acceptable, must we determine whether the defendant's use is fair.[23]

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[20] The district court's finding that this particular act was a substantial appropriation, hence copying, might not be as felicitous had the sales lead sheets not been derived from the initial copy which was entered into the computer data base and fixed on the magnetic tape.

[21] (1988).

[22] *Id.*

[23] *Id.*

In *Associated Telephone Directory*, this Court paid cursory attention to the first prong of the analysis by assuming that defendant's use of the expression in the phone directory advanced its research purposes.[24] We believe that the issue of purpose in this case demands more attention. Although Donnelley's use appropriated the research formatted in BAPCO's phone directory, the purpose underlying Donnelley's use was not to promote research, but to promote commercial profit. Donnelley's incentive in appropriating the formatted expression in BAPCO's directory was to compete for business advertisements by publishing the infringing directory. BAPCO had already completed the research and formatted it for presentation in the phone directory. Donnelley simply copied BAPCO's formatted research and published it for their own profit.[25] Because the record shows that Donnelley's use does not promote a salutary purpose, the first prong of the fair use doctrine is not satisfied. Accordingly, the defense of fair use is inapplicable, regardless of the second prong analysis.

Misuse Defense

Donnelley asserts that BAPCO, its parent, BellSouth, and its affiliate, Southern Bell, have engaged in an anticompetitive course of conduct thereby misusing its copyright in the Yellow Pages. The alleged object of the joint course of conduct was to maintain monopoly power or to attempt to attain monopoly power either of which are section 2 violations of the Sherman Act.[26] Donnelley alleges that the monopoly was effectuated by (1) refusing to supply Donnelley with the information required to

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[24] *Associated Tel. Directory*, 756 F.2d at 811.

[25] The fact that BAPCO did all the research and Donnelley did none of it only militates against the applicability of the doctrine of fair use; it is not the basis underlying the copyrightability of BAPCO's directory.

[26] 15 U.S.C. § 2 (1988).

compete in the market and (2) overexerting their intellectual property rights in the copyrighted directories to prohibit the use of competition-essential, unprotected information. Donnelley asserts that the court should not enforce the copyrights because BAPCO has abused its copyright privileges.

The antitrust misuse defense is an established defense to patent infringement.[27] The policy supporting the patent misuse defense lies in the equitable clean hands doctrine. A patentee who comes into court, praying that defendant's patent infringement be enjoined will not be gratified if he is guilty of abusing his patent rights.[28] Some courts have concluded that a misuse of copyright defense is inherent in the law of copyright just as a misuse of patent defense is inherent in patent law.[29] Although the patent misuse defense closely fits the copyright law situation and may someday be extended to discipline those who abuse their copyrights, we decline to extend the application in the context before us because there is no antitrust violation.

The disdain the law has for monopolies and the acquisition of monopolies is beyond peradventure.[30] However, this case is different from the ordinary monopoly case because BAPCO's right to restrict the copying of its work was recognized in them by the government. Therefore, to commit a Sherman Act violation with regard to an exclusive right that is sanctioned by the government,

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[27] *Morton Salt Co. v. G.S. Suppiger Co.*, 314 U.S. 488, 62 S.Ct. 402, 86 L.Ed. 363, *reh'g denied*, 315 U.S. 826, 62 S.Ct. 620, 86 L.Ed. 1222 (1942).

[28] *Id.* 314 U.S. at 492-93, 62 S.Ct. at 405.

[29] *Lasercomb America, Inc. v. Reynolds*, 911 F.2d 970, 977 (4th Cir.1990).

[30] *See, e.g. Swift & Co. v. United States*, 196 U.S. 375, 396, 25 S.Ct. 276, 279, 49 L.Ed. 518 (1905); *United States v. Grinnell Corp.*, 384 U.S. 563, 570-71, 86 S.Ct. 1698, 1703-04, 16 L.Ed.2d 778 (1966).

the grantee must abuse the legitimate privileges that accompany the grant. In order to abuse these privileges, it is necessary that the grantee extend its exclusive right beyond the parameters inherent in the grant.[31]

We agree with the district court conclusion that there was no antitrust violation because BAPCO had not "sought to extend the exclusionary power granted by the copyrights beyond the protection of the copyrighted directories." BAPCO only seeks to enforce its exclusionary rights in intellectual property which is an objective "for limited times" [32] countenanced by the Constitution and the copyright laws. Although enforcement of their copyright privileges does give BAPCO a competitive advantage in the advertisement sales market, this advantage is legitimately within the range of sanctioned benefits inherent in compilation copyright ownership.

Any suspicion that BAPCO has extended its privileges beyond that which is protected by copyright is dispelled by the fact that Southern Bell furnished Donnelley with a list of its business telephone subscribers pursuant to a license agreement. The furnished information includes names, addresses and telephone numbers for Southern Bell's business subscribers. By enforcing its copyright, BAPCO only seeks to prohibit Donnelley from appropriating its protected format and organization of the information published in the phone directory. BAPCO has not blocked the use of any information that is essential for competition as accused. Instead, BAPCO's alleged

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[31] *United States v. United Shoe Mach. Corp.*, 110 F.Supp. 295 (D.Mass.1953) (patentee violated Sherman Antitrust Act by leasing patented shoe manufacturing machinery pursuant to comprehensive lease agreements which induce lessor to rent successive machines and attain maintenance service only from patentee) *aff'd per curiam*, 347 U.S. 521, 74 S.Ct. 699, 98 L.Ed. 910 (1954); *Morton Salt Co.*, 314 U.S. 488, 62 S.Ct. 402 (patentee misused patent by illegally tying the license of patented machines with the sale of patentee's unpatented salt tablets).

[32] U.S. Const. art. I, § 8, cl. 8.

accomplice, Southern Bell, has made the information available to Donnelley. Accordingly, we affirm the conclusion that the antitrust misuse defense is not applicable to the undisputed facts of the case.

Conclusion

We agree with the district court that there were no issues of material fact before the trial court on the motions for summary judgment. BAPCO possessed a valid copyright in, and Donnelley copied, the original format of the Yellow Pages. Because the undisputed facts do not support Donnelley's fair use and misuse defenses, BAPCO is entitled to summary judgment on the issue of copyright infringement. Accordingly, the order for summary judgment and the injunction and restraining order were appropriately entered by the District Court for the Southern District of Florida. AFFIRMED.

APPENDIX C

UNITED STATES DISTRICT COURT
S.D. FLORIDA

No. 85-3233-CIV

BELLSOUTH ADVERTISING & PUBLISHING CORPORATION,
Plaintiff-Counterdefendant,

v.

DONNELLEY INFORMATION PUBLISHING, INC.,
Defendant-Counterclaimant,

v.

BELLSOUTH CORPORATION and SOUTHERN BELL TELEPHONE and TELEGRAPH COMPANY,
Additional Counterdefendants.

Oct. 27, 1988

Anthony B. Askew, Robert E. Richards, Stephen M. Schaetzel, Jones, Askew & Lunsford, Atlanta, Ga., Eric B. Meyers, Stephen B. Gillman, Shutts & Bowen, Miami, Florida, for BellSouth Advertising & Pub. Corp.

King & Spalding, Atlanta, Ga. and Shutts & Bowen, Miami, Fla., for BellSouth and Southern Bell Tel. and Tel. Co.

Fowler, White, Burnett, Hurley, Banick & Strickroot, P.A., Miami, Fla., for Donnelley Information Pub., Inc.

AMENDED MEMORANDUM OPINION

SCOTT, District Judge.

I. INTRODUCTION

THIS MATTER is before the Court on the parties' Motions and Cross-Motions for Summary Judgment. Plaintiff/Counter-Defendant BellSouth Advertising and Publishing Corporation's ("BAPCO") amended complaint against Defendant/Counterclaimant Donnelley Information Publishing, Inc. ("Donnelley") alleges copyright infringement, trademark infringement and unfair competition arising from Donnelley's publication and distribution of a classified advertising directory in South Florida. In its answer, Donnelley counterclaims against BAPCO, as well as Southern Bell Telephone and Telegraph Co. ("Southern Bell") and BellSouth Corporation ("BellSouth"), alleging that Counterdefendants illegally monopolized and attempted to monopolize the market for advertising directories in certain parts of Florida, in violation of Section 2 of the Sherman Act, 15 U.S.C. § 2, and Florida Statutes, § 542.19. After full and complete discovery, the voluminous record is replete with exhibits and depositions. The issues have been extensively briefed and are ripe for disposition.

II. FACTS AND PROCEDURAL POSTURE

In accordance with the "Plan of Reorganization and Divestiture" approved on August 5, 1983, by the United States District Court for the District of Columbia, American Telephone & Telegraph Company ("AT & T") was divided into seven regional companies. BellSouth is one of the seven regional companies and is the holding company for the stock of Southern Bell. Following the divestiture of AT & T, BellSouth created BAPCO as a wholly-owned subsidiary for the purpose of preparing, publishing and distributing telephone directories. *See generally Western Union Tel. Co. v. F.C.C.*, 815 F.2d 1495 (D.C.Cir. 1987); *GTE Service Corp. v. F.C.C.*, 782 F.2d 263 (D.C.Cir.1986).

On December 30, 1983, BellSouth Advertising and Publishing Corporation ("BAPCO")[1] and Southern Bell entered into an agreement by which Southern Bell granted to BAPCO the sole right to publish a classified advertising directory for the greater Miami, Florida area.[2] Pursuant to this agreement, BAPCO published and distributed a classified advertising directory known as the "1984 Miami Yellow Pages".[3] Southern Bell provided BAPCO with listing data for all new, changed and disconnected telephone subscribers, along with data for each foreign listing.[4] Additionally, BAPCO owns a valid copyright in the 1984 Greater Miami classified telephone directory.[5]

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[1] BAPCO is a corporation organized and existing under the laws of the State of Georgia, having its principal place of business at Atlanta, Georgia.

[2] Under the terms of the agreement between BAPCO and Southern Bell, BAPCO is engaged in "creating, compiling, publishing and distributing telephone directories and classified directories in the State of Florida, particularly the Greater Miami area." Amended Complaint, page 3.

[3] The directories were distributed in the following format:
(a) Greater Miami 1984-85 Yellow Pages—Vol. A-L
(b) Greater Miami 1984-85 Yellow Pages—Vol. M-Z.

[4] As per the terms of the agreement, Southern Bell provides BAPCO with information concerning its subscribers. Southern Bell obtains information from a new business telephone subscriber, which includes: (a) name; (b) name of business; (c) place of business; (d) directory address; (e) billing address; (f) desired type of phone equipment; (g) quantity of telephone books desired; (h) information about the number of jacks on the premises to facilitate installation; (i) number of business lines desired; (j) credit information; (k) remote call forwarding information; (l) long distance carrier desired; and (m) desired "Yellow Pages" heading. Mitchell Affidavit, para. 5.

[5] BAPCO published the 1984 Miami Yellow Pages with an appropriate copyright notice therein and otherwise complied in all respects with the applicable copyright laws. On October 10, 1984, BAPCO obtained, through deposit and registration of the works, federal registration of the copyright for the 1984 Miami Yellow Pages and has received from the Register a Copyright Certificate of Registration Nos. TX 1-425-775 and TX 1-425-783.

Following publication of the 1984 Miami Yellow Pages, Donnelley began the promotion and sale of classified advertising in a competitive classified directory for the Greater Miami area (hereinafter the "Donnelley Directory"). On August 23, 1984, Mr. William Bak, then Executive Vice President of Reuben H. Donnelley Corporation,[6] wrote to BAPCO requesting information about how Donnelley could obtain "listings" in connection with its own directory activities. Exhibit B to Mitchell Affidavit.

Following those discussions, Southern Bell entered into four business agreements with Donnelley for the publication and distribution of a competing classified advertising directory in the Miami area through which Southern Bell provided Donnelley with the name, address, and telephone number of its relevant business subscribers. This information is the same non-confidential business subscription information that Southern Bell provides to all similarly situated independent publishers.[7]

On October 2, 1985, BAPCO filed suit against Donnelley alleging three causes of action: (1) infringements of BAPCO's copyrights in the 1984 Miami Yellow Pages; (2) trademark infringement; and (3) unfair competition.[8] BAPCO moved for a preliminary injunction on

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[6] Mr. Bak is currently the president of Donnelley.

[7] There are fifty-seven (57) such license agreements now in effect.

[8] Donnelley did not request from Southern Bell any additional information until *after* BAPCO filed its Complaint, Born Affidavit, paras. 71-20, whereupon Donnelley sent a letter to Southern Bell on November 8, 1985, demanding comprehensive access to numerous catagories of information never before requested. Exhibit E to Born Affidavit. Donnelley's letter demanded the identical access to Southern Bell's subscriber information, both in form and content, that Southern Bell provided to BAPCO. The letter asserted that such identical access was "essential" for Donnelley to publish a classified directory. Donnelley also demanded on-line computer access to Southern Bell's subscriber data bases.

the copyright count, requesting that distribution of the Donnelley directories be prohibited. An evidentiary hearing was held in which substantial evidence was introduced. Donnelley neither disputed the validity of BAPCO's copyright registration for the 1984 Miami Yellow Pages nor denied obtaining listings and advertisements from the 1984 Yellow Pages in the preparation and publication of Donnelley's Miami North and Miami South classified telephone directories.

Donnelley's defense was essentially threefold: First, Donnelley alleged that BAPCO had purposely delayed filing the case until the eve of publication and, therefore, the alleged injury was not irreparable; second, Donnelley alleged unclean hands and antitrust violations by BAPCO, Southern Bell, and BellSouth; and third, the copyright laws did not prevent Donnelley from obtaining the listings and advertisements from BAPCO's copyrighted telephone directories.

The Court agreed with Donnelley's argument that "BAPCO's delay of over seven months in seeking injunctive relief [was] in conflict with its allegations of an urgent need to prevent irreparable injury."[9] Accordingly, BAPCO failed to meet its burden of persuasion that it would suffer irreparable injury sufficient to warrant the granting of an injunction.[10]

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[9] Order, dated October 31, 1985, page 6. As stated by the Court:

> During the course of the preliminary injunctive hearing, BAPCO failed to introduce any competent evidence to meet the "irreparable injury" prerequisite. BAPCO's references to irreparable harm were limited to argument of counsel. Conversely, the harm to Donnelley is real and imminent. Donnelley has invested literally millions of dollars and thousands of personnel-hours in its directory. Donnelley's very business reputation is at stake if the directory is not published the week of November 4, 1985.

[10] The Court, *sua sponte*, stayed execution of its Order denying preliminary injunctive relief for one (1) week in order to permit BAPCO an opportunity to perfect an appeal to the Eleventh Cir-

Before Donnelley answered the original complaint, BAPCO amended its complaint, expanding the allegations of copyright infringement to include all BAPCO copyrighted classified telephone directories from which Donnelley had obtained listings and advertisements.[11] The amended complaint was filed November 7, 1985. Donnelley answered, naming BAPCO, Southern Bell, and BellSouth, as Counterdefendants and alleged: (1) unlawful monopolization; (2) unlawful attempt to monopolize; and (3) invalid trademark registrations.[12]

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cuit. BAPCO filed its Notice of Appeal on October 31, 1985. On November 15, 1985, BAPCO moved to dismiss the appeal pursuant to Rule 42(b) of the Federal Rules for Appellate Procedure, which was entered by the Clerk of Court on November 25, 1985.

[11] According to the Amended Complaint, Donnelley used the 1984 Miami Yellow Pages in violation of the copyright laws of the United States in the preparation of the Donnelley Directory and in the preparation of materials for use in the solicitation of advertisements for the Donnelley Directory. Specifically, BAPCO alleges that Donnelley, without permission "made or required, at least one complete, unauthorized copy of the 1984 Miami Yellow Pages which was made by copying the work, or substantial portions thereof, into a computer data base so that said copy is in machine-readable form in collatable machine memory and/or recorded on magnetic media." Amended Complaint, page 9. Further, BAPCO alleges that "Donnelley unlawfully used said machine-readable copy of the 1984 Miami Yellow Pages, and/or hard copies thereof, in whole or in part, to contact the listed businesses and advertisers in the BAPCO 1984 Miami Yellow Pages and request that they place the same or substantially similar listings and advertisements in the Donnelley Directory. Specifically, . . . Donnelley used said machine-readable copy of the 1984 Miami Yellow Pages to generate sales lead sheets." *Id.* Finally, BAPCO alleges that Donnelley's use of the phrase "Yellow Pages" and the "Walking Fingers" logo is misleading to the public and violates BAPCO's registered trademarks.

[12] According to Donnelley's allegations, BAPCO, Southern Bell, and BellSouth have deliberately acquired and unlawfully maintained market power in the classified directory market by using their market power to exclude Donnelley and other potential competitors from the monopolized market in violation of federal and state

Following extensive discovery, the parties submitted voluminous motions for summary judgment—to wit:

(1) Donnelley moved for Summary Judgment on BAPCO's copyright claims.

(2) Donnelley moved for partial Summary Judgment on BAPCO's trademark claims;

(3) Donnelley moved for Summary Judgment seeking to cancel registration of the "Walking Fingers" logo;

(4) BAPCO moved for Summary Judgment on the copyright claims.

(5) BAPCO, BellSouth, and Southern Bell moved for Summary Judgment on Donnelley's antitrust counterclaims and defenses.

Oral argument was originally conducted on Friday, October 3, 1986. At the close of argument, the Court inquired as to whether discovery was complete. The parties indicated that "key" discovery needed to be taken. In view of these representations at oral argument, the Court allowed additional discovery. The parties were also granted leave to file supplemental memoranda and exhibits relating to their respective motions. In order to assist the Court in concluding this matter, the parties reargued their respective motions on May 22, 1987. Each motion as it relates to a substantive area of the law will be addressed independently.

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antitrust laws. Specifically, Donnelley alleges that "the license agreement offered by Southern Bell is a refusal to provide information known by it to be essential to the sale of advertising, compilation, publication and distribution of a fully competitive classified advertising directory." Answer, page 20.

Additionally, Donnelley asserts that the Counter-defendants and/or their predecessor-in-interest, AT & T, have abandoned the "Walking Fingers" logo, which has ceased to function as a trademark. Answer, page 26.

III. LEGAL DISCUSSION

A. COPYRIGHT

BAPCO moves for summary judgment [13] on count one of the amended complaint, arguing that Donnelley violated the copyright laws by reproducing the 1984 Miami Yellow Pages. As direct evidence of copying, BAPCO submits that Donnelley's own admissions, as well as the testimony of Donnelley's own employees, clearly establish that Donnelley actually copied name, address, telephone number and classified heading from the 1984 Miami Yellow Pages on to sales lead sheets and then into the Donnelley directories. As indirect evidence of mass copying, BAPCO argues that the 1984 Miami Yellow Pages were easily accessable to Donnelley, there being over 1,100,000 copies in circulation. Additionally, BAPCO asserts that the Donnelley sales lead sheets and the Donnelley directories are substantially similar to the 1984 Yellow Pages, relying mainly on the presence of "common errors" between the two publications.

In its Cross-Motion for Summary Judgment and Opposition to BAPCO's Motion for Summary Judgment, Donnelley's principal argument is that the names, addresses, and telephone numbers as they appear under yellow page headings in BAPCO's classified directories are not copyrightable subject matter. "Donnelley bases its claim of non-infringement on the contention that the particular material it has copied, because of both its nature and origin, is not protected by BAPCO's copyright." Concise Statement of Donnelley Information

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[13] Summary Judgment has specifically been found to be appropriate for deciding issues of copyright infringement. *Ferguson v. National Broadcasting Co., Inc.*, 584 F.2d 111, 200 U.S.P.Q. 65 (5th Cir.1978); *Chess Music, Inc., v. Tadych*, 467 F.Supp. 819, 204 U.S.P.Q. 516, 518 (E.D.Wis.1979); *see also Midway Mfg. Co. v. Bandai-American, Inc.*, 546 F.Supp. 125, 216 U.S.P.Q. 812, 822 (D.N.J.1982); *Knickerbocker Toy Co., Inc. v. Genie Toys, Inc.*, 491 F.Supp. 526, 211 U.S.P.Q. 461 (E.D.Mo.1980).

Publishing, Inc., Pursuant to Order of April 3, 1987, page 4.

To prevail on a claim of copyright infringement, a copyright owner must establish ownership of a valid copyright in the work and copying of that work by the defendant. *Donald Frederick, Evans and Assoc., Inc. v. Continental Homes, Inc.*, 785 F.2d 897, 903 (11th Cir. 1986); *Southern Bell Tel. & Tel. v. Assoc. Tel. Directory Publishers*, 756 F.2d 801, 810 (11th Cir.1985) (citing *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821 (11th Cir.1982); *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365 (5th Cir.1981)). Further, the "mere use of information contained in a directory without a substantial copying of the format does not constitute infringement." *Miller*, 650 F.2d at 1369-70; *New York Times Co. v. Roxbury Interface, Inc.*, 434 F.Supp. 217 (D.N.J.1977). Thus, there are three elements that must be established in order to show copyright infringement. These elements include:

(i) ownership of a valid copyright due to creation of an original work of authorship;

(ii) defendant's copying from plaintiff's work; and

(iii) the defendant's copying of enough protected expression to constitute an unlawful appropriation, i.e., a substantial and material taking.

When there is substantial copying, the alleged infringer may raise the issue of fair use, which is a defense in which various factors are balanced to determine if the defense is justified. *Assoc. Tel. Directory*, 756 F.2d at 810.

1. *Ownership of a Valid Copyright*

Directories such as the 1984 Miami Yellow Pages at issue in this case may receive copyright protection as "literary works" under 17 U.S.C. § 101 (1977). *Assoc. Tel Directory*, 756 F.2d at 809. *Southwestern Bell*

Media, Inc. v. Trans Western Publishing, Inc., 670 F. Supp. 899 (D.Kan.1987) (citing *Hutchinson Telephone Co. v. Frontier Directory Co.*, 770 F.2d 128 (8th Cir. 1985)); *Rural Tel. Service Co. v. Feist Publications, Inc.*, 663 F.Supp. 214, 218 (D.Kan.1987). This is true despite the fundamental principle of copyright law that facts cannot be copyrighted. *See* 17 U.S.C. § 102(b); *Miller*, 650 F.2d at 1368-69. Directories are also "compilations," which are defined as follows:

> A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. 17 U.S.C. § 101.

Thus, it has been held that,

> a telephone directory compilation whose components are comprised exclusively of information in the public domain can be protected by the copyright laws only as to the selection and arrangement of the compilation, the work as a whole, and not as to the preexisting information.

Assoc. Tel. Directory, 756 F.2d at 810. Directories in particular are afforded special protection as to the selection and arrangement of factual material notwithstanding the difficulty in reconciling this position with the principle that facts are not copyrightable. *See Miller*, 650 F.2d at 1370.

BAPCO published the 1984 Miami Yellow Pages with the appropriate copyright notice on each page. Furthermore, BAPCO filed for and received from the Registrar of Copyrights Certificates of Copyright Registration Nos. TX 1-425-775 and TX 1-425-783 for the 1984 Miami Yellow Pages. *See infra* note 5. Moreover, Donnelley does not contest the validity of BAPCO's copyrights of its classified telephone directories. In response to

BAPCO's Second Set of Interrogatories, Donnelley stated that it "does not contend that BAPCO's compilation copyright in the 1984 Miami Yellow Pages is invalid." Answer to Interrogatory No. 20, page 10.

The gravamen of Donnelley's argument of non-infringement is that the particular material it has copied, because of both its nature and its origin, is not protected by BAPCO's copyright. Concise Statement of Donnelley, pursuant to Order of April 3, 1987, page 4. Donnelley's fundamental claim, therefore, is that BAPCO did not select, coordinate or arrange the collection of facts to the extent that the directory became an original work of authorship. Although Donnelley's claim is well briefed, it does not apply to the facts of this case and fails to adequately distinguish case law binding on this Court.

This case is controlled to a large extent by *Southern Bell Telephone & Telegraph Co. v. Associated Telephone Directory Publishers,* 756 F.2d 801 (11th Cir.1985). In that case the court held that Southern Bell owned a valid copyright in the 1982 Atlanta Yellow Pages and enjoined the defendants from using photocopies of that compilation. The 1984 Miami Yellow Pages were compiled in an identical manner as the 1982 Atlanta Yellow Pages.[14] Second Affidavit of Bob Johnson at p. 1. Donnelley has not shown any facts which contradict this holding. Thus, the opinion by the Eleventh Circuit in *Assoc. Tel. Directory* that the 1982 Atlanta Yellow Pages were validly

[14] The court finds no material difference in the photocopying which took place in *Assoc. Tel. Directory* and the copying resulting from the input into a computer of every name, address, telephone number and associated classified heading for every listing in BAPCO's directory. Donnelley prepared sales lead sheets and its directories from these computer tapes. Although keying information into a computer and printing it out may not appear as egregious as photocopying, BAPCO's copied listings and headings still make up a substantial majority of Donnelley's directories. There is no meaningful distinction between photocopying material and inputing material into a computer before printing it out.

copyrighted is extremely persuasive authority that the 1984 Miami Yellow Pages are also validly copyrighted.

Both parties have submitted a multitude of authority regarding the legal standards by which compilations are to be measured under Section 101 of the Copyright Laws. Some courts have applied a "sweat of the brow" test to determine whether a particular compilation is copyrightable.[15] Under this test the factual compilations of a copyright owner are protected in that a subsequent compiler of such facts must do his own independent research and expend his own labor and effort. Other courts apply a "selection, coordination or arrangement" test in assessing copyrightability.[16] Although the underlying facts are unprotectable under this test, the compilation as a whole is protected as to the selection and arrangement of such facts. Although the Court prefers the "selection, coordination or arrangement" test, it is not clear which test the Eleventh Circuit adopted in *Assoc. Tel. Directory*.[17] It is clear, however, that BAPCO's directory meets both tests.[18]

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[15] Cases applying the "sweat of the brow" test include: *Hutchinson Telephone Co. v. Fronteer Directory Co.*, 770 F.2d 128 (8th Cir.1985); *Schroeder v. William Morrow & Co.*, 566 F.2d 3 (7th Cir.1977).

[16] Cases applying the "selection, coordination or arrangement" test include: *Financial Information, Inc. v. Moody's Investors Service, Inc.*, 751 F.2d 501 (2d Cir.1984); *Eckes v. Card Prices Update*, 736 F.2d 859 (2d Cir.1984).

[17] The Court stated:

> Our inquiry here does not require that we choose between a limited or more expansive standard of originality under the Act. It is enough that originality is to be tested by the nature of the selection and arrangement of the preexisting material in the compilation.

Assoc. Tel. Directory, 756 F.2d at 809 n. 9. But, without adopting a test, the Court concluded that the 1982 Atlanta Yellow Pages met the more vigorous "selection, coordination or arrangement" test.

[18] BAPCO and its affiliations have expended great efforts in collecting, assembling, compiling and publishing its directors. *See*

BAPCO collects and assembles preexisting material in the form of names, addresses, telephone numbers and classified headings. The process begins when Southern Bell sends BAPCO the name, address, telephone number (and sometimes a free listing classification) from business telephone subscribers when they obtain service from Southern Bell. BAPCO receives this information randomly and not sorted by geographical area, area code or telephone exchange. BAPCO then performs various acts of selection, coordination and arrangement of this information, which lead to the final organized Yellow Pages.

BAPCO performs various acts of selection which contribute to the publication of the directory. These acts include selection of the geographical area to be covered by a directory; selection of the number of free listings to be provided; selection of the requirement that businesses use business telephone service in order to advertise in the BAPCO directory; selection by the sales force of the headings which will be recommended to a customer; selection of the classified headings which will be available for a particular directory; selection of the headings under which an advertiser's listing will appear; selection of the criteria under which advertisers may or may not be permitted to advertise under headings not related to their business; selection of the number of free listings to be provided telephone subscribers; selection of customers who will be contacted by premise sales personnel, telephone sales personnel and no contact; selection of the date of commencement of a sales campaign; and selection of the date of closing the directory. *See* Second Affidavit of Bob Johnson.

BAPCO also engages in acts of coordination and arrangement which aid to the Yellow Pages publication.

Affidavit of Bob John; Second Affidavit of Bob Johnson. Donnelley does not claim to have used its own efforts in compiling the material published in its directory. There is no doubt, therefore, that BAPCO has met the "sweat of the brow" test.

BAPCO coordinated the headings. In addition, BAPCO arranged these headings, along with all of the listings under a particular heading, in alphabetical order. BAPCO chose to coordinate and arrange its directory in this manner from other alternatives. For example, BAPCO could have chosen to arrange its headings according to the numbers of advertisers or to arrange its listings under headings according to which listing had been advertising under that heading for the longest period of time.

Donnelley does not dispute that BAPCO performs these acts. The dispute centers only on the legal effect of such acts. All of BAPCO's acts contribute to the publication process and are identical to those carried out in aiding the publication of the 1982 Atlanta Yellow Pages. Because the opinion in *Assoc. Tel. Directory* held the Atlanta Yellow Pages to be validly copyrighted and because BAPCO has created a unique directory due to its method of selecting, coordinating and arranging its material, the Court concludes that BAPCO's compilation is an original work of authorship which is subject to a valid copyright.[19]

2. *Defendant's Copying From Plaintiff's Work*

This element of copyright infringement may be shown directly by an admission of copying by the defendant, or indirectly by proving access to the directory and substantial similarity between the plaintiff's and defendant's work. *Rural Tel. Ser. Co. Inc. v. Feist Publications, Inc.*, 663 F.Supp. 214 (D.Kan.1987); *Central Tel. Co. of Virginia v. Johnson Publishing Co.*, 526 F.Supp. 838, 843 (D. Colo.1981). It is well-settled that one of the most significant evidences of copying is the existence of common errors between the two directories. *Rural Telephone*, 663 F.Supp. at 218. *See also Fin. Information, Inc. v. Moody's In-*

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[19] Although not dispositive of the issues here we note parenthetically that Donnelley's acts of copying would have violated Donnelley's copyright notification in its own copyrighted directories. Deposition of Ernest J. Martin at 407, 410-11, 435.

vestors Serv., Inc., 599 F.Supp. 994, 996 n. 3 (S.D.N.Y. 1984); *Central Tel. Co.*, 526 F.Supp at 844.

There does not appear to be any dispute that Donnelley copied from BAPCO's copyrighted directory. Donnelley has never disputed "that it has copied material from BAPCO's directories." Concise Statement of Donnelley, Pursuant to Order of April 3, 1987, p. 4. This concession is buttressed by substantial facts of copying in the record.

Donnelley obtained copies of the 1984 Miami Yellow Pages and coded these pages for copying.[20] The coded pages were then sent to Appalachian Computer Services, Inc. ("Appalachian"), a data entry company located in London, Kentucky.[21] Appalachian reproduced in machine (computer) readable form every paid listing and every advertisement in the 1984 Miami Yellow Pages by "keying" (reproducing) into a computer data base the following information: name, address, telephone numbers, the code corresponding to the classified heading, a code corresponding to the unit of advertising and a code for the directory from which it came. This information was stored on magnetic tape and sent to Donnelley.

Donnelley then edited, compiled and organized the information on the magnetic tape, adding heading codes that

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[20] Copies of the 1984 Miami Yellow Pages were cut apart and each sheet was individually mounted on a stiffer backing sheet for ease of handling. Each mounted sheet was then coded in red ink by Donnelley personnel. This coding procedure involved marking each classified heading with a corresponding code and an advertising code.

[21] Appalachian specialized in converting data from paper or hard copy form to a computer or machine readable form by typing or "keying" data from the 1984 Miami Yellow Pages which appears on the paper into a computer terminal which then stores that computer data in magnetic form in a storage media, such as magnetic tape. *See* Appalachian Deposition, pages 10-17.

corresponded to the BAPCO classified heading. Upon completing this process, Donnelley had recorded on magnetic tape the name, address, telephone numbers, classified heading, unit of advertising and directory source from every paid listing and every advertisement in the 1984 Miami Yellow Pages. From this computer data base, Donnelley printed sales lead sheets, containing telephone numbers for every paid listing and advertisement in the 1984 Miami Yellow Pages. Collectively, the sales lead sheets constitute a reproduction of substantially the entire 1984 Miami Yellow Pages in inverted or criss-cross form. All of this information from the 1984 Miami Yellow Pages and/or sales lead sheets was then copied into the Donnelley directories and distributed in the Miami Area. A comparison of the two (2) directories reveals that Donnelley used a format nearly identical to that used by BAPCO. *See* Exhibit P and P Enlarged to BAPCO's brief.

Further evidence of copying by Donnelley is the presence of "common errors." [22] There are as many as thirty-seven (37) erroneous listings in the Donnelley directories which are identical to those in the 1984 Miami Yellow Pages.[23] Donnelley has offered no evidence to refute the

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[22] *See Rural Telephone*, 663 F.Supp. at 218; *Fin. Information*, 599 F.Supp. at 996 n. 3; *Central Tel. Co.*, 526 F.Supp. at 844.

[23] Illustrative examples of erroneous listings appearing in both the 1984 Miami Yellow Pages and the Donnelley Miami Directories are the following:

(1) On page 373 of the 1984 Miami Yellow Pages, "Fort Lauderdale News" is listed, erroneously, under the heading "Balancing Equipment". This identical listing for "Fort Lauderdale News" also appears under the heading "Balancing Equipment" in the Donnelley Miami North Directory at page 132. Copies of the pages from the 1984 Miami Yellow Pages and the Donnelley Miami Directories are attached to the second Affidavit of Barbara J. Wiggs as Exhibits 4 and 6 respectively with the subject listings highlighted in green. This entire listing is incorrect in both directories. Obviously the Fort Lauderdale News should not be listed under "Balancing

fact that it copied BAPCO's directory. Accordingly, the Court gleans from the record, three acts of copying. These include keying the information into the computer, preparing the sales lead sheets and publishing the Donnelley directories.

3. *Substantial Copying of Plaintiffs Work by Defendant*

As mentioned above, Donnelley does not contest that it copied every name, address, telephone number and classified heading from BAPCO's directories. Certainly the wholesale copying of every word in BAPCO's directory constitutes substantial copying. In addition, it does not matter that Donnelley did not produce an exact duplicate of BAPCO's directories. For example, in *Southwestern Bell Media v. Transwestern Publishing, Inc.*, 670 F.Supp. 899, 905 (D.Kansas 1987) the Court concluded that Transwestern infringed Bell Media's copyright despite noting that:

> In most of the prior federal court decisions dealing with copyright infringement in the area of telephone directories, the guilty party simply photocopied the existing directory or produced an identical listing of white pages, which is a much clearer case of copyright infringement. In the present case, Trans Western did not produce an exact, or even nearly exact,

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Equipment", a heading which is related to the balancing of automobile tires.

On page 1433 of the 1984 Miami Yellow Pages "Flash Courier Systems" is listed even though the subscriber's telephone was disconnected before January 1, 1984. This identical listing appears in the Donnelley Miami North directory at page 466. Copies of the pages from the 1984 Miami Yellow Pages and the Donnelley Miami North directory are attached to the Second Affidavit of Barbara J. Wiggs as Exhibits 37 and 39 respectively with the subject listing highlighted in green. The entire listing is incorrect in both directories. Furthermore, the listing was a "free listing" in the 1984 Miami Yellow Pages.

> copy of the Bell Media book. In a nutshell, Trans Media took essentially the same information contained in Bell Media's Yellow Pages and put it in a slightly different format.

Similarly, although Donnelley's directory is not identical to BAPCO's directory, the material was copied and used to produce a directory substantially similar in both content and format. *See* Affidavit of Barbara Wiggs; Testimony of Gerald Brown on Oct. 10, 1985. The Court easily concludes that such conduct constitutes substantial copying.[24]

4. *Fair Use Defense*

Donnelley argues that even if its copying constitutes copyright infringement, Donnelley's actions should be excused under the doctrine of "fair use." At the minimum, Donnelley claims that summary judgment is improper because of the existence of numerous material issues of fact raised by the fair use defense.

The fair use defense is a narrow exception to the Copyright Act which permits the use of copyrighted material under certain circumstances without the owner's consent. Fair use is an equitable rule of reason which must be decided on a case-by-case basis. *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 448, 104 S.Ct. 774, 792, 78 L.Ed.2d 574 (1984). *See also Harper & Row Publishers Inc. v. Nation Enterprises,* 471 U.S. 539, 105 S.Ct. 2218, 85 L.Ed.2d 588 (1985). Fair use presents a mixed question of law and fact. *Harper & Row,* 471 U.S. at 560, 105 S.Ct. at 2230; *Pacific & Southern Co. v. Duncan,* 744 F.2d 1490, 1495, n. 8 (11th Cir.1984). The burden of proving this defense is on Donnelley, the party asserting it. *Assoc. of Amer. Medical Colleges v. Mikaelian,* 571 F.Supp. 144, 151 (E.D.Pa.1983).

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[24] The substantiality of the copying is also an important factor to be analyzed in the fair use defense.

The fair use doctrine was judicially created and then codified by the Copyright Act at 17 U.S.C. § 107 (1977). The Act's preamble lists certain uses of copyrighted material that constitute fair use. These include using copyrighted material "for purposes such as criticism, comment, news reporting, teaching, scholarship [and] research." The Copyright Act then lists four factors which should be considered in evaluating whether a particular use is fair. These are:

(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit education purposes;

(2) the nature of the copyrighted work;

(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

(4) the effect of the use upon the potential market for or value of the copyrighted work.

These factors are important but are not meant to be exclusive. *Harper & Row,* 471 U.S. at 560, 105 S.Ct. at 2230. An analysis of each of these factors and the equities of the case demonstrates that Donnelley's copying of BAPCO's copyrighted material does not constitute a fair use.

a. The Purpose of the Use

It is undisputed that Donnelley's motives in copying the 1984 Miami Yellow Pages were of a purely commercial and for-profit nature. Thus, Donnelley's copying clearly does not fall under any of the listed excusable uses in the preamble to Section 107. Justice Stevens stated that such pure "commercial use of copyrighted material is presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright." *Sony Corp.,* 464 U.S. at 451, 104 S.Ct. at 793. *See also Pacific & Southern Co., Inc. v. Duncan,* 792 F.2d 1013

(11th Cir.1986). Although such commercial use standing along may not be enough to deprive one of the fair use defense, *see Meeropol v. Nizer,* 560 F.2d 1061, 1069 (2d Cir.1977), *cert. denied,* 434 U.S. 1013, 98 S.Ct. 727, 54 L.Ed.2d 756 (1978), Donnelley's copying for profit strongly militates against the applicability of the fair use defense.

b. Nature of the Copyrighted Work

As Justice O'Connor explained in *Harper & Row,* "[t]he law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy." 471 U.S. at 560, 105 S.Ct. at 2230. Although "the opportunity to use the fair use defense for copying research is broad, the opportunity to use that defense is narrow once the research is selected and arranged into a compilation and is copied." *Assoc. Tel. Directory,* 756 F.2d at 810-11. Thus, because BAPCO has selected, coordinated and arranged the facts into a compilation, Donnelley's fair use defense is now narrow.

c. The Amount and Substantiality of the Copying

Donnelley does not contend that the extent of its copying of name, address, telephone numbers and associated classified headings from BAPCO's classified directories is insubstantial or immaterial. In fact, as previously stated, Donnelley has admitted to copying into its computer every listing in BAPCO's directory. Such wholesale copying is strong evidence against the fair use defense. *Sony Corp.,* 464 U.S. at 450, 104 S.Ct. at 792. *See also infra,* subsection three (3) on substantial copying.

d. The Market Impact

The effect of the use of the copyrighted material on the potential market is perhaps the most significant factor of fair use. *Harper & Row,* 471 U.S. at 566, 105 S.Ct. at 2233. When the use is for commercial purposes, harm

to the potential market for the copyrighted work is presumed. *Id.* at 562, 105 S.Ct. at 2231. *Sony Corp.*, 464 U.S. at 451, 104 S.Ct. at 793. In addition, BAPCO has presented evidence that it is suffering harm to the good will and trust that BAPCO's advertisers have in BAPCO's directories because Donnelley has reproduced its errors, thereby perpetuating such errors a second year. Donnelley has not rebutted the presumption of harm in the market or the above described harm and, therefore, it has failed to satisfy the fourth statutory factor.

e. Other Factors

Donnelley alleges that "keying" (obtaining a copy of the local directory and placing the business listing information of name, address, telephone numbers, and business classification from that directory into a computer base) is a standard industry practice among competitive directory publishers. Donnelley contends that such practice is germane to the fair use defense. This argument is logically and legally insufficient. Such practice is not relevant to the fair use defense.

Donnelley's claim is analogous to that of a driver stopped for speeding. The driver may claim that everybody drives over fifty-five and that it is unfair to stop only him. Just as widespread abuse of speed limits is irrelevant to the crime of speeding, industrial piracy of directories, even if widespread, should not be probative of whether such piracy is a fair use.

The law supports this result. In *Meeropol v. Nizer*, 417 F.Supp. 1201, 1210 (S.D.N.Y.1976), *reversed on other grounds*, 560 F.2d 1061 (2d Cir.1977), *cert. denied*, 434 U.S. 1013, 98 S.Ct. 727, 54 L.Ed.2d 756, 196 U.S.P.Q. 592 (1978), the court stated that:

> The alleged standard rule in the publishing industry in the United States that more than 300 words of a copyrighted work does not qualify as a fair use, is

> not dispositive of a fair use question. Fair use is a legal question to be determined by the court not by alleged industry practice.

While the Second Circuit reversed because genuine issues of fact precluded summary judgment, this does not diminish the effectiveness of the lower court's pronouncement on the irrelevance of industry practice to the fair use defense.

Similarly, in *Maxtone-Graham v. Burtchaell,* 631 F. Supp. 1432, 1436 (S.D.N.Y.1986), *aff'd on other grounds,* 803 F.2d 1253 (2d Cir.1986), the court stated that:

> [T]he doctrine of fair use is a legal doctrine having Constitutional implications, it cannot be subject to definition or restriction as a result of any such trade custom or practice, no matter how long continued. Accordingly, even if such a custom were shown to exist industry wide, and it has not been, it could have no legal force.[25]

Based on this authority and the inherent weakness of Donnelley's position, the Court concludes that industrial piracy in directory compilations is irrelevant to the consideration of the fair use defense.

In determining whether Donnelley's copying constitutes fair use, the Court must engage in a balancing of all of the statutory factors, plus the other factors enumerated and raised by the parties. Upon careful application of the record and in light of the applicable authorities, *see, e.g., Southwestern Bell Media, Inc. v. Trans Western Publishing, Inc.,* 670 F.Supp. 899 at 905 (D.Kansas

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[25] *See also Leo Feist, Inc. v. Appollo Records N.Y. Corp.,* 300 F.Supp. 32 (S.D.N.Y.1969), *aff'd,* 418 F.2d 1249 (2d Cir.1970), *cert. denied,* 398 U.S. 904, 90 S.Ct. 1694, 26 L.Ed.2d 63 (1970); *Famous Music Corp. v. Seeco Records, Inc.,* 201 F.Supp. 560 (S.D.N.Y.1961); *Southern Music Publishing Co., Inc. v. Seeco Records, Inc.,* 200 F.Supp. 704 (S.D.N.Y.1960).

1987) (citing *Assoc. Tel. Directory*, 756 F.2d at 810-11), the Court concludes that Donnelley has not met the fair use defense.

5. *Anti-Trust Defense*

In addition to asserting a counter claim against BAPCO for antitrust violations, Donnelley asserts antitrust violations as an affirmative defense to BAPCO's Motion for Summary Judgment on the copyright claim. In essence, Donnelley alleges that BAPCO has driven Donnelley out of the directory business in Southern Florida and violated the antitrust laws by refusing to give Donnelley reasonable and timely access to the information necessary to compete in the directory publishing business. Antitrust violations, however, cannot be a defense to BAPCO's copyright claims.

In order for an antitrust affirmative defense to bar enforcement of a Plaintiff's copyright, the alleged antitrust violation must involve the copyright holder's attempt to extend the exclusionary power granted by its copyright.[26] Courts have ruled uniformly that no valid defense to a copyright infringement claim exists even where it is demonstrated that the copyright owner is violating the antitrust laws,[27] except possibly where there is an attempt to

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[26] This does not mean that a defendant cannot obtain redress against a copyright holder for its violation of the antitrust laws. Affirmative relief against the copyright holder to prevent a continued or remedy a past antitrust violation can be obtained pursuant to a counterclaim.

[27] *See Orth-O-Vision, Inc. v. Home Box Office*, 474 F.Supp. 672, 686 (S.D.N.Y.1979); *Foreign Car Parts of New England, Inc. v. Auto World, Inc.*, 366 F.Supp. 977, 979 (M.D.Pa.1973) ("It is doubtful that an antitrust violation creates a defense in a copyright infringement action."); *United Artists Associated, Inc. v. N.W.L. Corp.*, 198 F.Supp. 953, 957 (S.D.N.Y.1961); *Harms, Inc. v. Sansom Home Enterprise, Inc.*, 162 F.Supp. 129, 135 (E.D.Pa. 1958), *aff'd sub nom, Leo Feist, Inc. v. Lew Tendler Tavern, Inc.*, 267 F.2d 494 (3d Cir.1959).

extend the exclusionary power granted by copyright beyond the protected work itself. This narrow exception is based upon *Morton Salt Co. v. G.S. Suppiger Co.,* 314 U.S. 488, 62 S.Ct. 402, 86 L.Ed. 363 (1942), where the Supreme Court refused to enforce a Morton Salt patent because Morton Salt had sought to and did extend the exclusionary power granted by its patent beyond the protected product by tying the sale of an unpatented product to a sale of a patented product. Courts have applied this vary narrow exception in copyright cases in similar instances, not present here, of illegal tying arrangements. *See M. Witmark & Sons v. Jensen,* 80 F.Supp. 843 (D. Minn.1984), *appeal dism'd sub nom.; M. Witmark & Sons v. Berger Amusement Co.,* 177 F.2d 515 (8th Cir.1949); *Broadcast Music, Inc. v. Moor-Law, Inc.,* 208 U.S.P.Q. 487 (D.Del.1978).

The extremely narrow scope of this exception was explained in *Orth-O-Vision, Inc. v. Home Box Office,* 474 F.Supp. 672 (S.D.N.Y.1979), where the court refused to apply this exception. There, Orth-O-Vision, a middleman for the sale of pay television subscriptions, sued HBO, the pay television transmitter, for antitrust violations alleging a conspiracy to limit plaintiff's ability to supply pay television. HBO counterclaimed for infringements of its copyright. The court noted that "as a general rule, it is no defense to a copyright infringement claim that the copyright owner is violating the antitrust laws." *Id.* at 686. The court then went on to explain that, if there were an exception to this rule, such defense must involve an extension of monopoly power conferred by the copyright:

> The Supreme Court has since recognized that copyright owners may sometimes enjoy analogous market dominance over their copyrighted articles enabling them to exert anti-competitive pressure in non-copyrighted articles, *United States v. Loew's Inc.,* 371 U.S. 38, 45, 83 S.Ct. 97, 9 L.Ed.2d 11 (1962), but has not expressly held that a court of

> equity ought to decline to enjoin infringement where the copyright owner is engaged in such anti-competitive activity. Even if the rationale of Mercoid and Morton Salt were extended to copyrights, Orth-O-Vision has failed to establish its antitrust defense because there is simply no nexus between HBO's alleged anti-competitive actions and its power over copyrighted material. Unlike the patentees in Mercoid and Morton Salt, HBO is not alleged to have used its legal monopoly over the copyrighted material to exert anti-competitive power over non-copyrighted material or to have otherwise used its copyrights to extend legal monopolies beyond their proper scope.

474 F.Supp. at 686. *See Rural Tel. Serv. Co. v. Feist Publications, Inc.*, 663 F.Supp. 214, 220 (D.Kan.1987) (summary judgment granted plaintiff on copyright infringement and anti-trust violations do not constitute defense to copyright infringement); *Knickerbocker Toy Co. v. Winterbrook Corp.*, 554 F.Supp. 1309, 1322 (D.N.H. 1982) (dismissed Section 2 counterclaim where "[t]he key link—the exclusionary power of the Knickerbocker copyright, is not alleged."); *Midway Mfg. Co. v. Artic Int'l., Inc.*, 211 U.S.P.Q. 1152, 1161 (N.D.Ill.1981) (alleged antitrust violation not an affirmative defense because it "does not relate directly to the claim of copyright infringement").

Based upon the foregoing authorities, if Donnelley's antitrust affirmative defense could bar enforcement of BAPCO's copyrights, Donnelley would have to show that BAPCO sought to extend the exclusionary power granted by its copyrights beyond the protection of the copyrighted directories. In its counterclaim and not in its affirmative defense, Donnelley alleges that counter-defendants violated the antitrust laws because Southern Bell failed to provide Donnelley with updated listing information received by Southern Bell from subscribers and

supplied to BAPCO. Donnelley further alleges in its counterclaim that BAPCO improperly failed to permit Donnelley to copy BAPCO's entire classified directory. Such claims do not allege that BAPCO has attempted to extend the exclusionary power granted by its copyrights beyond the protected work itself. Moreover, Donnelley has failed to make any claim or offer any evidence that BAPCO has used its copyrights to prevent Southern Bell from providing Donnelley with raw data supplied by Southern Bell to BAPCO. The Court concurs with prior case law in concluding that antitrust violations generally do not constitute a defense to copyright infringement. The Court further finds that Donnelley has not satisfied the narrow exception to this rule. Accordingly, Donnelley's affirmative defense of antitrust violations does not bar the entry of summary judgment for copyright infringement.

In sum, upon careful review of the record and applicable law, the Court concludes that no genuine issues of material fact exist; and, therefore, BAPCO's Motion for Summary Judgment on the copyright issues is GRANTED and Donnelley's Motion for Summary Judgment is DENIED.

B. TRADEMARK/UNFAIR COMPETITION

Donnelley moves for partial summary judgment on counts two[28] and four[29] of BAPCO's amended com-

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[28] Specifically, count two of BAPCO's amended complaint alleges as follows:

45.

On information and belief, by using the trademarks, words and symbols "Yellow Pages" and the "Walking Fingers" logo, and by unlawfully using BAPCO's copyrighted 1984 Miami Yellow Pages, and by telling customers that Donnelley has "published" Southern Bell's Yellow Pages classified directories, and by telling customers that Southern Bell will no longer publish a classified directory, Donnelley has used a false desig-

plaint, which assert that Donnelley's use of the term "yellow pages" and the "walking fingers" logo, among others, constitutes federal statutory and common law unfair competition respectively. In support of its motion, Donnelley argues that BAPCO can assert no exclusive right in either the term "yellow pages" or the three-finger "walking fingers" logo. In particular, Donnelley argues that the "walking fingers" logo is in the public domain because the symbol is used by the entire classified directory industry; thus, the symbol fails to "identify and distinguish" the mark owner's goods "from those manufactured by others and to indicate the source of the goods" as required by 15 U.S.C. § 1127. Donnelley further argues that BAPCO cannot claim exclusive rights in the term

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nation of origin and/or a false description or representation, of its goods and/or services and is therefore liable in a civil action by plaintiff under Section 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125.

[29] Similarly, count four of BAPCO's amended complaint alleges as follows:

51.

On information and belief, by using the trademarks, words and symbols "Yellow Pages" and the "Walking Fingers" logo, and by unlawfully using BAPCO's copyrighted 1984 Miami Yellow Pages, Donnelley has used a false designation or origin and/or a false description of representation of its goods and/or services to create a likelihood of confusion as to the source, sponsorship or affiliation, of Donnelley and Donnelley's directory and to pass off Donnelley as BAPCO or Southern Bell.

52.

On information and belief, by telling customers that Southern Bell is no longer going to publish a classified directory in the Greater Miami are, by telling customers that Donnelley has published Southern Bell's Yellow Pages classified directories in the past and by telling customers that Donnelley is now taking over the task of publishing the classified directory in the greater Miami area, Donnelley has attempted to pass itself off as BAPCO or Southern Bell and has committed fraud on the public all to BAPCO's damage.

"yellow pages" because the term is generic and thus not protectable under trademark law.[30]

BAPCO contends that summary judgment is improper as to counts two and four because a combination of Donnelley's actions, including among others the use of the term "yellow pages" and the "walking fingers" logo, constitute unfair competition. Although BAPCO admits that it does not claim exclusive rights to the term "yellow pages," BAPCO asserts that Donnelley has used the term and the logo to confuse the public through copyright and trademark infringement in violation of the laws prohibiting unfair competition.

Donnelley has also moved for summary judgment on count three of BAPCO's amended complaint for infringement of the registered two-finger "walking fingers" trademark and on its counterclaim to cancel BAPCO's registration for the two-finger "walking fingers" logo. Donnelley contends that BAPCO and its affiliates have abandoned the two-finger mark because it has not been used in the Bell South area since 1978-79.[31]

BAPCO admits that it did not use the two-finger logo from 1979 until 1985 and that its use in 1985 followed the initiation of this lawsuit. Although this constitutes *prima facie* evidence of abandonment, it may be overcome by evidence of an intent to resume use of the mark. *Humble*, 524 F.Supp. at 465. BAPCO submits that such intent is evidenced by BAPCO's continual use of the

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[30] *See, e.g., Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 114, 59 S.Ct. 109, 111, 83 L.Ed. 73 (1938); *Miller Brewing Co. v. G. Heilman Brewing Co.*, 561 F.2d 75, 79 (7th Cir.1977), *cert. denied*, 434 U.S. 1025, 98 S.Ct. 751, 54 L.Ed.2d 772 (1978); *CES Publishing Corp. v. St. Regis Publications, Inc.*, 531 F.2d 11, 13 (2d Cir.1975).

[31] *See Exxon Corp. v. Humble Exploration Co., Inc.*, 524 F.Supp. 450, 464-65 (N.D.Texas 1981), *aff'd*, 695 F.2d 96 (5th Cir.1983) (non-use of a mark for two consecutive years *prima facie* evidence of abandonment).

similar three-finger logo in conjunction with its use of the two-finger logo because each logo creates the same commercial impression.

A careful review of the record demonstrates that there are numerous genuine issues of material fact in dispute. As to count three of BAPCO's amended complaint and Donnelley's counterclaim to cancel registration of the two-finger "walking fingers" logo, genuine issues of fact exist as to the use of abandonment and BAPCO and its affiliates' intent to resume commercial use of the two-finger logo. As to counts two and four of BAPCO's amended complaint, issues of fact exist in light of BAPCO's "Directory and Symbol Study" [32] and BAPCO's "Symbol Study." [33] The first Symbol Study, which shows that the public to some extent recognizes the three-finger logo as a trademark indicating BAPCO or one of its affiliates, creates a factual issue as to whether the logo has been dedicated to the public. Similarly, the Directory Study and the second Symbol Study, which demonstrates that the public to some extent associates the identifying elements of the "yellow pages" term and the walking fingers logo as used in connection with a BAPCO directory,

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[32] Two separate surveys were conducted on the same day. In the Directory Study people were given a 1985-86 Donnelley Yellow Pages and then asked which company put out the directory. Over three times as many people thought the Donnelley directory was published by BAPCO as thought the directory was published by Donnelley. In the Symbol Study people were shown a naked replica of the three-finger "walking fingers" logo and asked which company uses the symbol. Roughly 59% of those surveyed thought the logo was a symbol identifying BAPCO or its affiliates and only 1% thought the symbol to identify Donnelley.

[33] In the Symbol Study the interviewer explained the difference between a brand name and a generic term to each respondent. Each respondent was then shown six symbols, including Mr. Peanut, Walking Fingers, RX, Skull & Crossbones, Morton's Salt Girl and a Barber Pole, and then asked whether or not the symbol is a brand of product. The survey yielded high percentages of 97, 94 and 74 respectively for Mr. Peanut, Morton's Salt Girl and Walking Fingers.

creates issues of fact as to the trademark significance of both the three-finger logo and the term "yellow pages."

The above described genuine issues of material fact preclude granting summary judgment as to the trademark issues.[34] Accordingly, Donnelley's Motions for Summary Judgment as to counts two, three and four of BAPCO's amended complaint and as to its counterclaim to cancel BAPCO's registration for the two-finger "walking fingers" logo are hereby DENIED.

C. ANTITRUST

In its amended answer Donnelley counterclaims against BellSouth, Southern Bell and BAPCO alleging that the three Bell companies together have violated federal and state antitrust laws. Counts one and two are for monopolization and attempted monopolization and allege violations of Section 2 of the Sherman Act (15 U.S.C. § 2). Count three alleges this same conduct is in violation of Florida Statutes Section 542.19. The gravamen of Donnelley contentions is that the Bell Companies have a monopoly in the market for the sale of advertising and have willfully maintained such monopoly power by not providing Donnelley with enough information, such as business classifications and updates, allegedly essential to compete in the directory business, in a timely fashion so as to enable Donnelley publish a competing directory.

All three of the Bell companies have moved individually for summary judgment against Donnelley on the antitrust counterclaims. Southern Bell generally contends that: (1) it does not have monopoly power in the relevant market, which is that of business information; (2) it has provided Donnelley with all the information necessary to compete and has not refused to deal with Don-

[34] BAPCO is given the benefit of all reasonable doubts and favorable inferences. *Poller v. Columbia Broadcasting System, Inc.*, 368 U.S. 464, 82 S.Ct. 486, 7 L.Ed.2d 458 (1962); *Kypta v. McDonald Corp.*, 671 F.2d 1282 (11th Cir.1982).

nelley; and (3) Donnelley has not offered sufficient evidence of "injury-in-fact" to avoid summary judgment. BellSouth and BAPCO's basis for summary judgment will be addressed hereafter.

The elements of a monopoly in violation of Section 2 of the Sherman Act are set forth in *United States v. Grinnell Corp.*, 384 U.S. 563, 86 S.Ct. 1698, 16 L.Ed.2d 778 (1966). The offense of monopoly consists of: "(1) the possession of monopoly power in the relevant market and (2) the willfull acquisition or maintenance of that power as distinguished from growth or development as a consequence of a superior product, business acumen, or historic accident." *Id.*, at 570-71, 86 S.Ct. at 1703-04. *See also St. Joseph's Hospital v. Hospital Corp. of America*, 795 F.2d 948 (11th Cir. 1986). Proof of a private monopolization claim also requires proof of a causal relationship between the antitrust violation and specific injury to plaintiff's business or property. *McClure v. Undersea Indus., Inc.*, 671 F.2d 1287, 1289 (11th Cir.1982); *Drinkwine v. Federated Publications, Inc.*, 780 F.2d 735, 738-39 (9th Cir.1985), *cert. denied*, 475 U.S. 1087, 106 S.Ct. 1471, 89 L.Ed.2d 727 (1986). To prove an attempt to monopolize plaintiff must show a specific intent to accomplish monopolization and that there existed a dangerous probability that the attempt would be successful. *Ad-Vantage Telephone Directory Consultants v. GTE Directories*, 849 F.2d 1336, 1341 (11th Cir.1987); *Spectrofuge Corp. v. Beckman*, 575 F.2d 256, 276 (5th Cir.1978), *cert. denied*, 440 U.S. 939, 99 S.Ct. 1289, 59 L.Ed.2d 499 (1979).

The offenses of both monopoly and attempt to monopolize require proof of the relevant product and geographic markets, which are a question of fact for the jury. *Ad-Vantage*, at 1341. Both claims also require proof of the intent of defendants to acquire or maintain a monopoly, which necessarily requires a factual determination from the evidence presented.

In the offense of monopoly (which Donnelley chiefly relies upon), the need to prove defendant's intent is obviated if the plaintiff successfully demonstrates that it has been denied an essential facility. *See Aspen Skiing Co. v. Aspen Highlands Skiing Corp.*, 472 U.S. 585, 105 S.Ct. 2847, 86 L.Ed.2d 467 (1985). Southern Bell argues that only tangible physical objects are "facilities" and, as such, because the Bell Companies allegedly withheld from Donnelley only information, the essential facilities doctrine does not apply. Southern Bell further buttresses its argument with *Directory Sales Management Corp. v. Ohio Bell Telephone Co.*, 833 F.2d 606 (6th Cir.1987), which states that the service of business classifications is not an essential facility because such information is unreliable and thus, has to be duplicated in any event by a competitor.

Although the doctrine of essential facilities has been applied predominantly to tangible assets, there is no reason why it could not apply, as in this case, to information wrongfully withheld The effect in both situations is the same: a party is prevented from sharing in something essential to compete. *See Driscoll v. New York*, 650 F.Supp. 1522, 1529 (S.D.N.Y.1987) (essential facilities doctrine applies "where there has been 'denial of access to physical structures or discreet [sic] *services.*'" (citing *Midsouth Grizzlies v. National Football League*, 550 F.Supp. 558, 570 n.32 (E.D.Pa.1982)). In addition, the opinion in *Ohio Bell* appears to base its ruling on the "uncontroverted evidence," in that the plaintiff would not be given a competitive advantage because the business classifications are unreliable. No such evidence of unreliability exists in this case. Accordingly, Donnelley is not precluded from attempting to prove intent by using the essential facilities doctrine in conjunction with other evidence that the Bell companies willfully maintained a monopoly.

The application of the essential facilities doctrine raises genuine issues of material facts. Specifically, there are

clear factual disputes as to the essentiality of the data Donnelley seeks and the availability of such data from sources alternative to the Bell companies. Moreover, there are numerous other factual issues in dispute under the rubrics of antitrust. Indeed, the parties cannot even agree on the very first issue in a monopoly claim—the relevant market. Donnelley contends the relevant market is for the sale of advertising directories and Southern Bell claims the market is in business information. The issue is factual, *see Ad-Vantage,* at 1341.

In sum, the plethora of factual disputes on the antitrust issues include:

1. The relevant market for the purposes of Section 2 liability;

2. Whether the Bell companies have a monopoly in such market;

3. Whether the data Donnelley seeks is essential to compete in the relevant market;

4. Whether such data may be obtained from other sources;

5. Whether the Bell companies have engaged in anti-competitive activity with the requisite intent;

6. Whether Donnelley requested certain information from Southern Bell in addition to that contracted for and whether such request was ignored;

7. Whether Southern Bell offered Donnelley such additional information; and if so, whether such offer was linked to concessions by Donnelley on the copyright issues;

8. Whether Southern Bell gave Donnelley sufficient data to realistically compete in the market for directories; and,

9. Whether the Bell companies' actions have caused Donnelley injury in fact.

Accordingly, these and other genuine issues of material fact preclude the entry of summary judgment at this time.

The final set of antitrust issues concern whether BellSouth and or BAPCO are proper defendants to Donnelley's antitrust counterclaims. Donnelley alleges that BellSouth, Southern Bell and BAPCO ("Bell Companies") jointly comprise an enterprise subject to liability under Section 2 of the Sherman Act as a matter of law. Donnelley contends that *Copperweld Corp. v. Independence Tube Corp.*, 467 U.S. 752, 104 S.Ct. 2731, 81 L.Ed.2d 628 (1984), "plainly establishes that the 'flip side' of abolishing the intra-enterprise conspiracy doctrine is that a family of corporations is an 'enterprise'—in the language of *Copperweld*—which is to be treated under Section 2." Concise Statement of Donnelley pursuant to Order of April 3, 1987 at 37-38. Alternatively, Donnelley argues that if a factual inquiry is made, then BellSouth and BAPCO's involvement in the "enterprise" is evidenced by their conduct.[35]

BellSouth contends that no federal decision, including *Copperweld,* holds that a parent company is or should be liable as a matter of law under Section 2 for the alleged unlawful activities of its subsidiaries when the parent has not engaged in any anti-competitive conduct. Concise Statement of BellSouth pursuant to Order of April 3, 1987 at 3. In addition, BellSouth argues that Donnelley has failed to submit any evidence in support of its contention that BellSouth has itself engaged in anticompetitive activity or that it should be vicariously liable[36] for

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[35] This is consistent with the Court's prior denial of summary judgment in open court as to the trademark issues. *See* Transcript of Status Conference on May 22, 1987 at 53.

[36] Because Donnelley has alleged that BellSouth has engaged in unlawful conduct in furtherance of a monopolistic scheme, BellSouth's vicarious liability is not at issue. Donnelley's Memorandum in Opposition to BAPCO and BellSouth's Motion For Summary Judgment on Antitrust Issues at 14.

the alleged unlawful activities of its subsidiaries. BAPCO argues that its only alleged improper act is the filing of this lawsuit against Donnelley and that such conduct is protected from antitrust attack by the *Noerr-Pennington* doctrine as formulated in *California Motor Transport Co. v. Trucking Unlimited,* 404 U.S. 508, 92 S.Ct. 609, 30 L.Ed.2d 642 (1972); *United Mine Workers v. Pennington,* 381 U.S. 657, 85 S.Ct. 1585, 14 L.Ed.2d 626 (1965); *Eastern Railroad President Conference v. Noerr Motor Freight, Inc.,* 365 U.S. 127, 81 S.Ct. 523, 5 L.Ed. 2d 464 (1961). BAPCO's Motion for Summary Judgment on Antitrust Issues at 9. Further, BAPCO claims that it is not liable for Southern Bell's actions as a matter of law or fact. The Court will address BellSouth's motion and then that of BAPCO.

In *Copperweld,* the United States Supreme Court addressed a situation in which anti-competitive conduct was explicitly coordinated and accomplished by two corporations. The Court held that a parent corporation and its wholly-owned subsidiary cannot be considered separate entities for purposes of a conspiracy allegation pursuant to Section 1 of the Sherman Act. In so holding, the Court rejected the long standing intra-enterprise conspiracy doctrine and recognized that a parent and subsidiary have a unity of purpose that renders unrealistic any attempts to treat them as totally independent for conspiracy purposes.

Donnelley bottoms its argument that BellSouth, as the parent corporation of Southern Bell, is liable as a matter of law on a few passages in *Copperweld.* For example:

> [A] parent and its wholly owned subsidiary have a complete unity of interest. Their objectives are common, not disparate; their general corporate actions are guided or determined not by two separate corporate consciousnesses, but one. They are not unlike a team of horses drawing a vehicle under the control

> of a single driver. *Id.* 467 U.S. at 771, 104 S.Ct. at 2741.

The Court also stated that the "single entity" test, which measure the separateness of a subsidiary, is inadequate.

> to describe a separate economic entity for purposes of the Sherman Act. The factors [to determine separateness] simply describe the manner in which the parent chooses to structure a subunit of itself. They cannot overcome the basic fact that the ultimate interests of the subsidiary and the parent are identical, so the parent and subsidiary must be viewed as a single economic unit. *Id.* at 773 n. 18, 104 S.Ct. at 2742 n. 18.

The Court concluded its opinion stating that "[a] corporation's initial acquisition of control will always be subject to scrutiny under § 1 of the Sherman Act. . . . Thereafter, the enterprise is fully subject to § 2 of the Sherman Act. . . ." *Id.* at 777, 104 S.Ct. at 2744.

This Court is thus faced with the novel issue of whether *Copperweld* should be extended to permit a parent corporation to be held liable for the conduct of its affiliates even when the parent has not engaged in unlawful conduct. No court has yet to interpret the dicta in *Copperweld* in this manner; and this Court declines to be the first. *See United National Records, Inc. v. MCA, Inc.*, 616 F.Supp. 1429, 1433 (N.D.Ill.1985) (holding that *Copperweld* does not overrule state corporate law which provides for limited liability of a parent corporation). As mentioned, *Copperweld* is a Section 1 case and that opinion only addressed the issue of separate corporate entities as it related to allegations of conspiracy. No such conspiracy is even alleged in this case and thus, BellSouth (and BAPCO) are not liable under *Copperweld* as a matter of law for Southern Bell's actions.

Donnelley has alleged, however, that BellSouth has itself engaged in anti-competitive activity in that:

1. A Corporate Policy Council composed of the most senior officers of BellSouth approved the formation of BAPCO and the form contract between BAPCO and Southern Bell.

2. BellSouth's direction of and involvement in the business of its subsidiaries, including its exercise of alleged direct control over decisions relating to their marketing of subscriber listing data bases.

3. BellSouth's sponsorship of Competitive Evaluation and Strategy Workshops for its subsidiaries, including Southern Bell and BAPCO.

4. BellSouth's provision of support services to BAPCO, including the provision of alleged critical assistance to BAPCO in developing an advertising campaign which would allegedly exploit the advantages gained by BAPCO through the Bell companies' alleged refusal to provide competitors with complete and up-to-date subscriber listing information.

5. That BellSouth officers serve as BAPCO directors.

Concise Statement of Donnelley pursuant to Order of April 3, 1987 at 38; Donnelley's Memorandum in Opposition to Motions by BAPCO and BellSouth For Summary Judgment on Antitrust Issues at 17-24 and affidavits and depositions cited therein. Supplemental Factual Statement of Donnelley in Opposition to Bell Companies' Motions For Summary Judgment on Antitrust Issues. The Court concludes that Donnelley's allegations of BellSouth's involvement and control of alleged antitrust activities, among others as supported by various affidavits and deposition testimony, are barely sufficient to defeat BellSouth's Motion For Summary Judgment on the antitrust issues. However, these issues should be properly evaluated by a jury, whose verdict will undoubtedly reflect the extent, if any at all, of BellSouth's alleged unlawful activities.

The only wrongful act by BAPCO specifically alleged in the counterclaim is the filing of the complaint against Donnelley. Donnelley has since engaged in a massive discovery effort, evidenced by the voluminous file in this case, and has not alleged any significant additional facts regarding unlawful monopoly conduct by BAPCO. Donnelley's new allegations include its principal claim that the agreement between Southern Bell and BAPCO covering directory operations, by itself, is enough to make BAPCO liable for the alleged monopolization scheme. Donnelley's Memorandum in Opposition to Motions by BAPCO and BellSouth For Summary Judgment on Antitrust Issues at 24. Donnelley also asserts that in early 1984 Southern Bell's personnel told an independent directory publisher that they would need BAPCO's approval to furnish subscriber information to that publisher. Supplemental Factual Statement of Donnelley in Opposition to Bell Companies' Motions For Summary Judgment on Antitrust Counterclaims at 13 and cited deposition. Donnelley finally contends that BAPCO has supplied subscriber listing data to an independent directory publisher to fulfill obligations of a contract between that publisher and Southern Bell and that BAPCO has provided at least one extract of business listings for use by a competitive analyst studying interexchange carriers. *Id.* at 13-14.

Although Donnelley contends that BAPCO's liability can be premised on the agreement between BAPCO and Southern Bell, Donnelley does not base its claim on the existence of the agreement. Rather, Donnelley objects to Southern Bell's alleged refusal to provide Donnelley with the identical information and services provided to BAPCO. The agreement between BAPCO and Southern Bell does not restrict Southern Bell from providing listing data or services to any third party. Because Southern Bell's agreement with BAPCO provides Southern Bell, and only Southern Bell, with the power to give or refuse to give subscriber listing data to third parties, the agreement itself fails to show any unlawful conduct by BAPCO.

Donnelley's other contentions are tenuously supported by deposition testimony and do not offer persuasive evidence that BAPCO, as opposed to the other Bell Companies, had anything but tangential involvement in the alleged anticompetitive activity. Accordingly, Donnelley has failed to offer "significant probative evidence demonstrating that a genuine issue of fact exists," as the party opposing summary judgment must do, with respect to anticompetitive activity of BAPCO. *First Nat'l Bank of Arizona v. Cities Service Co.*, 391 U.S. 253, 290, 88 S.Ct. 1575, 1593, 20 L.Ed.2d 569 (1968); *Pan-Islamic Trade Corp. v. Exxon Corp.*, 632 F.2d 539, 554 (5th Cir.1980). BAPCO's Motion For Summary Judgment with respect to Donnelley's antitrust affirmative defenses and counterclaims is therefore GRANTED.

IV. CONCLUSION

In summary, it is hereby

ORDERED and ADJUDGED as follows:

1. BAPCO's Motion For Summary Judgment on the copyright claims is GRANTED and Donnelley's Motion For Summary Judgment on the copyright claims is DENIED.

2. Donnelley's Motion for Summary Judgment on the trade-mark claims and on its counterclaim to cancel BAPCO's registration of the two-finger "walking fingers" logo are DENIED.

3. BellSouth and Southern Bell's Motions for Summary Judgment on Donnelley's antitrust counterclaims are DENIED.

4. BAPCO's Motion For Summary Judgment on Donnelley's antitrust counterclaims and affirmative defenses is GRANTED.

5. This case will be set for trial on the remaining issues by separate order.

DONE and ORDERED.

APPENDIX D

UNITED STATES COURT OF APPEALS
ELEVENTH CIRCUIT

No. 89-5131

BELLSOUTH ADVERTISING & PUBLISHING CORPORATION,
Plaintiff-Counterclaim
Defendant-Appellee,

v.

DONNELLY INFORMATION PUBLISHING, INC. and the
REUBEN H. DONNELLY CORP.,
Defendants-Counterclaim
Plaintiff-Appellants,

BELLSOUTH CORPORATION, *et al.*,
Counterclaim Defendants.

Appeal from the United States District Court
for the Southern District of Florida
Thomas E. Scott, Judge

Nov. 4, 1992

Douglas C. Broeker, Michael J. Cappucio, Fowler, White, Burnett, Hurley, Banick & Strickroot, Miami, Fla., David L. Foster, Theodore Case Whitehouse, Francis J. Menton, Jr., Willkie, Farr & Gallager, Baila H. Celedonia, Roger L. Zissu, Cowan, Liebowitz & Latman, P.C., New York City, for appellants.

Robert E. Richards, Anthony B. Askew, Jones, Askew & Lunsford, Atlanta, Ga., for Bellsouth Advertising.

John K. Roedel, Jr., Senniger, Powers, Leavitt & Roedel, St. Louis, Mo., for amicus ANADP.

Robert E. Marsh, Blackwell, Sanders, Matheny, Weary & Lombardi, Kansas City, Mo., for amicus US West.

Robert Alan Garrett, Arnold & Porter, Washington, D.C., for amicus Bell Atlantic.

ON PETITION FOR REHEARING AND SUGGESTION FOR REHEARING EN BANC

Before TJOFLAT, Chief Judge, FAY, HATCHETT, EDMONDSON, BIRCH, BLACK and CARNES, Circuit Judges.*

BY THE COURT:

A member of this court in active service having requested a poll on the application for rehearing en banc and a majority of the judges in this court in active service having voted in favor of granting a rehearing en banc,

IT IS ORDERED that the above cause shall be reheard by this court en banc. The previous panel's opinion is hereby VACATED.

* Judges Phyllis A. Kravitch, R. Lanier Anderson, III, Emmett R. Cox and Joel F. Dubina have recused themselves and will not participate.

APPENDIX E

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA
MIAMI DIVISION

No. 85-3233-CIV-TES

BELLSOUTH ADVERTISING & PUBLISHING CORPORATION,
Plaintiff-Counterdefendant,

v.

DONNELLEY INFORMATION PUBLISHING, INC., and
THE REUBEN H. DONNELLEY CORPORATION,
Defendants-Counterclaimants,

v.

BELLSOUTH CORPORATION and SOUTHERN BELL
TELEPHONE AND TELEGRAPH COMPANY,
Counterdefendants.

MODIFIED FINAL INJUNCTION AND
RESTRAINING ORDER

[Filed January 5, 1989]

NOW, THEREFORE, this Court being fully advised and having entered its Memorandum Opinion on October 27, 1988, in response to the parties' Motions and Cross-Motions for Summary Judgment, it is hereby ORDERED, ADJUDGED and DECREED that:

(1) Donnelley Information Publishing, Inc., The Reuben H. Donnelley Corporation, including but not limited to, its division Donnelley Directory, and their officers, agents, servants, employees and attorneys, and all other persons

in active concert or participation with them who receive actual notice of the Order by personal service or otherwise, and their successors and assigns other than Official Airline Guide and Donnelley Marketing and their successors and assigns (hereinafter collectively referred to as "DIP and RHD/Donnelley Directory") are hereby PERMANENTLY RESTRAINED and ENJOINED from:

(a) Keying, copying, or otherwise reproducing the Expression of Information, in whole or in part, from BAPCO copyrighted classified directories; [1]

(b) Preparing sales lead sheets from the Expression of Information keyed, copied, or otherwise reproduced, in whole or in part, from BAPCO copyrighted classified directories, or otherwise preparing derivative works based, in whole or in part, on BAPCO copyrighted classified directories;

(c) Publishing directories containing the Expression of Information keyed, copied, or otherwise reproduced, in whole or in part, from BAPCO copyrighted classified directories;

(d) Using keyed listings or listings which are otherwise mechanically or systematically reproduced from BAPCO copyrighted classified directories as a part of DIP and RHD/Donnelley Directory's directories, sales solicitations or market evaluations;

(e) Obtaining or using the Expression of Information unlawfully copied or reproduced by others from BAPCO copyrighted classified directories; and

(f) Engaging in any other conduct which constitutes infringement of BAPCO's copyrights in its classified directories.

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[1] The Court has not considered the question of copyrightability for white page directories, and the Court expresses no opinion as to the copyrightability of such white page directories.

As used herein, the term "Expression of Information" shall mean:

(a) Listings as arranged under a heading or headings;

(b) Listings and their associated heading or headings;

(c) A listing and its associated headings;

(d) The selection of headings;

(e) Listings and their associated directory advertising codes;

(f) A listing and its associated directory advertising codes; and

(g) Listings and their associated headings and their associated directory advertising codes.

As used herein, the term "listing" shall mean: the name, or the address, or the telephone number, or any combination thereof for each entity appearing in a classified directory in column or in display advertising.

(2) Donnelley Information Publishing, Inc., The Reuben H. Donnelley Corporation, including but not limited to, its division Donnelley Directory, and their successors, assigns, officers, agents, servants, employees and attorneys (other than its former divisions, Official Airline Guide and Donnelley Marketing, and the successors and assigns of those former divisions) shall file with this Court and serve upon counsel for BAPCO within forty-five (45) days after entry of this Injunction and Restraining Order, a report setting forth in detail the manner in which compliance with this Injunction and Restraining Order has been accomplished and periodically thereafter when requested by BAPCO and ordered by the Court.

(3) This Court will retain jurisdiction over the parties in this action to insure compliance with the terms of this Injunction and Restraining Order.

DONE and ORDERED in Chambers at Miami, Florida, on this 5th day of January, 1989.

/s/ Thomas E. Scott
THOMAS E. SCOTT
United States District Judge

APPENDIX F

PERTINENT CONSTITUTIONAL AND STATUTORY PROVISIONS

United States Constitution, Article I, section 8, clause 8:

> [t]he Congress shall have power * * * to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

Copyright Act of 1976, 17 U.S.C. §§ 101 et seq.:

§ 101. Definitions

* * * *

A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term "compilation" includes collective works.

* * * *

§ 102. Subject matter of copyright: In general

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.

* * * *

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

§ 103. Subject matter of copyright: Compilations and derivative works

(a) The subject matter of copyright as specified by section 102 includes compilations and derivative works * * *.

(b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

APPENDIX G

RULE 29.1 STATEMENT

Bellsouth Corporation Non-Wholly Owned Subsidiaries

Movicel S.A.
Bell Communications Research Inc.
ITT World Directories, Inc.
ITT World Directories (U.K.) Ltd.
Promedla B.V.
Uniquest Incorporated
BellSouth Argentina S.A.
BellSouth New Zealand (a Partnership)
Optus Communications Pty. Limited
AUSSAT New Zealand Limited
Instapage Joint Venture (NSW Partnership)
BCP Comercio e Participacoes Ltda.
BSB Comercio e Participacoes Ltda.
Telcell S.A.
BSE Comercio e Participacoes Ltda.
Celular Catarinense Comercio e Participacoes Ltda.
Movicom S.A.
Telefonia Movel do Sul S.A.
E-Plus Mobilfunk GmbH
TCIL BellSouth Limited
BellSouth Inversora S.A.
B.A. Celular Inversora S.A.
Compania de Radiocomunicaciones Moviles S.A.
BLS Denmark Associates
DMT Dansk Mobiltelefon I/S
Compagnie Financiere pour le Radiotelephone S.A.
PCN One Limited
Communication-Developpement S.A.
Comunicaciones Celulares de Occidente, S.A. de C. V.
ROU Celular Inversora S.A.
Abiatar S.A.
TelCel Celular, C.A.
Air Call Communications SA

Australia New System L.P.
BellSouth Wireless Data Company L.P.
RAM/BSE Communications L.P.
Belgium New System L.P.
RAM Mobile Data Belgium S.P.R.L.
France New System L.P.
France Telecom Mobiles Data, S.A.
Germany New System L.P.
Honolulu Cellular Telephone Company
Netherlands New System L.P.
RAM Mobile Data C.V.
RAM Mobile Data (Netherlands) B. V.
RAM Mobile Data USA Limited Partnership
BSE Mobile Data Company, L.P.
RAM/BSE, L.P.
RAM/BSE Paging Company, L.P.
National Cellular Communications, Inc.
Gulf Coast Cellular Telephone Company (A Partnership)
Charisma Communications Corp. of the Southwest
Houston Mobile Cellular Communications Company
(A Partnership)
Houston Cellular Telephone Company (A Partnership)
Galveston Cellular Partnership
Galveston Mobile Partnership
Honolulu Cellular Telephone Company (A Partnership)
Cellular Systems (A Partnership)
MCTA (A Partnership)
Los Angeles RCCs, Inc.
Los Angeles Cellular Corporation
Los Angeles Cellular Telephone Company
(A Partnership)
Bloomington Cellular Telephone Company
(A Partnership)
Kokomo Celltelco Partnership (A Partnership)
Muncie Cellular Telephone Company, Inc.
Terre-Haute Cellular Telephone Company, Inc.
Los Angeles Cellular Corporation

Los Angeles Cellular Telephone Company
(A Partnership)
Green Bay Cellular Telephone Company (A Partnership)
Janesville Cellular Telephone Company, Inc.
Madison Cellular Telephone Company (A Partnership)
Racine Cellular Telephone Company (A Partnership)
Sheboygan Cellular Telephone Company, Inc.
RCTC Wholesale Company (A Partnership)
Westel-Tampa Company, Inc.
Acadiana Cellular General Partnership (RSA's No. 5 & 6)
Huntsville MSA Limited Partnership
Centel Cellular Company of Hickory
Centel Cellular Company of North Carolina
Centel Cellular Company of Tallahassee
Century Cellunet of North Louisiana Cellular Limited
Partnership
Chattanooga MSA Limited Partnership
Decatur RSA Limited Partnership
Jacksonville MSA Limited Partnership
Florida RSA #2B (Indian River) Limited Partnership
Atlanta-Athens MSA Limited Partnership
Georgia RSA No. 1 Limited Partnership
Georgia RSA No. 2 Limited Partnership
Georgia RSA No. 3 Limited Partnership
Lexington MSA Limited Partnership
Baton Rouge MSA Limited Partnership
Lafayette MSA Limited Partnership
Louisiana RSA No. 7 Cellular General Partnership
Louisiana RSA No. 8 Limited Partnership
Memphis SMSA Limited Partnership
Nashville/Clarksville MSA Limited Partnership
North Carolina RSA 15 North Sector Limited Partnership
Northeastern Georgia RSA Limited Partnership
Orlando SMSA Limited Partnership
Columbia MSA Limited Partnership
South Carolina RSA No. 4 Cellular General Partnership
South Carolina RSA No. 5 Cellular General Partnership
South Carolina RSA No. 6 Cellular General Partnership
MobileComm of the West, Inc.
Skilldex, Inc.

Supreme Court, U.S.
FILED
DEC 30 1993

No. 93-862

IN THE
Supreme Court of the United States
OCTOBER TERM, 1993

BELLSOUTH ADVERTISING & PUBLISHING CORPORATION,
Petitioner,
v.
DONNELLEY INFORMATION PUBLISHING, INC., and
THE REUBEN H. DONNELLEY CORPORATION,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

RESPONDENTS' BRIEF IN OPPOSITION

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QUESTION PRESENTED

Whether the Court of Appeals correctly applied the principles recently stated by this Court in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), to the particular facts of record before it to hold that the Respondents did not infringe the Petitioner's concededly valid compilation copyright in a telephone directory by (1) copying just the name, address, and telephone number listings appearing in the yellow pages and (2) using the factual information as to kind of business revealed by the descriptive headings under which the listings appeared in Petitioner's directory in order to classify the businesses in Respondents' own, independently chosen, set of categories.

TABLE OF CONTENTS

	Page
QUESTION PRESENTED	i
TABLE OF AUTHORITIES	v
PRELIMINARY STATEMENT	1
STATEMENT OF THE CASE	2
A. Like The Defendant In *Feist*, Donnelley Had To Extract The Data From The Directory In Order To Attempt To Compete In The Yellow Pages Business	3
B. Donnelley Used A Particular Method Of Extraction To Obtain From BAPCO's Directory Only Public Domain Facts Needed To Compete In The Yellow Pages Business	4
C. The Decisions Below	6
1. District Court Decision	7
2. The Panel Decision	7
3. The *En Banc* Decision	8
REASONS FOR DENYING THE WRIT	9
I. THE DECISION BELOW IS NOT A SWEEPING RULING ON THE COPYRIGHTABILITY OF CLASSIFIED DIRECTORIES, BUT IS FACT-BOUND BY THE LIMITATIONS SELF-IMPOSED BY DONNELLEY ON ITS EXTRACTION OF FACTS FROM BAPCO'S DIRECTORIES	10
II. THE DECISION BELOW CORRECTLY APPLIES *FEIST*	12
A. BAPCO's "Acts" Of Selection And Coordination Lack Sufficient Originality For The Same Reasons Similar Acts Were Found Insufficient In *Feist*	13

TABLE OF CONTENTS—Continued

Page

B. Donnelley Did Not Copy Any Elements Resulting From BAPCO's Other Acts, Which Also Were Not Shown To Manifest Sufficient Originality To Be Copyrightable 17

III. THE DECISION OF THE ELEVENTH CIRCUIT IS CONSISTENT WITH DECISIONS OF OTHER CIRCUITS APPLYING *FEIST* 19

A. There Is No Conflict Between The Second And Eleventh Circuits 20

1. The *Key* Decision 21

2. *Key* Is Dissimilar From The Case Below .. 22

3. On The One Common Issue Below And In *Key*, The Eleventh And Second Circuits Are In Total Agreement 23

4. Other Second Circuit Cases Further Disprove Any Conflict Between The Two Circuits 23

B. There Is No Conflict With Other Circuits' Interpretation Of *Feist* 26

IV. BAPCO'S REAL DISPUTE IS WITH THIS COURT'S DECISION IN *FEIST* 29

CONCLUSION 30

TABLE OF AUTHORITIES

CASES — Page

Arica Inst., Inc. v. Palmer, 970 F.2d 1067 (2d Cir. 1992) 25, 26
Atari Games Corp. v. Oman, 979 F.2d 242 (D.C. Cir. 1992) 26, 27
Bonner v. City of Prichard, 661 F.2d 1206 (11th Cir. 1981) 6
Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340 (1991) ..... *passim*
Harper House, Inc. v. Thomas Nelson, Inc., 5 F.3d 536 (9th Cir. 1993), *petition for cert. filed* (U.S. Dec. 10, 1993) (No. 93-916) 26, 27
Illinois Bell Tel. Co. v. Haines & Co., 932 F.2d 610 (7th Cir. 1991) 20, 26
Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc., 945 F.2d 509 (2d Cir. 1991) ..... *passim*
Kregos v. Associated Press, 731 F. Supp. 113 (S.D.N.Y. 1990), *aff'd in part and rev'd in part*, 937 F.2d 700 (2d Cir. 1991), *on remand*, 795 F. Supp. 1325 (S.D.N.Y. 1992), *aff'd*, 3 F.3d 656 (2d Cir. 1993), *petition for cert. filed* (U.S. Nov. 30, 1993) (No. 93-863) ..... *passim*
Los Angeles News Serv. v. Tullo, 973 F.2d 791 (9th Cir. 1992) 28
Mason v. Montgomery Data, Inc., 967 F.2d 135 (5th Cir. 1992) 26, 28
Mid Am. Title Co. v. Kirk, 991 F.2d 417 (7th Cir.), *cert. denied*, 114 S. Ct. 346 (1993) 21, 26, 28
Miller v. Universal City Studios, 650 F.2d 1365 (5th Cir. 1981) 6
Rural Tel. Serv. Co., Inc. v. Feist Publications, Inc., 663 F. Supp. 214 (D. Kan. 1987) 7
Schiller & Schmidt, Inc. v. Nordisco Corp., 969 F.2d 410 (7th Cir. 1992) 26, 28
Sem-Torq, Inc. v. K Mart Corp., 936 F.2d 851 (6th Cir. 1991) 20, 26, 28
Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers, 756 F.2d 801 (11th Cir. 1985) 6, 19

TABLE OF AUTHORITIES—Continued

Page

The Gates Rubber Co. v. Bando Chem. Indus., Ltd., No. 92-1256, 1993 U.S. App. LEXIS 27045 (10th Cir. Oct. 19, 1993) 26, 28

Victor Lalli Enters. v. Big Red Apple, Inc., 936 F.2d 671 (2d Cir. 1991) 25, 26

STATUTES

17 U.S.C. § 101 (1988 & Supp. IV 1992) 6, 7, 26

OTHER AUTHORITIES

Paul J. Heald, *The Vices of Originality*, 1991 Sup. Ct. Rev. 143 19

William Patry, *Copyright in Collections of Facts (Or Why the White Pages Are Not Copyrightable)*, 12 Comm's & Law 37 (1991) 3

Shira Perlmutter, *The Scope of Copyright in Telephone Directories: Keeping Listing Information in the Public Domain*, 38 J. Copyright Soc'y 1 (Fall 1990) 3, 16

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RESPONDENTS' BRIEF IN OPPOSITION

PRELIMINARY STATEMENT

Respondents Donnelley Information Publishing, Inc., and The Reuben H. Donnelley Corporation (collectively, "Donnelley")[1] respectfully oppose the Petition of BellSouth Advertising & Publishing Corporation ("BAPCO") for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit on the ground that no issue meriting this Court's consideration is presented by the Petition.

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[1] In accordance with this Court's Rule 29.1, Respondents state that named Respondent Donnelley Information Publishing, Inc., was merged into Respondent The Reuben H. Donnelley Corporation on August 31, 1992, with The Reuben H. Donnelley Corporation as the surviving entity. The Reuben H. Donnelley Corporation is a wholly-owned subsidiary of The Dun & Bradstreet Corporation, a publicly traded company.

STATEMENT OF THE CASE

The *en banc* opinion of the Eleventh Circuit below involved a straightforward application of this Court's recent, unanimous decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991) ("*Feist*"), to the question whether Donnelley's extraction of certain factual data from the 1984 Miami yellow pages directory published by BAPCO infringed the compilation copyright claimed by BAPCO in that directory. Contrary to the assertions repeatedly made by BAPCO in its Petition,[2] the case below does not concern the question whether BAPCO's yellow pages directory reflected sufficient original authorship to merit compilation copyright protection for the work as a whole. The validity of BAPCO's compilation copyright in the directory was *stipulated to* by the parties and *assumed* by the Eleventh Circuit. Petitioner's Appendices ("App.") 2a, 4a, 7a & n.11.

The only issue presented, as framed by the Eleventh Circuit at the outset of its opinion, "is whether that which was copied by [Donnelley] was protected by [BAPCO's] registered claim of compilation copyright." *Id.* at 2a. Based on a detailed examination of the summary judgment record below (which, in many respects, was similar to the record in *Feist*), and in accordance with the analysis required by *Feist*, the Eleventh Circuit held that Donnelley had only copied preexisting, public domain facts from BAPCO's directory, and that BAPCO had not shown that Donnelley's copying of these fact data resulted in the copying of any original authorship of BAPCO. *Id.* at 12a, 14a, 18a. Although the fact data copied by Donnelley were "substantial in a purely quantitative sense," the Eleventh Circuit found this "not surprising, given that the copyright protection of a factual compilation is 'thin' " for the reasons explained in *Feist*. *Id.* at 17a (quoting *Feist*, 499 U.S. at 349).

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[2] *See* Petition ("Pet.") 3, 9-11, 14, 16-21.

A. Like The Defendant In *Feist*, Donnelley Had To Extract The Data From The Directory In Order To Attempt To Compete In The Yellow Pages Business.

In 1984, Donnelley began a failed attempt to compete with the local telephone company (Southern Bell Telephone and Telegraph Co. ("Southern Bell")) and its exclusive licensee (BAPCO) in selling and publishing yellow pages directory advertising in Miami and elsewhere in Florida. Like the defendant directory publisher in *Feist*, Donnelley's efforts to compete caused it to become a copyright defendant and an antitrust plaintiff.[3] Donnelley claimed that BAPCO, Southern Bell, and their corporate parent, BellSouth Corporation, had monopolized and attempted to monopolize the market for advertising directories in certain parts of Florida by, *inter alia*, denying Donnelley access to essential telephone subscriber listing information provided by Southern Bell to BAPCO. On summary judgment motions, the district court ruled that Donnelley's antitrust claims against Southern Bell and BellSouth Corporation should go to trial, but the district court also ruled in BAPCO's favor on the copyright claims. The substance of Donnelley's antitrust charges continued against BAPCO in the copyright phase of the case as the foundation of Donnelley's copyright misuse defense.[4]

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[3] *See* William Patry, *Copyright in Collections of Facts (Or Why the White Pages Are Not Copyrightable)*, 12 Comm's & Law 37, 40 (1991) (telephone companies have used claims of copyright not to vindicate intellectual property rights, "but rather to eliminate competition for yellow pages advertisers"); Shira Perlmutter, *The Scope of Copyright in Telephone Directories: Keeping Listing Information in the Public Domain*, 38 J. Copyright Soc'y 1, 1 (Fall 1990) (telephone companies have "sought to eliminate the competition" in the lucrative market for yellow pages advertising by asserting copyright claims).

[4] The district court entered summary judgment in BAPCO's favor on Donnelley's antitrust claims against BAPCO on corporate identity grounds. After the district court's summary judgment rulings, Donnelley dropped its antitrust claims against Southern Bell and BellSouth Corporation in return for BAPCO's abandonment of its demands for monetary relief on its copyright claims.

In the Petition, BAPCO asserts, as if it were a fact, that Donnelley's use of BAPCO's directory was unnecessary in light of a "list" furnished by Southern Bell. Pet. 4. That assertion simply ignores the fact that the district court found Donnelley's antitrust claims against Southern Bell and BellSouth Corporation worthy of trial in part because of a genuine factual dispute as to "[w]hether Southern Bell gave Donnelley sufficient data to realistically compete in the market for directories". App. 100a.

B. Donnelley Used A Particular Method Of Extraction To Obtain From BAPCO's Directory Only Public Domain Facts Needed To Compete In The Yellow Pages Business.

Donnelley obtained copies of BAPCO's 1984 Miami yellow pages directory [5] and extracted certain fact information from it in order to generate a list of potential advertisers. App. 3a. Donnelley marked each business listing in the BAPCO directory with two alphanumeric codes from among a series of codes created by Donnelley. The first code indicated the size (*i.e.*, half page, quarter column) and type (*i.e.*, display ad, in-column, or coloring) of paid advertisement, if any, purchased by the subscriber; the second code indicated the subscriber's type of business by marking the heading selected by the sub-

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[5] BAPCO published the 1984 "Southern Bell Greater Miami Yellow Pages" directory pursuant to an exclusive license agreement with Southern Bell. Southern Bell is a telephone company granted monopoly status to provide telephone service to residential and business subscribers in Miami and other parts of the Southeastern United States. When a business subscribes to telephone service from Southern Bell, Southern Bell obtains the name and address of the business, solicits the heading or classification under which the business wishes to appear in the local yellow pages telephone directory (because one such appearance is included "free" in the price of business-class telephone service), and assigns a telephone number. App. 2a-3a, 14a, 70a n.4. Southern Bell then supplies the subscriber's name, address, telephone number, and business heading selection to BAPCO for publication in the yellow pages directory. Pet. 3; App. 2a-3a, 14a, 70a n.4.

scriber in the BAPCO directory [6] with a code identifying the closest corresponding heading previously and independently selected by Donnelley for use in its competing directory. *Id.* In some cases, the corresponding heading was the same; in other cases, it was different. *Id.* at 12a-13a. Donnelley used its own system of headings and did not copy BAPCO's. *Id.* at 13a.

Donnelley gave the encoded directories to a data entry company, which copied the name, address, and telephone number of each business subscriber appearing in the BAPCO directory. *Id.* at 3a. The data entry company also recorded the alphanumeric codes assigned by Donnelley to each listing, indicating advertising unit and business type. *Id.* By using this particular extraction process, Donnelley copied only preexisting, public domain facts about the business subscribers. Donnelley did not copy any of the headings, advertisements, textual material, typeface, graphic layout, format, or other information appearing in the BAPCO directory. *Id.* at 3a n.2, 12a-13a, 17a.

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[6] As in all yellow pages telephone directories, listings in BAPCO's 1984 Miami directory are assembled alphabetically under standardized business classifications or "headings," which are themselves organized in alphabetical order. App. 3a. The name, address, and telephone number of each subscriber to Southern Bell's business-class telephone service is listed once without separate charge in alphabetical order under the heading the business subscriber selected (a business subscriber may also elect not to appear at all). *Id.* at 3a, 14a. A business subscriber may purchase additional listings under other headings so long as they factually describe the nature of the subscriber's business. *Id.* For example, a barber may choose to be listed under "Barber", "Hair Stylist", or both, so long as the chosen headings are factually descriptive of the barber's business activities. Pet. 4. These headings result from obvious "functional considerations and common industry practice", App. 13a, of describing businesses in plain, ordinary terms that make the directory easy to use. Businesses may also purchase space in the directory for advertisements of various sizes, shapes, and colors; these advertisements typically contain graphic and textual information about individual businesses, such as product lines, hours of operation, and services. *See id.* at 3a n.2.

Donnelley used the data extracted from the BAPCO directory to contact businesses to sell listings and advertisements in Donnelley's yellow pages directory. *Id.* at 3a-4a. The data were also used to develop a listings base for Donnelley's competing publication. *Id.* at 4a.

C. The Decisions Below.

BAPCO's theory of compilation copyright protection at the outset of this case was based on the "sweat of the brow" doctrine, which presumed that the taking of any fruits of a compiler's labor was infringement regardless of whether such labor constituted authorship.[7] Much of BAPCO's evidence thus focused on the *efforts* BAPCO expended in compiling, processing, and publishing yellow pages directories.[8] Seeking to state its "sweat of the brow" premise in the language of the 1976 Copyright Act, BAPCO invoked the words of the Copyright Act's definition of a "compilation," 17 U.S.C. § 101 (1988), to argue that BAPCO's efforts to collect and assemble the directory listings were "acts" of "selection, coordination, and arrangement" sufficient to qualify all of the contents of the directory—including the facts—for compilation copy-

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[7] *See* Amended Complaint ¶ 42 ("BAPCO alleges that Donnelley's preparation of a classified directory using the 1984 Miami Yellow Pages in any shape or form . . . without expending its own 'sweat of the brow' in developing sales leads and potential customer lists is an unlawful use of BAPCO's copyrighted 1984 Miami Yellow Pages."). *See also id.* at ¶ 63. Notably, BAPCO chose to prosecute a "sweat of the brow" case even though BAPCO was litigating in a Circuit that had already rejected the "sweat of the brow" doctrine before the case below was begun. *See Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers*, 756 F.2d 801, 809 n.9 (11th Cir. 1985) ("*ATD*"), and *Miller v. Universal City Studios*, 650 F.2d 1365, 1369 (5th Cir. 1981) (binding precedent in the Eleventh Circuit under *Bonner v. City of Prichard*, 661 F.2d 1206 (11th Cir. 1981). Since Donnelley copied only facts, BAPCO's claim of copyright protection for facts may have left BAPCO with no choice but to rely upon a "sweat of the brow" theory. *Feist* required the Eleventh Circuit to reject BAPCO's claims.

[8] *See* App. 79a-80a & n.18.

right protection under section 101.[9] BAPCO then argued that *any* substantial copying of fact data appearing in the directory constituted infringement.[10]

1. *District Court Decision.*

The United States District Court for the Southern District of Florida granted BAPCO's motion for summary judgment on the copyright claims and denied Donnelley's cross-motion on those claims. The district court held that "BAPCO and its affiliates have expended great efforts in collecting, assembling, compiling and publishing its directories. . . . There is no doubt, therefore, that BAPCO has met the 'sweat of the brow' test." App. 79a n.18. The district court also held that BAPCO's "acts" of collection, assemblage, and compilation were sufficient to warrant copyright protection for the directories as a whole under section 101. *Id.* at 79a. Although professing to disfavor the "sweat of the brow" theory, *id.*, the district court relied heavily on the Kansas district court opinion ultimately reversed by this Court in *Feist*,[11] and extended copyright protection to naked facts.

2. *The Panel Decision.*

While the case was pending on appeal to the Eleventh Circuit, this Court rejected the "sweat of the brow" doctrine in *Feist*. 499 U.S. at 353-55. In so doing, this Court made clear that "copyright is not a tool by which a compilation author may keep others from using the facts or data he or she has collected. . . . Rather, the facts contained in existing works may be freely copied because copyright protects only the elements that owe their origin to the compiler—the selection, coordination, and arrangement of facts." *Id.* at 359. The issue of infringe-

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[9] *See* App. 80a; Brief of Appellee at 3.

[10] Brief of Appellee at 17-26.

[11] The district court cited to *Rural Telephone Service Co., Inc. v. Feist Publications, Inc.*, 663 F. Supp. 214 (D. Kan. 1987), the lower court decision reversed in *Feist*, no fewer than five times in its opinion below.

ment in any compilation case thus turns on whether what was copied by an alleged infringer owes its origin to the compiler; if the elements copied are preexisting facts or data unoriginal to the compiler, they may be freely copied even if the compiler was the first to discover and record those facts or data.

Notwithstanding the *Feist* decision, a panel of the Eleventh Circuit affirmed the district court's grant of summary judgment based on a *gestalt* theory of compilation copyright that ignored the element-by-element analysis of the copied material required by *Feist*, and instead focused solely on whether BAPCO's directory as a whole was copyrightable. Having determined that BAPCO's so-called "acts" of selection, coordination, and arrangement in collecting and assembling its yellow pages listings were sufficiently original to warrant copyright protection for the work as a whole—a point not even at issue in the case, given Donnelley's *ab initio* stipulation that BAPCO's directory was a copyrightable compilation —the panel wrongly concluded that BAPCO's "acts" became inherent in the preexisting name, address, telephone number, and line of business data contained in the directory. App. 58a-59a. Based on this faulty analysis, the panel held that Donnelley had copied "BAPCO's protected material by substantially appropriating the constituent elements of the original format inscribed in the BAPCO directory." *Id.* at 62a.

3. *The* En Banc *Decision.*

The Eleventh Circuit granted *en banc* rehearing. After correctly applying the element-by-element infringement analysis required by *Feist*, the Eleventh Circuit concluded that Donnelley's particular method of extracting only preexisting name, address, telephone number, and business type fact information from BAPCO's directory did not copy any selection, coordination, or arrangement of the data original to BAPCO. The Eleventh Circuit thus found no copyright infringement. App. 18a.

While expressly assuming the validity of BAPCO's claim of compilation copyright in the directory as a whole, *see id.* at 2a, 4a, 7a & n.11, the Eleventh Circuit held that BAPCO's "acts" of collecting and assembling the listings in its yellow pages directory "were not acts of authorship, but techniques for the discovery of facts." *Id.* at 8a. The Eleventh Circuit further held that:

> The protection of copyright must inhere in a creatively original *selection* of facts to be reported and not in the creative means used to discover those facts. Ultimately, the district court erred by extending the protection of copyright to the collection of facts in the BAPCO directory based on the uncopyrightable formative acts used to generate those listings.

Id. at 9a (emphasis in original) (citations omitted).

The Eleventh Circuit reversed the district court's grant of summary judgment on BAPCO's claim of copyright infringement, and entered summary judgment in favor of Donnelley on that claim. *Id.* at 18a.

REASONS FOR DENYING THE WRIT

The decision of the Eleventh Circuit does not concern copyrightability of classified directories as such, but rather the particular method adopted by Donnelley to extract factual information from a yellow pages directory without copying anything other than facts. BAPCO argued that Donnelley's extraction process necessarily appropriated creatively original elements of BAPCO's directory and that Donnelley therefore failed in its effort to avoid copyright infringement. The Eleventh Circuit rejected BAPCO's argument, concluding that, although the copyrightability of BAPCO's classified directories was not in dispute, Donnelley succeeded in avoiding infringement of BAPCO's copyright.

This Court should not grant *certiorari* because the decision of the Eleventh Circuit is both (i) correct in light of this Court's decision in *Feist*, and (ii) entirely fact-bound by the particular limitations that Donnelley imposed upon its own information extraction process. The

decision below announces no broad principle of law, but rather applies principles recently established by this Court to a particular factual circumstance. BAPCO's attempt to recast this case as one that imperils the future copyrightability of compilations is, in substance, nothing more than a transparent pretext for rearguing the fundamental issues of the *nature* and *scope* of copyright protection for fact compilations already decided by this Court in *Feist*.

I. THE DECISION BELOW IS NOT A SWEEPING RULING ON THE COPYRIGHTABILITY OF CLASSIFIED DIRECTORIES, BUT IS FACT-BOUND BY THE LIMITATIONS SELF-IMPOSED BY DONNELLEY ON ITS EXTRACTION OF FACTS FROM BAPCO'S DIRECTORIES.

Since the copyrightability of BAPCO's directory was stipulated to by Donnelley and assumed by the Eleventh Circuit, infringement would have been found by stipulation if Donnelley had copied any original authorship from BAPCO's directory. Donnelley, however, used a technique designed to permit it to extract just the factual information from BAPCO's directory without infringing the copyright. The Eleventh Circuit decision below rests on a correct finding that what Donnelley copied was only names, addresses, telephone numbers, and the fact as to the nature of the listed business.

As to names, addresses, and telephone numbers, *Feist* is plainly controlling. The taking of such purely factual data is lawful under that decision.

The only possible distinction between the case below and *Feist* thus focuses on what Donnelley did with the descriptive business classifications ("headings") in the yellow pages of BAPCO's book. Donnelley did not copy BAPCO's headings, but instead used the factual information as to kind of business revealed by BAPCO's descriptive headings to classify the businesses appearing under those headings according to Donnelley's own, independently chosen, set of categories.

The inquiry into what Donnelley did with BAPCO's headings was made difficult for the Eleventh Circuit by BAPCO's effort on appeal to create the appearance of a factual dispute when the record was clear that Donnelley did not copy BAPCO's headings. *See En Banc* Brief of Appellees at 27.[12] Rather than simply dismissing BAPCO's accusations of copying the headings as untimely, the Eleventh Circuit conscientiously searched the record and determined that Donnelley's particular method of extracting type-of-business information did not involve copying of BAPCO's system of headings. As explained by the Eleventh Circuit:

> The evidence submitted to the district court in the form of affidavit, deposition, and witness testimony reveals that Donnelley established its own system of headings and that, in constructing its data base, Donnelley entered, with each BAPCO listing, an alpha-numeric code that corresponded to the *Donnelley* heading.

App. 12a-13a (emphasis in original) (numerous record citations omitted).

The Eleventh Circuit further compared the headings appearing both in the sales solicitation forms generated by Donnelley using the data extracted from BAPCO's directory, as well as the headings appearing on pages selected by BAPCO from both the BAPCO directory and Donnelley's competing yellow pages directory. This analysis again disproved BAPCO's claim that Donnelley had copied the system of headings appearing in the BAPCO directory.

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[12] As discussed above, BAPCO relied at the outset of the case on the "sweat of the brow" doctrine in prosecuting its infringement claims. Under that now-discredited theory, Donnelley's copying of name, address, and telephone number listing data alone would have been sufficient to prove copyright infringement. After *Feist*, BAPCO introduced the heading issue on appeal in an unfounded attempt to create a triable issue.

> Considering the extent to which the heading structure of a classified business directory is dictated by functional considerations and common industry practice, the differences apparent in the glossary of headings employed by Donnelley are sufficient to rebut any inference of copying that otherwise might be drawn from those terms that are common to both directories.

Id. at 13a. The Eleventh Circuit thus held that, by employing its particular encoding process, Donnelley had "extracted uncopyrightable information regarding the business activities of BAPCO's subscribers without appropriating any arguably original, protectable expressive element in the BAPCO glossary of headings." *Id.*

The straightforward application of *Feist* principles to the peculiar facts of this case would not present an occasion for *certiorari* even if the Eleventh Circuit had misdetermined the facts or had erred in applying the principles of *Feist*. *Certiorari* is even less appropriate because the Eleventh Circuit was correct both as to the facts and the principles it applied to them.

II. THE DECISION BELOW CORRECTLY APPLIES *FEIST*.

In order to establish a claim of copyright infringement in its directory, "BAPCO must prove '(1) ownership of a valid copyright and (2) copying of constituent elements of the work that are original.'" App. 7a (quoting *Feist*, 499 U.S. at 361). BAPCO claims in the Petition that the Eleventh Circuit "denied copyright protection for BAPCO's directory . . . ." Pet. 16. That assertion, as previously shown, is false. As in *Feist*, the validity of the compilation copyright in the directory as a whole was conceded by the parties below, and the Eleventh Circuit stated no fewer than four times in its opinion that it was not considering "whether BAPCO's yellow pages directory, taken as a whole, is copyrightable." App. 7a n.11; *see also id.* at 2a, 4a, 7a. This case thus presents no issue about the copyrightability of yellow pages direc-

tories or any other type of fact compilation. The Eleventh Circuit considered only one issue below, and that was whether "Donnelley, by taking the material it copied from the BAPCO directory, appropriated BAPCO's *original* selection, coordination or arrangement." *Id.* at 7a (emphasis in original). On that issue, the Eleventh Circuit faithfully followed the principles announced in *Feist* in a manner consistent with the seven other Circuits (including the Second Circuit) that have interpreted *Feist* in the context of fact compilations.[13]

A. BAPCO's "Acts" Of Selection And Coordination Lack Sufficient Originality For The Same Reasons Similar Acts Were Found Insufficient In *Feist*.

BAPCO's *gestalt* theory of copyright posits that the formative acts which caused the preexisting fact information to appear in the directory—as opposed to some other preexisting fact information—make the fact information in the directory copyrightable. Such a principle cannot be squared with *Feist*. In *Feist*, there were a number of actions that caused the Rural Telephone Service Co. ("Rural Telephone") white pages to be what they were rather than something else, such as the particular "close date" selected for the book and the inclusion of all of Rural Telephone's subscribers in one book rather than several (geographic scope). The argument that such content-defining acts were bases for copyright protection was made and rejected in *Feist*. The contentions of BAPCO, here and in the courts below, are simply more prolix statements of the same arguments.

As in its Petition here, BAPCO argued below that its "acts" of "selection" and "coordination" in collecting and assembling the yellow pages listings appearing in its directory were original authorship and so inhered in the facts themselves that no substantial copying of the facts could be permitted. The purported "acts" of "selection," which BAPCO now characterizes as "editorial judgments," in-

[13] *See, infra,* at Part III (pp. 19-29).

clude (1) limiting the yellow pages business directory to business, as opposed to residential, subscribers; (2) providing one "free" listing for each business subscriber (rather than none or more than one); (3) determining the geographic scope of the directory; (4) determining which potential advertisers residing outside of the geographic scope of the directory should be contacted by BAPCO's sales personnel for possible inclusion in the directory; and (5) determining the "headings" that will be available for business subscribers to select from in choosing where to appear alphabetically in the directory. Pet. 3-5. The purported "acts" of "coordination" by BAPCO include (1) coordinating particular business listings with an appropriate heading or headings; and (2) adhering to rules that maintain the "integrity of the directory" by prohibiting business subscribers from appearing under a heading which misrepresents the nature of the subscribers' products or services. *Id.* at 6-7.

The Eleventh Circuit considered each of these "acts" in determining whether Donnelley had appropriated any material original to BAPCO in the course of extracting names, addresses, telephone numbers, and line of business information from the BAPCO directory. In so doing, the Eleventh Circuit correctly concluded that many of BAPCO's "acts" in collecting and assembling these preexisting facts were of the kind previously considered and determined by this Court in *Feist* to lack sufficient originality to extend copyright protection to a directory compiler's selection of the facts (as opposed to the directory as a whole). With respect to the other "acts" alleged by BAPCO, the Eleventh Circuit held that Donnelley had not copied any constituent elements resulting from such acts, and that, in all events, the record in the case below failed to establish any genuine dispute that such constituent elements were unoriginal to BAPCO and therefore uncopyrightable.

The Eleventh Circuit held that BAPCO's purported "acts" of selection lacked sufficient originality to extend copyright protection to the fact data extracted by Don-

nelley. In reaching this holding, the Eleventh Circuit repeatedly referred to this Court's analysis of similar "acts of selection" by the directory compiler in *Feist*. With respect to the geographic scope of BAPCO's directory, for example, the Eleventh Circuit noted that the directory compiler in *Feist* "obviously established a geographic scope . . . for its white pages," App. 8a, and that extending the scope of copyright protection on the basis of this selective act "would protect such factual elements of every compilation; [since] any collection of facts . . . will by necessity have . . . where applicable, a geographic limit selected by the compiler." *Id.*

With respect to other allegedly "selective" acts of BAPCO, such as offering one "free" listing, limiting listings to purchasers of business telephone service, and determining the sales procedures used to contact potential advertisers and to recommend the purchase of additional listings, the Eleventh Circuit found that these "acts of selection" did not—and could not—extend the protection of BAPCO's copyright to the facts themselves.

> [T]hese acts are not acts of authorship, but techniques for the discovery of facts. In *Feist*, the Court emphasized the distinction "between creation and discovery: the first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence." By employing its sales strategies, BAPCO discovered that certain subscribers describe their businesses in a particular fashion and were willing to pay for a certain number of listings under certain available business descriptions.

Id. (citation omitted).

While recognizing that BAPCO had devised its own strategies and techniques for discovering and collecting this subscriber listing information, the Eleventh Circuit noted that any useful compilation "will be shaped by a number of decisions regarding the optimal manner in which to collect the pertinent data . . . ." *Id.* at 9a. These decisions, however, do not constitute authorship;

otherwise, "the protection of copyright would extend to census data, cited in *Feist* as a paradigmatic example of a work that lacks the requisite originality." *Id.* (citation omitted).[14]

The Eleventh Circuit also applied the principles of *Feist* in considering whether BAPCO's "feats of coordination and arrangement to generate its yellow pages directory" constituted original authorship which barred Donnelley's taking of preexisting facts. *Id.* Although BAPCO's yellow pages "required somewhat more organization and arrangement than the white pages directory considered in *Feist*", *id.* at 9a n.13, the Eleventh Circuit held that the organization of listings and headings in BAPCO's directory "did not deviate from the arrangement of the typical business directory, which employs an alphabetical list of headings to describe the various types of business and then alphabetizes the listings under appropriate headings." *Id.* at 10a n.13. With respect to yellow pages directories, the Eleventh Circuit concluded, "such an arrangement 'is not only unoriginal, it is practically inevitable.'" *Id.* at 10a (quoting *Feist*, 499 U.S. at 363).

The Eleventh Circuit rejected BAPCO's argument, embraced by the district court, that copyrightable originality was established by the mere fact that BAPCO could have arranged its headings and the listings appearing under those headings in other ways.

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[14] *See also* Perlmutter, *supra* note 3, at 13-17 (After analyzing purported "acts" of selection, coordination, and arrangement, like those alleged by BAPCO, in the collection and assembling of telephone listings: "If copyright is disclaimed in listing information, disclaimed in the alphabetical arrangement of that information, and it is the subscribers rather than the telephone company who select themselves for inclusion, what authorship has the telephone company contributed? All that remains is the mere pulling together and publishing of all of the unprotectible data in one place in an unprotectible form. It is hard to see any difference between this contribution and plain 'sweat'—the effort expended by the compiler.")

> The relevant inquiry is not whether there is some imaginable, although manifestly less useful, method of arranging business telephone listings. In *Feist*, Rural could have published multiple directories for its service area or listed its numbers in numerical order, by age, or by neighborhood within a single directory. The pertinent inquiry is whether the compiler has demonstrated originality, the "*sine qua non*" of copyright, in *its* arrangement or coordination.

Id. at 12a (emphasis in original). The Eleventh Circuit concluded that BAPCO's arrangement of its yellow pages listings, "like that of Rural's white pages [listings] is 'entirely typical' of its respective type." *Id.*[15]

Having found that BAPCO's acts of selection and coordination in organizing business listings in its directory were unoriginal for reasons explained by this Court in *Feist*, the Eleventh Circuit reached the inevitable conclusion that Donnelley's extraction of names, addresses, and telephone numbers from BAPCO's directory—which are the same factual data extracted by Feist from Rural Telephone's directory—did not constitute infringement.

B. Donnelley Did Not Copy Any Elements Resulting From BAPCO's Other Acts, Which Also Were Not Shown To Manifest Sufficient Originality To Be Copyrightable.

The only remaining issues below were whether Donnelley copied BAPCO's headings and, if so, whether those headings were sufficiently original to BAPCO to merit copyright protection. After a detailed examination

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[15] The Eleventh Circuit also held that BAPCO's claim of copyright protection in the arrangement of listings in its yellow pages directory would not survive application of the "merger" doctrine, because the alphabetical listing of business subscribers under an alphabetical sequence of appropriate headings was "the one way to construct a useful business directory." App. 10a-11a. Thus, "the arrangement has 'merged' with the idea of a business directory, and . . . is uncopyrightable." *Id.*

of the record, the Eleventh Circuit ruled in Donnelley's favor on both counts.[16]

As noted above, the Eleventh Circuit found that there was no genuine dispute as to the fact that Donnelley's particular method of extraction did not result in the copying of BAPCO's headings. App. 13a. Second, even if Donnelley had copied BAPCO's system of headings, the Eleventh Circuit found that BAPCO had "failed to present evidence that . . . its heading structure constitutes original expression warranting copyright protection." *Id.* at 14a. Besides being so obvious as to lack any originality,[17] most of the headings employed by BAPCO were shown below to be the result of standard industry practices common to virtually all yellow pages publishers. *Id.* The Eleventh Circuit further found that the testimony of BAPCO's own representatives established that the *subscribers* selected, from among the headings offered by BAPCO, the particular heading or headings under which they wished to appear. "The headings that actually appear in the directory thus, do not owe their origin to BAPCO and BAPCO has claimed no copyright in the larger universe of headings that are offered to subscribers." *Id.* at 14a-15a.

Finally, the Eleventh Circuit noted that Donnelley did not copy any of the other material in the BAPCO directory, such as the text or graphic elements of advertisements, the layout and formatting of the pages, "or the

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[16] Given the conclusion that Donnelley did not copy BAPCO's headings, the rulings concerning the adequacy of BAPCO's evidence on the originality of those headings is simply an additional, alternative ground of decision for granting Donnelley's summary judgment motion. Either conclusion, standing alone, would establish non-infringement.

[17] In the words of BAPCO's counsel: "Where are you going to put somebody if he is a plumbing contractor? The heading is going to be Plumbing Contractor. It has got to be. The dispute between these two companies does not involve the wording of the heading, your Honor. It has no significance of any real merit." 5SR-Tr. of Oct. 1985 Prel. Inj. Hrg. at 8.

textual material included by BAPCO to assist the user." *Id.* at 17a.

> Unlike the infringer in *Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers*, 756 F.2d 801 (11th Cir. 1985), Donnelley did not photocopy, or reproduce by any equivalent means, the page by page arrangement or appearance of its competitor's directory in the process of creating its own work.

Id.[18] While the Eleventh Circuit recognized that the *amount* of material extracted by Donnelley from the BAPCO directory "was substantial in a purely quantitative sense, Donnelley did not, by this process, appropriate whatever original elements might arguably inhere in the BAPCO directory." *Id.*[19]

III. THE DECISION OF THE ELEVENTH CIRCUIT IS CONSISTENT WITH DECISIONS OF OTHER CIRCUITS APPLYING *FEIST*.

BAPCO bases its Petition primarily upon the argument that there is a conflict in the Circuits requiring this Court's attention. The opinion below neither reveals nor acknowledges any such conflict, no other Circuit opinion

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[18] The Eleventh Circuit's affirmation of *ATD* further shows that the Eleventh Circuit recognizes that yellow pages directories, as a whole, may be subject to copyright protection and infringed by takings of protected authorship. Read together, the Eleventh Circuit's decision below and its decision in the *ATD* case underscore the fact-specific inquiry required to determine whether particular copying of information from a directory results in the extraction of only uncopyrightable public domain facts, as in the case below, or in the appropriation of other elements of the work original to the directory publisher, as in *ATD*.

[19] *See* Paul J. Heald, *The Vices of Originality*, 1991 Sup. Ct. Rev. 143, 162 (After observing that copying of listings and headings probably would not infringe: "Contrary to prior lower court precedent, *Feist* clearly sanctions the production of competing yellow pages as long as the second-comer's product does not substantially reproduce the individual page-by-page arrangements of materials found in the first (something only likely to result from photocopying).").

has revealed or acknowledged any such conflict, and there is none.[20]

A. There Is No Conflict Between The Second And Eleventh Circuits.

As shown, BAPCO's infringement theory was and remains that possession of a valid compilation copyright should entitle BAPCO to bar all substantial copying—even of facts—from the compilation. That position leads BAPCO to insist upon addressing only the question of existence of copyright protection for its directory, even though that question was never in issue in the courts below.

Based on this false premise, BAPCO incorrectly asserts that the Eleventh Circuit decision is in conflict with an earlier, post-*Feist*, decision of the Second Circuit: *Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991) ("*Key*"). BAPCO asserts that the Eleventh Circuit below construed *Feist* "as precluding copyright protection for a yellow pages directory [while] the Second Circuit in *Key* construed *Feist* as affording such protection." Pet. 11. Neither part of this statement is correct: The Eleventh Circuit assumed at the outset that BAPCO's directory was copyrightable in reliance on Donnelley's stipulation to that effect; the Second Circuit in *Key* did not address whether typical yellow pages directories, such as BAPCO's, might be copyrightable, since no such directory was before it. Rather, the two decisions each applied the same inherently fact-intensive analysis required by *Feist* to dif-

[20] BAPCO's arguments on this point are ironic, since the Eleventh Circuit took particular care to ensure the consistency of its *en banc* decision with the post-*Feist* decisions of other Circuits by specifically directing, in its November 4, 1992 order setting the schedule for the *en banc* rehearing, that the parties address the then-recent decisions in *Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991); *Kregos v. Associated Press*, 937 F.2d 700 (2d Cir. 1991); *Sem-Torq, Inc. v. K Mart Corp.*, 936 F.2d 851 (6th Cir. 1991); and *Illinois Bell Tel. Co. v. Haines & Co.*, 932 F.2d 610 (7th Cir. 1991).

ferent factual issues. The treatment and resolution of the one significant issue common to the cases are entirely consistent.

1. *The* Key *Decision.*

Key involved claims that the publisher of a specialized classified directory for the Chinese-American community in New York had infringed the copyright on another specialized directory directed to the same group of Chinese-American users. Unlike the case below, the *Key* case required the Second Circuit to decide, first, whether the plaintiff held a valid copyright. The Second Circuit found the evidence presented by the plaintiff sufficient to establish that the plaintiff's directory embodied a creative selection, from the larger universe of businesses in New York, of just those businesses that the plaintiff subjectively determined to be of interest to the Chinese-American community and that the plaintiff thought would remain open for business during the life of the directory. *Key*, 945 F.2d at 513.[21] The Second Circuit also held that the evidence showing selection and creation of business classifications—including, significantly, classifications "not common to yellow pages"—was sufficient to establish originality in the arrangement of the plaintiff's compilation. *Id.* at 513-14. The Second Circuit found these elements of original selection and arrangement to be sufficient to support a valid compilation copyright on the plaintiff's directory as a whole. *Id.* at 514.

After making this determination, the Second Circuit proceeded to the second analytical step required by *Feist*; namely, whether the alleged infringer had copied constituent elements protected by the copyright. The Second

[21] Although BAPCO contends otherwise, Pet. 13 n.5, it is plain that the selectivity inherent in the specialized nature of the directory in *Key* was central to the originality finding. *See Mid Am. Title Co. v. Kirk*, 991 F.2d 417, 420-21 (7th Cir.), *cert. denied*, 114 S. Ct. 346 (1993) (summarizing *Key* as holding that "copyright protection could be extended to a directory of businesses of specific interest to the Chinese community").

Circuit focused just on those elements proved to be original to the plaintiff and determined that infringement was *not* proved because the defendant's directory did not reproduce either the plaintiff's particular selection of businesses deemed to be of interest to a specialized group or any original aspect of the plaintiff's classification scheme. *Id.* at 515-16. There being no evidence of copying of original constituent elements of the plaintiff's work, there could be no infringement under *Feist*. *Id.* at 516.

2. Key *Is Dissimilar From The Case Below.*

The Eleventh Circuit below was confronted with a very different case from *Key*. There was no issue whether BAPCO's typical yellow pages directory was copyrightable: just like the defendant in *Feist*, Donnelley conceded that the presence of original artwork, layout, and textual material in the yellow pages of BAPCO's directory was sufficient to sustain a valid compilation copyright on the directory as a whole. The sole question before the Eleventh Circuit was whether Donnelley's admitted copying of names, addresses, and telephone numbers, and its use of BAPCO's factually descriptive classification of businesses to identify the kind of business carried on by the listed telephone subscribers, resulted in the copying of original material from BAPCO's directory. App. 2a.

In *Key* there was a factual issue as to whether the defendant had copied the original aspects of the plaintiff's classification scheme. In the case below, the Eleventh Circuit determined that there was no genuine issue as to the fact that Donnelley did not copy BAPCO's headings. *See* pp. 8-9, above.

BAPCO goes so far as to assert that, "[u]nder the Eleventh Circuit's view, the publishers of the yellow pages in *Key Publications* simply 'discovered' those businesses of interest to the Chinese-American community that were willing to be listed." Pet. 13. Of course, the Eleventh Circuit said no such thing. Indeed, the Eleventh Circuit's opinion makes quite clear that it would be likely to find the original selection of listed firms in *Key* to con-

stitute precisely the sort of creative selection absent from the record in the case below. *See* App. 8a-9a, 16a n.22.[22]

3. *On The One Common Issue Below And In* Key, *The Eleventh And Second Circuits Are In Total Agreement.*

The case below and *Key* presented only one significant question in common: whether classification of business listings under descriptive categories—*e.g.*, classifying a plumber as a plumbing contractor—is original authorship protectable by copyright. On this point, the Eleventh Circuit and the *Key* court are in total agreement. The Second Circuit held, as a matter of law, that "[p]lacing listings within categories is the sort of mechanical task that does not merit copyright protection." *Key*, 945 F.2d at 515. The Eleventh Circuit reached the same conclusion, on the record before it, on factual grounds. App. 14a.

4. *Other Second Circuit Cases Further Disprove Any Conflict Between The Two Circuits.*

The absence of any conflict between the Second and Eleventh Circuits in the application of *Feist* is confirmed by examination of other decisions of the Second Circuit applying *Feist*. BAPCO mentions in its Petition only one other post-*Feist* Second Circuit case: *Kregos v. Associated Press*, 937 F.2d 700 (2d Cir. 1991), *on remand*, 795

[22] BAPCO contends that a conflict between the Second and Eleventh Circuits is also to be inferred from the Eleventh Circuit dissent's reliance on *Key*. The dissent's extensive reliance on the portion of *Key* concerning copyrightability of the *Key* plaintiff's directory reflects the dissent's acceptance of BAPCO's argument that proof of copyrightability was all that was needed to show infringement. BAPCO fails to acknowledge the Eleventh Circuit majority's citation to *Key* on the crucial question of what must be shown to prove infringement, App. 16a n.22, and does not address the fact that the dissent would have found copyrightable authorship in BAPCO's classification of listings under particular headings, *id.* at 27a, whereas the majority in the Eleventh Circuit and the Second Circuit in *Key* are entirely in agreement in holding to the contrary, as discussed in subpart 3, below.

F. Supp. 1325 (S.D.N.Y. 1992), *aff'd*, 3 F.3d 656 (2d Cir. 1993), *petition for cert. filed* (U.S. Nov. 30, 1993) (No. 93-863) ("*Kregos*"). In *Kregos*, the district court originally entered summary judgment in favor of the defendants on the plaintiff's copyright claims relating to a compilation of baseball statistics known as a "pitching form". *Kregos v. Associated Press*, 731 F. Supp. 113 (S.D.N.Y. 1990). On the first appeal, the Second Circuit reversed the summary judgment and remanded for trial on the fact-intensive issues of originality and infringement. Contrary to BAPCO's assertion, Pet. 24, the Second Circuit did not "uph[o]ld the copyrightability of a pitching form" but rather held only that the record did not warrant summary judgment for the defendants on the issue of originality. The Second Circuit specifically noted that:

> Our ruling that Kregos' copyright claim survives defendants' motion for summary judgment does not, of course, mean that he will necessarily obtain much of a victory. "Even if a work qualifies as a copyrightable compilation, it receives only limited protection . . . . [C]opyright protects only the elements that owe their origin to the compiler—the selection, coordination, and arrangement of facts." *Feist*, —U.S. at —, 111 S.Ct. at 1294. If Kregos prevails at trial on the factual issues of originality and creativity, he will be entitled to protection only against infringement of the protectable features of his form. Only the *selection* of statistics might be entitled to protection. We agree entirely with Judge Goettel that nothing in Kregos' *arrangement* of the selected statistics displays the requisite creativity.

Kregos, 937 F.2d at 709 (emphasis in original). There is certainly no inconsistency between these rulings and those of the Eleventh Circuit.

On remand, the district court again granted summary judgment in favor of the defendants. *Kregos v. Associated Press*, 795 F. Supp. 1325 (S.D.N.Y. 1992), holding, in part, that one of Kregos' pitching forms was copyrightable but could not be infringed as a matter of law by a

pitching form on which four or five out of ten of the categories of statistics differed. The Second Circuit affirmed this ruling. *Kregos v. Associated Press*, 3 F.2d 656 (2d Cir. 1993). Thus, in *Kregos*, as in the case below, close scrutiny of what the defendants were alleged to have copied from the plaintiff's work revealed the absence of any infringement.

Although BAPCO does not mention the fact in its Petition, the Eleventh Circuit cited *Kregos* (App. 10a) and two other post-*Feist* Second Circuit cases: *Victor Lalli Enterprises, Inc. v. Big Red Apple, Inc.*, 936 F.2d 671 (2d Cir. 1991) ("*Lalli*") (App. 10a n.13) and *Arica Institute, Inc. v. Palmer*, 970 F.2d 1067 (2d Cir. 1992) ("*Arica*") (App. 18a n.24), in its *en banc* decision. The issue in *Lalli* was whether, in light of *Feist*, "a compilation of information gleaned from horse racing statistics" was sufficiently original to be copyrightable. *Lalli*, 936 F.2d at 672. The Second Circuit affirmed a pre-*Feist* district court ruling that the plaintiff's charts of numbers for use by gamblers were not sufficiently original to be copyrightable, despite the plaintiff's investment of labor in compiling and calculating the material on the charts. *Id.* at 673-74. In citing *Lalli* on the issue of originality, the Eleventh Circuit expressly applied the same originality standard as was applied by the Second Circuit in *Lalli*.

In *Arica*, as in the case below, copyrightability of the plaintiff's work was not in dispute; the issue was infringement. The Second Circuit closely examined the plaintiff's and defendants' works on psychology to see if copyrightable elements of the plaintiff's work had been taken. As required by *Feist*, the Second Circuit proceeded element-by-element, finding, among other things, that material held out as factual could not be original and therefore copying of it could not be infringement. *Arica*, 970 F.2d at 1075-76. Finding some allegedly copied elements of the plaintiff's works uncopyrightable and the copying of other elements to be fair use, the Second Circuit affirmed a summary judgment in favor of the defendants.

Singly or together, these cases reveal no conflict between the Second and Eleventh Circuits. Like the decision below, *Key*, *Kregos*, *Lalli*, and *Arica* all illustrate efforts to carry out the fact-specific analysis required by *Feist*. BAPCO's contention that the Eleventh and Second Circuits are in conflict over the interpretation of *Feist* is groundless.

B. There Is No Conflict With Other Circuits' Interpretation Of *Feist*.

BAPCO says that "defendants in copyright actions are relying on *Feist* to argue that compilations previously recognized as entitled to copyright protection are no longer protected", Pet. 21-22, and contends that there is a resulting trend toward a "limited reading of *Feist*". *Id.* at 27. As examples for this asserted proposition, BAPCO cites (in addition to the Second Circuit's 1991 decision in *Kregos*) just three of at least twelve Circuit-level compilation copyright decisions applying *Feist*.[23]

BAPCO first discusses, *see id.* at 22-24, the District of Columbia Circuit's decision in *Atari Games Corp. v. Oman*, 979 F.2d 242 (D.C. Cir. 1992) ("*Atari*"), which involved copyrightability of an audiovisual work (defined in the Copyright Act as a work that consists of "a series of related images", 17 U.S.C. § 101 (Supp. IV 1992)), not

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[23] *Kregos v. Associated Press*, 3 F.3d 656 (2d Cir. 1993), *petition for cert. filed* (U.S. Nov. 30, 1993) (No. 93-863); *Mid Am. Title Co. v. Kirk*, 991 F.2d 417 (7th Cir.), *cert. denied*, 114 S. Ct. 346 (1993); *Harper House, Inc. v. Thomas Nelson, Inc.*, 5 F.3d 536 (9th Cir. 1993), *petition for cert. filed* (U.S. Dec. 10, 1993) (No. 93-916); *The Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, No. 92-1256, 1993 U.S. App. LEXIS 27045 (10th Cir. Oct. 19, 1993); *Arica Inst., Inc. v. Palmer*, 970 F.2d 1067 (2d Cir. 1992); *Mason v. Montgomery Data, Inc.*, 967 F.2d 135 (5th Cir. 1992); *Schiller & Schmidt, Inc. v. Nordisco Corp.*, 969 F.2d 410 (7th Cir. 1992); *Atari Games Corp. v. Oman*, 979 F.2d 242 (D.C. Cir. 1992); *Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc.*, 945 F.2d 509 (2d Cir. 1991); *Victor Lalli Enters., Inc. v. Big Red Apple, Inc.*, 936 F.2d 671 (2d Cir. 1991); *Sem-Torq, Inc. v. K Mart Corp.*, 936 F.2d 851 (6th Cir. 1991); *Illinois Bell Tel. Co. v. Haines & Co.*, 932 F.2d 610 (7th Cir. 1991).

alleged infringement of fact compilations. In analyzing the copyrightability of an audiovisual work composed of uncopyrightable images, the court drew an analogy to compilations on the ground that an audiovisual work, like a compilation, may consist of uncopyrightable elements, the selection and arrangement of which may be protectable. Because an audiovisual work is one that, by definition, consists of a flow ("series") of images, the court faulted the Register of Copyrights for basing his decision as to originality on the individual images rather than on whether the "flow" of the images was original. *Atari*, 979 F.2d at 245.

BAPCO seeks to draw from *Atari* the inference that the District of Columbia Circuit construed *Feist* to embrace the *gestalt* theory of compilation copyright on which BAPCO relied in the courts below. *Atari* does not bear that inference because audiovisual works, by definition, owe their copyrightability not to "constituent elements of the work that are original," *Feist*, 499 U.S. at 361 (citation omitted), but to an original flow of the elements, whether or not those elements are original. *Atari* does not say that copying of uncopyrightable elements from a copyrightable audiovisual work would infringe the copyright, nor could it in light of the plain holding of *Feist*. BAPCO's reliance on *Atari* simply evidences again its continuing effort to confuse the separate questions of copyrightability and infringement.

The second case cited by BAPCO is the Ninth Circuit's most recent opinion in *Harper House, Inc. v. Thomas Nelson, Inc.*, 5 F.3d 536 (9th Cir. 1993) (full text reported at Nos. 91-55426, 91-55550, 91-55774, 1993 U.S. App. LEXIS 23390 (9th Cir. Sept. 10, 1993)), *petition for cert. filed* (U.S. Dec. 10, 1993) (No. 93-916) ("*Harper House*"). *Harper House* simply found that a genuine factual dispute as to the originality of the plaintiff's work should have been submitted to a jury. 1993 U.S. App. LEXIS 23390, at *7. Contrary to BAPCO's contention, Pet. 25, the Ninth Circuit did not make *any* ruling as to copyrightability or infringement.

BAPCO's final example of alleged conflict, *Mason v. Montgomery Data, Inc.*, 967 F.2d 135 (5th Cir. 1992) ("*Mason*"), involved real estate title maps. *Mason* simply illustrates again how a plaintiff that proves the originality of its selection, coordination, or arrangement of material in a compilation, and further proves that its original authorship has been copied by another, may prevail in a copyright infringement action under the principles established in *Feist*.[24]

BAPCO does not mention several cases that further confirm that the Circuits are having no difficulty applying the teachings of *Feist*. In addition to the District of Columbia, Second, Fifth, and Ninth Circuit cases discussed above, *Feist* has been applied to compilation copyright issues in at least the Sixth, Seventh, and Tenth Circuits. *See The Gates Rubber Co. v. Bando Chem. Indus., Ltd.* No. 92-1256, 1993 U.S. App. LEXIS 27045 (10th Cir. Oct. 19, 1993) (applies *Feist* to require element-by-element analysis of computer program, and finds no infringement as to unoriginal elements); *Mid Am. Title Co. v. Kirk*, 991 F.2d 417 (7th Cir.), *cert. denied*, 114 S. Ct. 346 (1993) (emphasized inherently factual nature of the originality inquiry requirement of *Feist* and reversed a Rule 12(b)(6) dismissal of a copyright infringement claim on the grounds that *Feist* imposed no special pleading requirements); *Schiller & Schmidt, Inc. v. Nordisco Corp.*, 969 F.2d 410, 414 (7th Cir. 1992) (no infringement of compilation copyright in office supply catalog: "[G]iven the utilitarian and hence inevitably rather standardized format of a mail order catalog of office supplies", no original authorship shown to have been copied); *Sem-Torq, Inc. v. K Mart Corp.*, 936 F.2d 851 (6th Cir. 1991) (applies *Feist* to determine the copyrightability of a claimed compilation of signs; find-

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[24] BAPCO also mentions *Los Angeles News Service v. Tullo*, 973 F.2d 791 (9th Cir. 1992), a case having to do with copyrights on raw videotapes of news events, rather than compilations, with no apparent relevance to the matters at issue here.

ing neither a compilation nor original authorship, affirmed summary judgment for the defendants).

As a whole, the developing case law under *Feist*—while still in its infancy—reveals no confusion or inconsistency in principle or application. The Eleventh Circuit decision below follows the pattern common to all of these cases: it applies the originality requirements of *Feist* to the particular facts before the court.

IV. BAPCO'S REAL DISPUTE IS WITH THIS COURT'S DECISION IN *FEIST*.

BAPCO asserts that the Eleventh Circuit erred by "evaluating creativity on an element-by-element basis rather than judging the compilation as a whole." Pet. 11. In the context of the infringement issues present in the case below, this is simply an attack upon the Eleventh Circuit's refusal to rule that the facts within BAPCO's compilation of facts were protected expression that could not be copied without infringement. The Eleventh Circuit's decision in this regard was mandated by *Feist*, which holds that:

> [f]acts, whether alone or as part of a compilation, are not original and therefore may not be copyrighted. A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves.

499 U.S. at 350-51. *Feist* further holds that "[n]otwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, so long as the competing work does not feature the *same* selection and arrangement." *Id.* at 349 (emphasis added).

Given these plain holdings of this Court, which were faithfully followed by the Eleventh Circuit below, BAPCO's Petition is revealed to be nothing more than an attack upon this Court's recent, unanimous decision in

Feist.[25] BAPCO's Petition presents no good reason to overrule the *Feist* decision, and there is none.

CONCLUSION

BAPCO's Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

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[25] This impression is strengthened by the announced intention of many of the *amici* who appeared in support of Rural Telephone in *Feist* to defend the "sweat of the brow" doctrine (including West Publishing Company and various local telephone companies and their affiliated directory publishers) to seek leave to file *amicus* briefs in this Court in support of BAPCO (whose corporate parent, BellSouth Corporation, also appeared in *Feist* in support of Rural Telephone and made substantially the same arguments now being reargued by BAPCO in its Petition).

No. 93-862

FILED
DEC 28 1993

IN THE
Supreme Court of the United States
OCTOBER TERM, 1993

BELL SOUTH ADVERTISING & PUBLISHING CORPORATION,
Petitioner,
v.
DONNELLEY INFORMATION PUBLISHING, INC., and
THE REUBEN H. DONNELLEY CORPORATION,
Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

MOTION FOR LEAVE TO FILE A BRIEF AND BRIEF OF AMICI CURIAE AMERITECH PUBLISHING, INC., NYNEX CORPORATION, AND BELL ATLANTIC CORPORATION IN SUPPORT OF PETITIONER

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On Petition for Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

MOTION OF AMERITECH PUBLISHING INC., NYNEX CORPORATION, AND BELL ATLANTIC CORPORATION FOR LEAVE TO FILE A BRIEF IN SUPPORT OF PETITION OF BELLSOUTH FOR A WRIT OF CERTIORARI

Pursuant to Rule 37 of the Rules of this Court, Ameritech Publishing, Inc., NYNEX Corporation, and Bell Atlantic Corporation request leave to file a brief as amici curiae in support of BellSouth Advertising and Publishing Corporation's ("BAPCO") petition for a writ of certiorari to the United States Court of Appeals for the Eleventh

Circuit. Petitioner BAPCO granted consent; however, amici were unable to obtain the consent of Respondents Donnelley Information Publishing, Inc. and the Reuben H. Donnelley Corporation.

This case involves the nature and scope of copyright protection to be afforded yellow pages directories and other compilations in which factual data are selected and arranged according to particular headings and subheadings chosen by directory publishers. Ameritech Publishing, Inc., NYNEX Corporation, and Bell Atlantic Corporation directly or through subsidiaries, publish both "yellow pages" and "white pages" telephone directories and compile computerized data bases.

Amici are concerned about the implications of the opinion by the *en banc* court of the Eleventh Circuit. If accepted by other courts, the reasoning in this opinion threatens to eviscerate copyright protection for the creative and original portions of yellow pages telephone directories, computerized data bases, data base management systems, the content of the "information superhighway," and other similar works.

Amici also believe that their participation in this appeal is helpful in providing the Court with additional information about the original efforts involved in the creation of yellow pages and how those efforts relate to the creation of other types of data bases. In the accompanying brief, Amici offer their views as to why the selection of headings and the selection of particular listings to be associated with such headings reflect substantial originality, and are crucial to the creation of competitive yellow pages directories and other similar compilations.

Amici also have a significant financial stake in this litigation. If the position of the Eleventh Circuit were adopted by other courts, the fruit of Amici's creative efforts in developing yellow pages directories would be at risk. For the foregoing reasons, the Court should grant

Ameritech Publishing, Inc., NYNEX Corporation, and Bell Atlantic Corporation leave to file the attached brief as amici curiae in support of the petition of BAPCO for a writ of certiorari to the United States Court of Appeals for the Eleventh Circuit.

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December 28, 1993

QUESTION PRESENTED

Whether the court below erred in concluding that the selection, coordination, or arrangement of the headings and the listings under those headings in a yellow pages directory is not sufficiently creative to qualify for copyright protection, so that a rival publisher does not violate the registered copyright in the work when it engages in wholesale copying of that compilation.

TABLE OF CONTENTS

	Page
QUESTION PRESENTED	i
TABLE OF AUTHORITIES	iv
OPINIONS BELOW	1
PERTINENT CONSTITUTIONAL AND STATUTORY PROVISIONS	1
JURISDICTION	2
INTEREST OF AMICI	2
SUMMARY OF ARGUMENT	3
REASONS FOR GRANTING THE WRIT	4
I. CERTIORARI SHOULD BE GRANTED TO RESOLVE AN ISSUE OF CRITICAL IMPORTANCE TO YELLOW PAGES AND OTHER DATA COMPILATION BUSINESSES	4
A. The Decision Below Underestimates the Substantial Level of Creativity Involved In Creating Yellow Pages Directories	4
1. The Selection Of Yellow Pages Headings Reflects Substantial Originality	4
2. The Selection Of Particular Listings To Be Associated With Yellow Pages Headings Reflects Substantial Originality	8
B. If Left Standing, The Decision Below Could Effectively Nullify the Compilation Copyright In Yellow Pages Directories, As Well as In Computer Data Bases and Similar Works	11
II. CERTIORARI SHOULD BE GRANTED BECAUSE THE DECISION BELOW CONFLICTS WITH DECISIONS OF OTHER COURTS AND IS CONTRARY TO FEIST	13
CONCLUSION	15

TABLE OF AUTHORITIES

Cases: Page

Atari Games Corp. v. *Oman*, 979 F.2d 242 (D.C. Cir. 1992) 14

BellSouth Advertising & Publishing Corp. v. *Donnelley Info. Publishing, Inc.*, 719 F. Supp. 1551 (S.D. Fla. 1988) ..... *passim*

Eckes v. *Card Prices Update*, 736 F.2d 859 (2d Cir. 1984) 14

Feist Publications, Inc. v. *Rural Telephone Service Co.*, 499 U.S. 340, 111 S. Ct. 1282 (1991) ..... *passim*

J.R. O'Dwyer Co. v. *Media Mktg. Int'l, Inc.*, 755 F. Supp. 599 (S.D.N.Y. 1991) 14

Key Publications, Inc. v. *Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991) 13, 14

Kregos v. *Associated Press*, 937 F.2d 700 (2d Cir. 1991) 13

M.G.B. Homes, Inc. v. *Ameron Homes, Inc.*, 903 F.2d 1486 (11th Cir. 1990) 10

Miscellaneous:

H.R. Rep. No. 1476, 94th Cong., 2d Sess. 54 (1976) Final Report of the National Commission on New Technological Uses of Copyrighted Works ("CONTU") (1978) 12

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On Petition for Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

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BRIEF OF AMICI CURIAE AMERITECH PUBLISHING, INC., NYNEX CORPORATION, AND BELL ATLANTIC CORPORATION IN SUPPORT OF PETITIONER

OPINIONS BELOW

The *en banc* opinion of the United States Court of Appeals is reprinted at 999 F.2d 1436. Citations herein are to the Appendix of Petitioner.

PERTINENT CONSTITUTIONAL AND STATUTORY PROVISIONS

Article I, Section 8, Clause 8 of the United States Constitution, and the Copyright Act of 1976, 17 U.S.C. § 101 et. seq. are set forth in the Appendix of Petitioner.

JURISDICTION

Amici adopt the Jurisdictional Statement of Petitioner.

INTEREST OF AMICI

Amici Curiae, Ameritech Publishing, Inc. (also known as "Ameritech advertising services"), NYNEX Corporation, and Bell Atlantic Corporation submit the following brief in support of the Petition of BellSouth Advertising and Publishing Corp. ("BAPCO") for a writ of certiorari to the United States Court of Appeals for the Eleventh Circuit. Amici are engaged in the business of, among other things, compiling yellow pages telephone directories. Based upon that experience, Amici believe that Eleventh Circuit Court of Appeals, sitting *en banc*, has substantially underestimated the scope and nature of (1) the creative efforts involved in the preparation of yellow pages; and (2) the copyright protection afforded yellow pages and other compilations. As a result, the Eleventh Circuit has improperly held that the efforts of yellow pages and other data compilation businesses to select, coordinate and arrange information in an original, creative, and commercially valuable manner are not protected by copyright—but instead may be appropriated at will by competitors.

The decision below affects not only the yellow pages industry, but it also has substantial implications for the content of the "information superhighway," for legal research information data bases such as WESTLAW® and LEXIS®, and for catalogues and directores of every kind, all of which are compilations of facts. Because of the importance of these issues to Amici, to the yellow pages industry as a whole, and to other data compilation businesses, Amici submit this brief in support of the Petition of BAPCO for a writ of certiorari to the Eleventh Circuit.

SUMMARY OF ARGUMENT

This Court's decision in *Feist Publications, Inc.* v. *Rural Telephone Service Co.*, 499 U.S. 340, 111 S.Ct. 1282 (1991) ("*Feist*"), establishes that Respondents ("Donnelley") may copy into a data base each of the names, addresses and telephone numbers listed in a white pages directory. The petition pending before this Court, however, involves far more than simply the reproduction of alphabetical white pages listings or even yellow pages listings. In developing its competing yellow pages directories, Donnelley also has copied into its data base the particular listings associated with each of BAPCO's headings, thereby copying BAPCO's classifications of thousands of individual businesses. Nothing in *Feist* or its progeny permits Donnelley to expropriate the commercially valuable creative effort that goes into determining such classifications.

Feist makes clear that the selection and arrangement of facts are protected by the compilation copyright if that selection or arrangement reflects "originality." Originality requires only that the author make the selection independently and that the selection "display some minimal level of creativity." *Feist Publications, Inc.*, 111 S. Ct. at 1294. There can be no question that yellow pages, including their ad displays, are copyrightable; indeed, the Eleventh Circuit noted below that Donnelley had conceded that point. (App. 4a, 6a-7a.) In addition, the compilation of yellow pages directories requires substantial efforts on the part of publishers in selecting particular headings, associating the individual listings with those headings and arranging those listings within each heading which are also copyrightable.

As the dissent noted below, there is "no factual dispute" that Donnelley "substantially appropriated BAPCO's selection of headings" and "other original acts of selection and arrangement." (App. 39a.) Such efforts more than satisfy the "minimal" standard of originality articulated by the Supreme Court in *Feist*. Indeed, if those efforts are

not protected by copyright, it is difficult to imagine a case where data bases will be protected by the copyright laws.

This Court should grant BAPCO's petition for a writ of certiorari in order to resolve conflicting lower court applications of *Feist* to data compilations, and to reverse a decision which would otherwise effectively eviscerate the protection Congress intended to afford data compilations under the Copyright Act of 1976, 17 U.S.C. §§ 101 et seq.

REASONS FOR GRANTING THE WRIT

I. CERTIORARI SHOULD BE GRANTED TO RESOLVE AN ISSUE OF CRITICAL IMPORTANCE TO YELLOW PAGES AND OTHER DATA COMPILATION BUSINESSES

Certiorari should be granted to resolve an issue which is of critical importance to the parties, to Amici, and to other information compilation businesses. That issue—which concerns the nature and level of creativity necessary to warrant copyright protection for data bases—has now been squarely presented to this Court by the decision of the Eleventh Circuit below, sitting *en banc*. The decision below reaches the very heart of the copyrightability of the original aspects of selecting and arranging the content of data base compilations, such as yellow pages directories; and it has serious and immediate implications for the activities of data compilation businesses nationwide.

A. The Decision Below Underestimates the Substantial Level of Creativity Involved In Creating Yellow Pages Directories

1. *The Selection of Yellow Pages Headings Reflects Substantial Originality*

The Eleventh Circuit held—despite the District Court's findings to the contrary (see App. 80a-81a)—that "BAPCO failed to present evidence that, even if copied,

its heading structure constitutes original expression warranting copyright protection." (App. 14a.) Indeed, the Eleventh Circuit opinion gives the misimpression that publishers of such directories do little more than rely on the "standardized headings" of the National Yellow Pages Service Association, or utilize "such [] obvious label[s]" for headings, such as "attorneys," that the heading selection process involves no original expression or creative endeavor. (App. 14a.)

The opinion below vastly understates the creativity involved in selecting directory headings. Publishers of yellow pages directories do make use of an industry-wide reference guide. But it is wrong to suggest that yellow pages directories such as those published by Amici can be created entirely through reliance on such a guide. To the contrary, the process of selecting particular headings for a particular directory entails a considerable degree of ingenuity and creativity.

A yellow pages publisher chooses what may be anywhere from a few hundred to a few thousand different headings, as the publisher deems necessary and appropriate for each individual directory. The publisher must formulate, and continuously revise and refine, its selection of headings to ensure that they are responsive to the ever-changing needs, habits and tastes of consumers. Directory publishers seek to tap into the mindset of the public they serve—to create a directory that will appeal to their evolving audiences, just as a writer of popular music or books attempts to create a work with commercial appeal.

A "user-friendly" directory—one that can be used easily by a consumer without reference to instructional materials—is, of course, important to consumers, who might not otherwise find the particular product or service they wish to purchase. It is equally important to the advertiser, who wants the consumer to locate a listing with sufficient ease so as not to be discouraged by the search process.

Consumers will not use, and businesses will not advertise in, a yellow pages directory that is not "user-friendly."

Because judgment is necessarily involved in determining what makes a directory appealing to consumers, no two yellow pages publishers select the same set of headings (absent, of course, unauthorized copying). To be sure, there are standardized headings such as "attorneys" and "banks" that seem to be common to all directories. There are, however, a host of headings whose inclusion in, or exclusion from, a particular directory will vary depending upon the judgments made by different publishers. For example—

> —One publisher might choose to consolidate a number of different businesses under a common heading, such as "Beauty Salons" Another publisher might choose to distinguish among, and list separately, businesses including "Hair Dressers," "Color Consultants," "Facials," "Manicurists" or "Fingernail Salons".
>
> —The terminology generally applied to particular goods and services varies from one geographic region to the next. For example, what may be listed under "Aerobics" in one city may be called "Dance Instruction" or "Exercise Studios" in another.
>
> —Particular goods and services may be in greater demand in certain areas of the country than in others. A Silicon Valley yellow pages directory will thus contain categorizations for products and services not yet in significant use elsewhere. Similarly, in the Midwest, there may be a great demand for "Well Drillers," whereas in the metropolitan East, municipal water may render that heading unnecessary.
>
> —Certain headings may create legal or ethical issues. For example, if a state proscribes gambling, a judgment must be made about how to characterize "Bingo Halls" and "Lotteries."
>
> —A directory publisher may make the judgment call to anticipate legal and regulatory developments with

such headings as "Recycling Services," "Air Quality Control Services," or "Asbestos Abatement and Removal Services."

The yellow pages publisher must take account of these and other considerations when determining how consumers are likely to use its directory. To do so, experienced directory representatives conduct extensive research, using a number of different reference sources—such as product guides, dictionaries, encyclopedias and marketing studies. In addition, they consult with professional lexicographers and linguistic experts who can help determine whether particular expressions are suitably crafted to reach the desired audience. And they spend substantial amounts of time discussing the need for new or different headings with the advertisers themselves.

Publishers also may choose to utilize different approaches in heading selection to enhance user-friendliness. They may employ different guides and subheadings—a restaurant guide, for example, could be organized by type of food, geographic location, hours of operation or type of service (formal, informal, takeout, delivery). They also may utilize cross-referencing techniques, directing a consumer's attention to other headings that the publisher considers to be related.

The process of selecting headings is a continuous one. The selection of headings for a particular directory will necessarily evolve over time, as consumers change their preferences or develop more sophisticated understandings of products, and as a market itself changes and expands into new services and technologies. Karaoke music and step aerobics, for example, are new products and services that have raised classification issues in recent years and have generated different responses from different publishers. In resolving such issues, publishers must balance (among other considerations) the benefits of creating additional specific headings with the possible burdens on current advertisers who do not wish to advertise under multiple headings.

Amici evaluate hundreds of separate requests for new headings each year. Some are accepted, while many others are rejected. In each case, Amici exercise their judgment to determine whether a new heading would improve their directories. Similar judgment calls are made by every publisher who relies on its own creative efforts, rather than copying, to produce a yellow pages directory or other data compilation that consumers wish to use.

2. *The Selection Of Particular Listings To Be Associated With Yellow Pages Headings Reflects Substantial Originality*

The Eleventh Circuit also concluded that the association of listings with particular headings lacks sufficient originality to be protected by copyright. According to the court, such association reflects no more than a "technique[] for the discovery of facts," a means of identifying an advertiser's own choice of how to be classified. (App. 8a.) Again, the court below has mischaracterized the process of creating yellow pages directories.

The determination of where to place specific listings is the product of very substantial creative effort on the part of the directory publisher and its representatives. The objective of that effort, like the objective of the effort involved in selecting headings, is to achieve user-friendliness—to ensure that each of the thousands of businesses included in a directory is categorized in a way that allows consumers to locate with ease the information they wish to obtain from that directory.

The placement of certain listings under certain headings may be straightforward; however, the placement of many other listings (or indeed the placement of the same listings under other categories) will frequently require difficult judgments and creative approaches. For example,

> —Pizza could be listed under "Carry Out," "Restaurants," "Food" or "Pizza."

—Landscape Contractors could be listed under "Lawn Maintenance," "Sod and Sodding Services," or "Nurseries, Plants and Trees."

—Dieticians could be listed under "Nutritionists," "Health and Diet Food Products," or "Weight Control Services."

—Boat Dealers may fall under "Boat Rental and Leasing," "Boat Storage," "Charters," "Fishing Parties," or "Boat Repair and Equipment."

Similarly, it might be problematic to list a pro-life advocacy group under a heading for "Abortion Counselling and Provision." A publisher may have to create several headings (such as "Pregnancy Counselling," "Abortion Alternatives," or "Family Planning Services") to ensure that the listings within the headings are not only accurate, but also respond to the sensibilities of the community served by the directory.

In each case, the publisher must choose among the many possible classifications and determine which among them are appropriate. These judgments will vary from publisher to publisher. Consequently, any one publisher's selection and arrangement of the listings to be included among each of the hundreds or thousands of categories in a directory will be different from another publisher's selection and arrangement (absent copying).

To ensure an informed judgment, the publishers' representatives discuss with advertisers the nature of their businesses—including the goods and services they offer; the specific brands they carry; the actual and potential geographic markets they seek to serve; the identity of the consumer groups which they seek to reach; anticipated changes in their businesses; the nature of any competitive advantages they may possess; and the various ways their goods or services might be utilized in connection with other goods and services.

Based upon its research and the policies it follows, the publisher determines the appropriate heading classifica-

tions under which each listing may fall. Typically, the determination is that the advertiser may come within several headings—often including headings that the advertiser itself did not initially consider. The publisher also may determine that the advertiser's business warrants inclusion and classification in more than one geographic directory. The publisher will often select for inclusion in a yellow pages directory listings from outside the precise geographic scope identified in the directory.

Publishers in fact employ market research firms to determine where the consumers residing in a geographic area shop for particular goods and services. Such studies are used by the publisher in its discussions with advertisers to determine the extent, location and type of directory advertising necessary to ensure maximum usefulness of each directory to both consumers and advertisers.

An advertiser may, of course, suggest specific headings under which it wishes to see its business listed. But the suggestion may be inappropriate under any of a number of policies that the publisher follows; if so, the publisher will not accept the advertiser's suggestion. For example, a publisher might refuse to list under the heading "Landscape Contractors" a company that performed referral services for landscaping, but not landscaping itself. Similarly, artificial flower companies have not been listed under "Florists," and exotic lingerie shops have not been listed under "Entertainment Bureaus"—notwithstanding the requests of advertisers. And all directory publishers must determine how to classify, for example, Chiropractors, Podiatrists, Homeopaths and Naturopaths.

It also is true that the advertiser ultimately must approve the placement of its listing under any particular category. Courts have generally held, however, that the identity of the party who has final approval rights is irrelevant for copyright purposes. *See M.G.B. Homes, Inc.* v. *Ameron Homes, Inc.*, 903 F.2d 1486, 1493 (11th Cir. 1990). In any event, such a right of approval cannot obscure the fact that the publisher retains final au-

thority over the selection and arrangement of all the listings to be associated with each of the headings in its directory; nor does it alter the nature or magnitude of the publisher's creative efforts in making that selection and arrangement.

B. If Left Standing, The Decision Below Could Effectively Nullify the Compilation Copyright In Yellow Pages Directories, As Well as In Computer Data Bases and Similar Works

There can be no doubt that the Court in *Feist* regarded white pages telephone directories as an especially clear case for the denial of copyright protection:

> Given that some works must fail [to satisfy the requirement for a de minimus quantum of creativity], we cannot imagine a more likely candidate [than Rural's white pages directory]. Indeed, were we to hold that Rural's white pages pass muster, it is hard to believe that any collection of facts could fail.

111 S. Ct. at 1297. As this suggests, along the spectrum of compilations, white pages telephone directories stand at one extreme. But the Court in *Feist* contemplated that most other compilations would qualify for copyright protection, noting that "the requisite level of creativity is extremely low; even a slight amount will suffice." 111 S. Ct. at 1287.

As discussed above, yellow pages directories more than satisfy the requisite standards for originality. Unable to deny copyright protection to BAPCO's directories altogether, the court below adopts an alternative that yields a functionally equivalent result for those directories that are competitive databases.

The Eleventh Circuit has determined that BAPCO's selection of yellow pages headings, and listings associated with each of those headings, are nothing more than mere facts identified through a discovery process. If that determination is the law, the legal significance and benefits of

a compilation copyright would be seriously threatened. Indeed, such an unbounded interpretation of what constitutes a "fact" could read out of the copyright law all practical protection for the selection and arrangement of factual information. Electronic publishers would be able to claim the right to reproduce and publish (via an electronic network or CD-ROM disks) the entire selection of names, addresses, telephone numbers, headings, and listings associated with each of those headings, from any publisher's yellow pages directory.

The implications of the Eleventh Circuit's decision are not limited to yellow pages telephone directories, but extend to other kinds of directories and catalogues as well as computerized data bases, data base management systems, and even LEXIS®, and WESTLAW® information data bases. Congress has specifically concluded that data bases are similar to directories and thus qualify for copyright protection. *See* H.R. Rep. No. 1476, 94th Cong., 2d Sess. 54 (1976); Final Report of the National Commission on New Technological Uses of Copyrighted Works ("CONTU") at 38 (1978). If the selection of materials included in a computerized data base can be said to consist solely of "facts" (as Donnelley and the Eleventh Circuit would characterize them), third parties could henceforth claim the unrestricted right to duplicate entire data bases, which is directly contrary to the congressional intent of the 1976 Act.

The *Feist* decision has provided important guidance on the constitutional basis for copyright protection. It reaffirms that copyright protection is available for even a modicum of creative originality in the selection or arrangement of pre-existing data. The decision below circumvents this result by recharacterizing what is clearly a copyrightable selection into uncopyrightable facts. If left standing, that decision threatens the existing legal foundation for protecting, and thereby encouraging the creation and dissemination of, copyrightable directories, catalogues and computerized data bases.

II. CERTIORARI SHOULD BE GRANTED BECAUSE THE DECISION BELOW CONFLICTS WITH DECISIONS OF OTHER COURTS AND IS CONTRARY TO FEIST

The Court also should grant BAPCO's petition for a writ of certiorari because the *en banc* decision of the Eleventh Circuit directly conflicts with a decision from the Second Circuit, and is contrary to this Court's own opinion in *Feist*. As a result, the opinion below has created substantial legal uncertainty for data compilation businesses nationwide. That uncertainty should be resolved expeditiously by a decision of this Court.

The court below holds that the selection of headings for a yellow pages directory does not constitute expression protected by the copyright laws. (App. 7a-9a, 14a.) But that holding is inconsistent with the decision in *Key Publications, Inc.* v. *Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509, 514 (2d Cir. 1991) ("*Key Publications*"). There the Second Circuit held that the determination of which categories to include in a directory and under what name "entailed the de minimis thought needed to withstand the originality requirement." *See also Kregos* v. *Associated Press*, 937 F.2d 700, 704-05 (2d Cir. 1991) (Plaintiff's selection of nine categories of statistics constitutes originality).

The Second Circuit in *Key Publications* also emphasized that infringement may be found "if there is a substantial similarity in the selection of businesses listed in the two publications." 945 F.2d at 514. *See also id.* at 517 (If defendant's directory had "exactly duplicated a substantial designated portion" of plaintiff's directory—"for example, all its listings of professionals such as medical doctors, lawyers, accountants, engineers and architects, an infringement action would succeed.") It is precisely such substantial (and thus unlawful) duplication in which Donnelley has engaged; yet the Eleventh Circuit, contrary to

Key Publications, has erroneously concluded that Donnelley has not infringed upon BAPCO's copyright.

Furthermore, by second-guessing the amount of originality entailed in particular BAPCO judgments as to how to select headings and arrange entries within those headings, the Eleventh Circuit has sought to transform the copyright originality requirement into a much more exacting standard than it is. As the Court observed in *Feist*, that requirement "is not particularly stringent." 111 S. Ct. at 1294. "[T]he requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily . . . ." *Id.* at 1287. *See also Atari Games Corp.* v. *Oman*, 979 F.2d 242, 243 (D.C. Cir. 1992) (noting that the Court in *Feist* "left no doubt that the [originality] requirement is indeed modest . . . ."); *Key Publications* at 513 (even the choice of a directory publisher not to include certain businesses which might not stay open long "alone indicates thought and creativity" sufficient to meet the originality requirement). The creativity that goes into selecting and arranging the listings in a yellow pages directory comfortably exceeds this minimal threshold. *See* pp. 4-11 *supra*.

Indeed, if one's simple classification of baseball cards as "premium" or "common" qualifies as protected expression, *see Eckes* v. *Card Prices Update*, 736 F.2d 859, 863 (2d Cir. 1984), then certainly the classifications of a yellow pages directory must likewise qualify. *See J.R. O'Dwyer Co.* v. *Media Mktg. Int'l, Inc.*, 755 F. Supp. 599, 601 (S.D.N.Y. 1991) (Plaintiff's selection of only "true" public relations firms to be included in its annual directory constituted sufficient originality under *Eckes*, notwithstanding that plaintiff was willing to include any firm willing to pay the printing fee). The decision below, however, requires a level of creativity for copyright protection that goes far beyond that required by the Second Circuit and by this Court in *Feist*.

CONCLUSION

For the reasons stated above, this Court should grant the writ of certiorari to the United States Court of Appeals for the Eleventh Circuit.

Respectfully submitted,

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December 28, 1993

MOTION FILED
DEC 29 1993

(4)

No. 93 - 862

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1993

BELLSOUTH ADVERTISING
& PUBLISHING CORPORATION,
Petitioner,

v.

DONNELLEY INFORMATION PUBLISHING, INC., AND
THE REUBEN H. DONNELLEY CORPORATION,
Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

---

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE AND BRIEF OF MARTINDALE-HUBBELL, INC. AS AMICUS CURIAE IN SUPPORT OF PETITIONER BELLSOUTH ADVERTISING & PUBLISHING CORPORATION

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---

MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE*

Martindale-Hubbell, Inc. ("Martindale-Hubbell") hereby respectfully moves for leave to file the attached brief as *amicus curiae* in this case. The consent of the attorney for Petitioner, BellSouth Advertising & Publishing

Corporation ("BAPCO"), has been obtained.* The consent of the attorney for Respondents, Donnelley Information Publishing, Inc. and The Reuben H. Donnelley Corporation (collectively "Donnelley"), was requested but refused.

The interest of Martindale-Hubbell in this case arises from the fact that annually Martindale-Hubbell publishes the Martindale-Hubbell Law Directory. This Law Directory contains, *inter alia*, a roster, as complete as possible, of the Bar of the United States and Canada, plus listings for lawyers in the United States Pacific and Other Territories, listings for lawyers registered to practice Patent Law before the U.S. Patent and Trademark Office and to practice Canadian patent law, listings for lawyers employed by the Federal Government in Washington, D.C.,

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* The written consent of Petitioner is being filed with the Clerk of the Court contemporaneously herewith.

and listings of international lawyers whose professional interests extend beyond their own countries. These listings appear in the Geographical Section of seven volumes of the Martindale-Hubbell Law Directory.

Martindale-Hubbell creates the Law Directory by directly contacting attorneys through mailings as well as through its field representatives, and having those attorneys complete questionnaires to provide the information which appears in the Directory. Martindale-Hubbell also engages in a continual and elaborate effort to update the data in the Directory and to monitor the status of attorneys listed therein. Among other things, it directly communicates with state bars and/or admitting authorities in the United States and Canadian Provinces, as well as local Bar associations, and obtains lists of new attorneys, changes in Bar membership,

notices of deceased attorneys, notices of discipline, suspension and reinstatements, it reviews annual Bar rosters and state and local Bar publications, and it monitors attorney advertising regulations and state specialization programs.

Each volume of the Martindale-Hubbell Law Directory is published with a copyright notice in accordance with the copyright act. Martindale-Hubbell registered the copyrights in its law directories and received certificates of registration from the Copyright Office. Martindale-Hubbell is the owner of the copyrights and the copyright registrations in the Martindale-Hubbell Law Directory.

Martindale-Hubbell presently has pending a case styled Martindale-Hubbell, Inc. v. Dunhill International List Company, Inc., United States District Court for the Southern

District of Florida, Case No. 88-6767-CIV-ROETTGER. That case was brought by Martindale-Hubbell against Dunhill (a mail list company) for, *inter alia*, infringement of Martindale-Hubbell's copyrights in the Martindale-Hubbell Law Directory.

Martindale-Hubbell and Dunhill filed cross-motions for summary judgment on the copyright issues. Recently, the magistrate in that case issued a "Report And Recommendation To District Judge" wherein it was found that Dunhill had not copied any original constituent elements of the Martindale-Hubbell Law Directory. The magistrate's decision was based in large part upon the Eleventh Circuit's en banc decision in *BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*, 999 F.2d 1436 (11th Cir. 1993)(the case below).

Martindale-Hubbell is interested in a proper interpretation of the copyright law since it relies heavily on copyright protection for the Martindale-Hubbell Law Directory. If the en banc Eleventh Circuit decision below is permitted to stand, other mail list companies and other competitors may be able to copy the Martindale-Hubbell Law Directory with impunity in the Eleventh Circuit. The en banc decision may also encourage courts in other circuits to adopt the approach of the Eleventh Circuit in the case below. This will inevitably lead to confusion and a lack of clarity as to the scope of copyright protection, if any, for Martindale-Hubbell's Law Directory throughout the country. Such a result would seriously and irreparably damage Martindale-Hubbell's publishing business.

Petitioner, BAPCO, has argued a number of issues supporting grant of *certiorari* in this case and only briefly discusses the standard by which creativity should be measured. The brief that Martindale-Hubbell is requesting permission to file as *amicus curiae* focuses on that issue and contains a more complete argument of the correct standard by which creativity of works of authorship should be measured. This argument should be helpful to

the Court in determining whether to grant *certiorari* in this case.

Respectfully submitted,

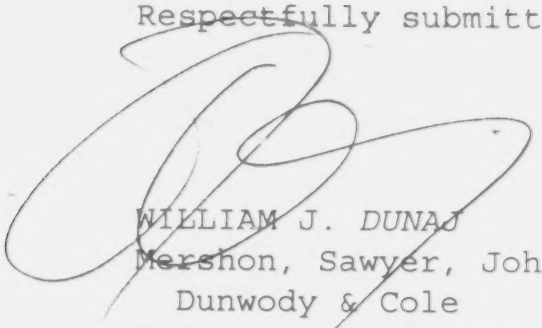

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TABLE OF CONTENTS

Page

TABLE OF CONTENTS.....i

TABLE OF AUTHORITIES.....iii

PRELIMINARY STATEMENT.....2

INTEREST OF MARTINDALE-HUBBELL AS *AMICUS CURIAE*.....2

STATEMENT OF THE CASE.....9

SUMMARY OF THE ARGUMENT.....12

ARGUMENT.....16

I. THIS COURT SHOULD RESOLVE THE IMPORTANT QUESTION OF THE PROPER STANDARD BY WHICH CREATIVITY OF WORKS OF AUTHORSHIP SHOULD BE MEASURED UNDER THE COPYRIGHT ACT 16

A. The Legislative History of the Copyright Act of 1976 Indicates that Originality is to be Measured by the Standards then Applied by the Courts.....17

B. This Court's Ruling in *Feist Publications, Inc. v. Rural Telephone Service Co.* does not provide sufficient guidance as to when a minimal degree of creativity is present.....21

C. This Court should grant *certiorari* to clarify the

TABLE OF CONTENTS

Page

requirement of creativity as stated in *Feist* as being based upon clearly defined objective standards 28

II. THE EN BANC DECISION OF THE ELEVENTH CIRCUIT BELOW IN *DONNELLEY* HAS ESTABLISHED A DEGREE OF CREATIVITY WHICH IS BOTH TOO HIGH AND IS MEASURED BY SUBJECTIVE ANALYSIS 30

III. THIS IS AN APPROPRIATE CASE FOR *CERTIORARI* SINCE THE REQUIREMENT OF CREATIVITY IS NOT LIMITED TO COMPILATIONS 35

CONCLUSION 38

TABLE OF AUTHORITIES

Cases ..... **Page**

BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc., 719 F. Supp. 1551 (S.D. Fla. 1988) ... 11, 32

BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc., 933 F.2d 952 (11th Cir. 1991) 11

BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc., 999 F. 2d 1436 (11th Cir. 1993)(en banc) *8, 33*

Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, (1903) 28, 35

Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 111 S. Ct. 1282 (1991) ..... 16, 17, 21, 22, 23, 24 ..... 25, 26, 27, 29, 34, 35

TABLE OF AUTHORITIES

Cases.....**Page**

Constitutional and Statutory Provisions

17 U.S.C. § 101.....12

17 U.S.C. § 102(a).....19, 36, 37

Other

Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law, 87th Cong., 1st Sess. 9 (Comm. Print 1961).....18

Copyright Law Revision, Pt. 3: Preliminary Draft for Revised U.S. Copyright Law and Discussions and Comments on the Draft, 88th Cong., 1st Sess. 40-41 (Comm. Print 1964).....19

Copyright Law Revision, Pt. 6: Supplementary Report of The Register of Copyrights on the General revision of the U.S. Copyright Law, 1965

TABLE OF AUTHORITIES

Cases ..... **Page**

Revision Bill, 89th Cong., 1st Sess. 3 (Comm. Print 1965) 20

A. Latman & J. Lightstone, *The Kaminstein Legislative History Project: A Compendium and Analytical Index Leading to the Copyright Act of 1976*, (1981) 20

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---

BRIEF OF MARTINDALE-HUBBELL, INC. AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER BELLSOUTH ADVERTISING & PUBLISHING CORPORATION

PRELIMINARY STATEMENT

Martindale-Hubbell, Inc. ("Martindale-Hubbell") submits this brief as *amicus curiae*, pursuant to Rule 37 of the Rules of this Court, in support of Petitioner, BellSouth Advertising & Publishing Corporation ("BAPCO").

INTEREST OF MARTINDALE-HUBBELL AS *AMICUS CURIAE*

Established in 1868, the Martindale Company issued Martindale's United States Law Directory and Martindale's American Law Directory, prior to purchasing the publishing rights to Hubbell's Legal Directory in 1930. Since 1930, Martindale-Hubbell, Inc. has created and published annually a directory of lawyers known as the Martindale-Hubbell Law Directory. This Law Directory contains, *inter alia*, a roster, as complete as possible, of

the Bar of the United States and Canada, plus listings for lawyers in the United States Pacific and Other Territories, listings for lawyers registered to practice Patent Law before the U.S. Patent and Trademark Office and to practice Canadian patent law, listings for lawyers employed by the Federal Government in Washington, D.C., and listings of international lawyers whose professional interests extend beyond their own countries. These listings appear in the Geographical Section of each volume of the Martindale-Hubbell Law Directory. For each individual attorney listed in the Martindale-Hubbell Law Directory, the data will include: year of birth, year of original bar admission, college and law school attended with degrees received from each, and firm or business affiliation or address. For professional card subscribers, the listings may include, in addition to the

firm's name and address, some or all of the following information: cable address; telephone and telex numbers; names of partners, associates or counsel; firm size and composition; fields of law in which the firm concentrates; any specialties of firm practice, if permitted in the jurisdiction where it is located; any language proficiency on the part of the firm's partners, associates or counsel; references to any branch offices the firm may have; and the names of up to ten clients and/or other references. The Biographical Section provides expanded personal data for lawyers and firms and a listing of up to 40 clients and/or references.

Martindale-Hubbell creates the Law Directory by directly contacting attorneys through mailings as well as through its field representatives, and having those attorneys complete questionnaires to provide the

information which appears in the Directory. Martindale-Hubbell also engages in a continual and elaborate effort to update the data in the Directory and to monitor the status of attorneys listed therein. Among other things, it directly communicates with state bars and/or admitting authorities in the United States and Canadian Provinces, as well as local Bar associations, and obtains lists of new attorneys, changes in Bar membership, notices of deceased attorneys, notices of discipline, suspension and reinstatements, it reviews annual Bar rosters and state and local Bar publications and it monitors attorney advertising regulations and state specialization programs.

Each volume of the Martindale-Hubbell Law Directory is published with a copyright notice in accordance with the copyright act. Martindale-Hubbell registered the copyrights

in its law directories and received certificates of registration from the Copyright Office. Martindale-Hubbell is the owner of the copyrights and the copyright registrations in the Martindale-Hubbell Law Directory.

Martindale-Hubbell presently has pending a case styled Martindale-Hubbell, Inc. v. Dunhill International List Company, Inc., United States District Court for the Southern District of Florida, Case No. 88-6767-CIV-ROETTGER. That case was brought by Martindale-Hubbell against Dunhill for, *inter alia*, infringement of Martindale-Hubbell's copyrights in the Martindale-Hubbell Law Directory. Dunhill extracted the names and addresses of lawyers from the 1981 and 1988 editions of the Martindale-Hubbell Law Directory. Dunhill then utilized this

material to assemble mailing lists of lawyers and law firms nationwide.

Dunhill employed temporary help to review the biographical section of the Martindale-Hubbell Law Directory and to extract the names, business addresses, and zip codes of attorneys working in law firms. Notations were also made of attorney age and area of specialization. This material was then encoded into Dunhill's computer to enable it to include on a given mailing list only those individuals meeting the specific criteria of its customers. Dunhill's temporary employees also examined the geographical roster section for names and addresses, taking approximately half of the copied attorney names from the geographic section and half from the biographical section. In total, Dunhill copied approximately 390,000 of the 700,000 attorney names and addresses from the 1988

edition of the Martindale-Hubbell Law Directory. Dunhill sold its mailing lists based upon the material copied from the Martindale-Hubbell Law Directory for commercial profit and gain.

Martindale-Hubbell and Dunhill filed cross-motions for summary judgment on the copyright issues. Recently, the magistrate in that case issued a "Report And Recommendation To District Judge" wherein it was found that Dunhill had not copied any original constituent elements of the Martindale-Hubbell Law Directory. The magistrate's decision was based in large part upon the Eleventh Circuit's en banc decision in *BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*, 999 F.2d 1436 (11th Cir. 1993)(the case below).

Martindale-Hubbell is interested in a proper interpretation of the copyright law

since it relies heavily on copyright protection for the Martindale-Hubbell Law Directory. If the en banc Eleventh Circuit decision below is permitted to stand, other mail list companies and other competitors will be able to copy the Martindale-Hubbell Law Directory with impunity in the Eleventh Circuit. The en banc decision may also encourage courts in other circuits to adopt the approach of the Eleventh Circuit in the case below. This will inevitably lead to confusion and a lack of clarity as to the scope of copyright protection, if any, for Martindale-Hubbell's Law Directory throughout the country. Such a result would seriously and irreparably damage Martindale-Hubbell's publishing business.

STATEMENT OF THE CASE

Petitioner, BellSouth Advertising & Publishing Corporation ("BAPCO"), is the

world's largest publisher of yellow pages classified directories. In 1984, BAPCO published the Greater Miami Yellow Pages directory. Donnelley obtained a copy of BAPCO's Miami Yellow Pages and had certain material contained therein copied into a computer database by a keying service. Donnelley stipulated that it had keyed into the computer database every listing (a listing comprises a name, address and telephone number) contained in the Miami Yellow Pages. For each listing, Donnelley also stipulated that it keyed a code for the classified heading under which the listing appeared, a code for the size of the advertisement, and a code for the directory from which the listing was keyed. Later, the code for the classified heading was translated back into the words of the corresponding heading. Therefore, when Donnelley's database was completed, it

contained every listing and its corresponding classified heading as they appeared in the Miami Yellow Pages directory. The computer database was then used by Donnelley to prepare sales lead sheets which were used by Donnelley to sell advertising in its own directory. Donnelley also used the material in the copied computer database to publish its yellow pages directories.

In October 1985, BAPCO sued Donnelley for, *inter alia*, infringement of BAPCO's registered copyrights in the Miami Yellow Pages. The district court granted BAPCO's motion for partial summary judgment on the copyright issue. *BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*, 719 F. Supp. 1551 (S.D. Fla. 1988). A three judge panel of the Eleventh Circuit affirmed the decision of the district court. *BellSouth Advertising & Publishing*

Corp. v. Donnelley Information Publishing, Inc., 933 F.2d 952 (11th Cir. 1991). The panel decision was reviewed en banc more than eighteen months later. The en banc Eleventh Circuit reversed the decision of the district court. One judge of the en banc Eleventh Circuit dissented. BAPCO filed the present Petition for *certiorari* on November 30, 1993.

SUMMARY OF THE ARGUMENT

In order for works of authorship to qualify for copyright protection, they must meet the statutory requirements of the Copyright Act of 1976. Yellow pages directories, such as those involved in the present case, qualify for copyright protection as compilations. The statute defines a compilations as follows:

> A "compilation" is a work formed by the collection and assembling of pre-existing materials or of data that are

> selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.

17 U.S.C. § 101. The term "original" has been construed by this Court to include the requirement of a minimal degree of creativity. The legislative history of the Copyright Act further indicates that no requirement of aesthetic value, novelty, or ingenuity should be applied when assessing creativity.

The en banc decision of the Eleventh Circuit below concluded that the compilation of names, addresses, telephone numbers and classified headings in BAPCO's Miami Yellow Pages was not sufficiently creative, and, therefore, not original, as a matter of law. Consequently, it was determined that the Miami Yellow Pages did not meet the requirements of

the statute and copyright protection for the compilation was denied.

However, the en banc Eleventh Circuit below erred in analyzing the creativity associated with the Miami Yellow Pages directory because it assessed creativity on a qualitative basis. It is submitted that creativity should be assessed according to an objective standard, rather than qualitatively. Qualitative analysis of creativity is contrary to the intent of the Copyright Act as reflected by the legislative history, and also contrary to other Supreme Court precedent.

The en banc Eleventh Circuit below further erred by determining the degree of creativity present in the Miami Yellow Pages by comparing it to other similar directories. In so doing, the court applied a patent law standard of novelty or obviousness. This Court has clearly stated that novelty and

obviousness are not the proper measure of creativity required for copyright protection. Therefore, the en banc Eleventh Circuit below erroneously concluded that the Miami Yellow Pages did not possess the requisite degree of creativity to qualify for copyright protection. This Court should grant the present Petition for *certiorari* in order to clarify the manner in which creativity is to be measured.

Although the issue of how to measure the proper degree of creativity required for copyright protection arises in the present case in the context of yellow pages directories, the requirement of originality, and, therefore, creativity applies to all copyrighted works of authorship. This case is therefore not fact specific, but, rather, relates to a rule of law which is applicable to copyright law generally. Accordingly, this

case is appropriate for review by this Court. For these reasons, Martindale-Hubbell submits that the Petition for certiorari should be granted.

ARGUMENT

I. THIS COURT SHOULD RESOLVE THE IMPORTANT QUESTION OF THE PROPER STANDARD BY WHICH CREATIVITY OF WORKS OF AUTHORSHIP SHOULD BE MEASURED UNDER THE COPYRIGHT ACT

In *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 111 S. Ct. 1282 (1991), this Court emphasized one aspect of compilation copyright law, but in so doing raised a number of other questions that remain unanswered. Although *Feist* emphasized the need for creativity for a work of authorship to qualify for copyright protection, it did not set any guidelines by which that level of creativity could be determined. The en banc Eleventh Circuit decision below, while ostensibly relying on

Feist, based its decision on a qualitative analysis of the level of creativity. Furthermore, that decision established a level of creativity exceeding that established by this Court in *Feist*. Martindale-Hubbell submits that this Court should grant the present Petition in order to resolve the important question in copyright law of what guidelines should be used to determine the minimal level of creativity.

A. The Legislative History of the Copyright Act of 1976 Indicates that Originality is to be Measured by the Standards then Applied by the Courts

In order for the Copyright Act to provide reliable protection for works of authorship, it should be possible to determine with some reasonable degree of certainty what works qualify for copyright protection. Such certainty cannot be achieved if copyright ability is judged on a qualitative basis. A

qualitative determination of copyright ability places the courts in the awkward position of determining whether the creative contributions of an author are sufficiently worthy to merit protection under the copyright statute. This undesirable result was specifically recognized by the legislature as the Copyright Act of 1976 was being enacted.

The Register of Copyright's 1961 report to Congress, which initiated revision of the 1909 Act, proposed that the statute hinge copyright ability on "original creative authorship." *Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law*, 87th Cong., 1st Sess. 9 (Comm. Print 1961). While this proposed standard was understood by the Register to allow the copyright "of all the classes of works now included" *(Id.)*, the proposal nevertheless drew opposition on the

ground that "the word 'creative' might possibly be understood by courts as implying a higher requirement of creativity than is required at present." *Copyright Law Revision, Pt. 3: Preliminary Draft for Revised U.S. Copyright Law and Discussions and Comments on the Draft*, 88th Cong., 1st Sess. 40-41 (Comm. Print 1964) (remarks of Mr. Goldman). *See id.* at 65 (remarks of Ms. Ringer).

The Register accordingly dropped the word "creative" from the draft legislation, offering in its place a basic provision that in substance is identical to existing Section 102(a). *Id.* at § 1(a) at 1. The Register also proposed a provision addressing the copyright ability of compilations that was identical in substance to existing Section 103 (see *Id.* at § 2, at 1-2), along with a definition of "compilation" that tracks the one in existing Section 101. *See Id.* at § 2(c), at 2.

Commenting on these proposals, the Register again explained that "our intention here is to maintain the essential standard of originality without implying any further requirement of aesthetic value, novelty, or ingenuity." *Copyright Law Revision, Pt. 6: Supplementary Report of The Register of Copyrights on the General revision of the U.S. Copyright Law, 1965 Revision Bill*, 89th Cong., 1st Sess. 3 (Comm. Print 1965). While disputes over other issues delayed passage of the Act for another decade, the language of the relevant portions of Sections 101, 102, and 103 remained unchanged. *See* A. Latman & J. Lightstone, *The Kaminstein Legislative History Project: A Compendium and Analytical Index Leading to the Copyright Act of 1976*, at 29-55, 69-81 (1981).

Thus, the drafters of the present Copyright Act understood the pitfalls presented by the concepts of aesthetic value,

novelty and ingenuity as they are applied to copyright protection. Therefore, they chose to avoid the introduction of the word "creative" within the statute, and, chose instead to rely upon the standard of originality previously applied by the courts; no additional requirement of aesthetic value, novelty or ingenuity was to be implied.

B. This Court's Ruling in *Feist Publications, Inc. v. Rural Telephone Service Co.* does not provide sufficient guidance as to when a minimal degree of creativity is present

In Feist, this Court made it clear that the standard for copyrightability is "originality." "The *sine qua non* of copyright is originality. To qualify for copyright protection, a work must be original to the author." *Feist*, 111 S. Ct. at 1287. According to the Court, "originality" is established by a two-part test: "Original, as the term is

used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity." *Id.* at 1287.

Thus, after *Feist* all copyrighted works, including compilations, are to be measured by a two-part test to determine whether they are original: (1) they must be independently created by the author, and (2) they must possess some minimal degree of creativity. If a compilation meets these two requirements (and otherwise meets the requirements of the statute), it is entitled to copyright protection.

The first element of originality is easily determined -- either a work is independently created by the author or it is not -- this is a factual determination well suited for the trier of fact. However, the

second element, *i.e.*, a minimal degree of creativity, is not so easily determined. Although *Feist* established the requirement for a minimal degree of creativity, it failed to provide any guidelines as to how to determine when that minimal level of creativity was present.

In *Feist*, this Court repeatedly stated that the amount or degree of creativity required in a copyrightable compilation is quite low. The Court said: "[T]he requisite level of creativity is *extremely low; even a slight amount will suffice*. The vast majority of works make the grade quite easily, as they possess some creative spark, 'no matter how crude, humble or obvious' it might be." *Id.* (citing M. Nimmer & D. Nimmer, Copyright § 1.08[C][1]) (1990)(emphasis added).

While not every selection, coordination, or arrangement will qualify, as is clear from

the Court's holding regarding the white page alphabetical directory in *Feist*, only minimal creativity is required for a copyrightable compilation. Consider the following key passage which contains the single most important statement about how courts are to judge the creativity component in measuring compilations:

> [T]he originality requirement is not particularly stringent. A compiler may settle upon a selection or arrangement that others have used; novelty is not required. Originality requires only that the author make the selection or arrangement independently (i.e., without copying that selection or arrangement from another work), and that it display some minimal level of creativity. Presumably, the vast majority of compilations will pass this test, but not all will. There remains a narrow category of works in which the creative

> spark is utterly lacking or so trivial as to be virtually nonexistent.

Id. at 1294.

Applying these criteria for copyright protection to the facts in *Feist*, the Court found that the alphabetical arrangement of the names, addressees, and telephone numbers of all of Rural's subscribers in its white pages directory did not meet the creativity component of the originality test. Specifically, the Court found that Rural only performed one act of selection in publishing its white pages directory -- Rural selected to publish all of its subscribers in a single directory -- but concluded that this act of selection was not creative.

> Rural's selection of listings could not be more obvious: it publishes the most basic information -- name, town, and telephone number -- about each person who applies to it

> for telephone service. This is "selection" of a sort, but it lacks the modicum of creativity necessary to transform mere selection into copyrightable expression.

Id. at 1296. The Court further found that Rural only performed one act of coordination and arrangement -- Rural arranged its listings in alphabetical order -- but, again, found that this was not creative.

> Nor can Rural claim originality in its coordination and arrangement of facts. The white pages do nothing more than list Rural's subscribers in alphabetical order. This arrangement may, technically speaking, owe its origin to Rural; no one disputes that Rural undertook the task of alphabetizing the names itself. But there is nothing remotely creative about arranging names alphabetically in a white pages directory.

Id. at 1297. Based upon the fact that Rural's only acts of selection, coordination, and arrangement were the alphabetizing of all of its subscribers, the Court found the white pages directory to lack creativity, and, therefore, originality.

Beyond the Court's instruction as to what types of selection, coordination or arrangement are not creative and, therefore, not copyrightable, *i.e.*, Rural's selection to publish all of its subscribers in a single directory and Rural's arrangement of the listings for all of its subscribers in alphabetical order, there is little guidance in *Feist* as to how one determines if a minimal degree of creativity is present in any compilation.

C. This Court should grant *certiorari* to clarify the requirement of creativity as stated in *Feist* as being based upon clearly defined objective standards

This Court should grant *certiorari* in the present case to clarify the standard by which the minimal degree of creativity required in order to render a compilation copyrightable is measured. That standard should be one which extricates the courts from the morass of conflicting decisions and forum shopping which will result if originality is measured qualitatively, as was done by the court below.

This Court long ago recognized that "[i]t would be a dangerous undertaking for persons trained only in the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239,

251 (1903) (cited in *Feist*, 111 S. Ct. at 1294). Furthermore, this Court seemed to adopt such a "narrow" standard in *Feist* when it held that the mere mechanical task of alphabetization and selection of a comprehensive pre-existing group of listings was not sufficiently creative.

It is submitted that the types of "narrow and obvious limits" which do not yield creativity are those wherein (1) the material in a compilation is arranged in alphabetical, numerical or chronological order, (2) all of the elements of a pre-existing group are selected, (3) the selection, coordination and/or arrangement of the material is dictated by the nature of the material itself or by the idea of the work, rather than by the expression of the author. These standards may be objectively determined and will not lead a court into the impossible morass of attempting

to qualitatively evaluate creativity. Any contribution by an author which goes beyond these basic mechanical ways of selecting, coordinating or arranging the material contained in a compilation should be found by the courts as meeting the minimal degree of creativity required for originality.

II. THE EN BANC DECISION OF THE ELEVENTH CIRCUIT BELOW IN *DONNELLEY* HAS ESTABLISHED A DEGREE OF CREATIVITY WHICH IS BOTH TOO HIGH AND IS MEASURED BY SUBJECTIVE ANALYSIS

The district court below concluded that "BAPCO has created a unique directory due to its method of selecting, coordinating and arranging its material." Specifically, the district court found as follows:

> BAPCO performs various acts of selection which contribute to the publication of the directory. These acts include selection of the geographical area to be

covered by a directory; selection of the number of free listings to be provided; selection of the requirement that businesses use business telephone service in order to advertise in the BAPCO directory; selection by the sales force of the heading which will be recommended to a customer; selection of the classified headings which will be available for a particular directory; selection of the headings under which an advertiser's listing will appear; selection of the criteria under which advertisers may or may not be permitted to advertise under headings not related to their business; selection of the number of free listings to be provided telephone subscribers; selection of customers who will be contacted by premise sales, telephone sales personnel and no contact; and selection of the date of closing the directory. [Citation omitted].

BAPCO also engages in acts of coordination and arrangement which aid

> (sic., add) to the Yellow Pages publication. BAPCO coordinated headings. In addition, BAPCO arranged these headings, along with all of the listings under a particular heading, in alphabetical order. BAPCO chose to coordinate and arrange its directory in this manner from other alternatives. For example, BAPCO could have chosen to arrange its headings according to the number of advertisers or to arrange its listings under headings according to which listing had been advertising under that heading for the longest period of time.
>
> Donnelley does not dispute that BAPCO performs these acts. The dispute centers only on the legal effect of such acts.

BAPCO v. Donnelley, 719 F. Supp. at 1557-58. The panel opinion below affirmed this district court decision.

After rehearing en banc, the Eleventh Circuit overturned the unanimous panel

opinion. The majority rejected the district court's conclusion that BAPCO showed originality in selecting the scope for its directory, noting that every compilation "will by necessity have * * *, where applicable, a geographic limit selected by the compiler." *BAPCO v. Donnelley*, 999 F.2d at 1441. The majority also concluded that the various acts of selection that the district court and panel had found to be original were "not acts of authorship, but techniques for the discovery of facts." *Id.* The en banc Eleventh Circuit also ruled that BAPCO's coordination and arrangement of the particular listings under its selected headings failed to exhibit the requisite degree of creativity, because this general structure "did not deviate from the arrangement of the typical business directory." *Id.* at 1442n.13. The court further found that the selection of particular

headings did not constitute original expression warranting copyright protection." *Id.* at 1444.

The decision of the en banc Eleventh Circuit below sets a dangerous precedent for measuring creativity by comparing the work in question with other works of the same type. Such an analysis establishes a level of creativity corresponding to the novelty or obviousness standards of patent law. As this Court explicitly stated in *Feist*, novelty and obviousness are not the proper standard by which creativity should be measured. *Feist*, 111 S. Ct. at 1287.

Moreover, the foregoing demonstrates the importance of adhering to this Court's holding that the requisite level of creativity is "extremely low." *Feist*, 111 S. Ct. at 1287. Any other standard would require courts to make difficult -- indeed, impossible --

judgments about the relative value of various creative decisions. The majority below established a qualitative standard of creativity and its decision thus threatens to entangle the court in qualitative evaluations of creative worth.

The en banc decision of the Eleventh Circuit below is therefore in conflict with the Copyright Act of 1976 and with this Court's holdings in *Bleistein* and *Feist*. Accordingly, this Court should grant *certiorari* in this case.

III. THIS IS AN APPROPRIATE CASE FOR *CERTIORARI* SINCE THE REQUIREMENT OF CREATIVITY IS NOT LIMITED TO COMPILATIONS

The present case arises in the specific context of a yellow pages directory. Such works are treated as compilations under the copyright law. However, the requirement for

originality, and, thus, creativity, extends throughout the entire field of copyright. The Copyright Act defines the subject matter which qualifies for copyright protection as follows:

> Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:
>
> (1) literary works;
> (2) musical works, including any accompanying words;
> (3) dramatic works, including any accompanying music;
> (4) pantomimes and choreographic works;
> (5) pictorial, graphic, and sculptural works;

> (6) motion pictures and other audiovisual works;
> (7) sound recordings; and
> (8) architectural works.

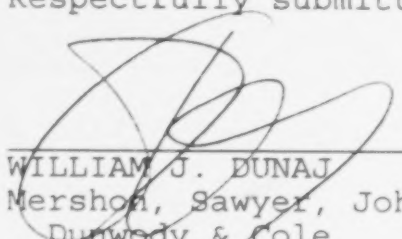
17 U.S.C. § 102(a)(emphasis added).

From this statute, it is clear that the requirement for originality applies to all types of copyrighted works; not merely compilations. Clarification as to how the minimal degree of creativity should be determined is an issue of importance to copyright law in general. Therefore, the present case is an excellent vehicle by which the Court clarify this important aspect of copyright law.

CONCLUSION

For the foregoing reasons, the Petition of BellSouth Advertising & Publishing Corporation should be granted.

Respectfully submitted,



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CERTIFICATE OF SERVICE

We hereby certify that a true and correct copy of the printed version of the foregoing Motion for Leave to File Brief Amicus Curiae and Brief of Martindale-Hubbell, Inc. In Support of Petitioner BellSouth Advertising & Publishing Corporation has been forwarded to the Clerk of the United States Supreme Court via Federal Express Overnight Mail, and served, via Federal Express Overnight Mail, on Theodore C. Whitehouse, Esq., Willkie Farr & Gallaher, Three Lafayette Centre, 1155 21st Street, N.W., Suite 600, Washington, D.C. 20036-3302, this 6th day of January, 1994.

William J. Dunaj

FILED
DEC 28 1993

(5)

No. 93-862

In the

Supreme Court of the United States

October Term, 1993

BELLSOUTH ADVERTISING AND PUBLISHING CORPORATION,

Petitioner,

v.

DONNELLEY INFORMATION PUBLISHING, INC., and THE REUBEN H. DONNELLEY CORPORATION,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

MOTION FOR LEAVE TO FILE BRIEF AND BRIEF OF WEST PUBLISHING COMPANY AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER BELLSOUTH'S PETITION FOR A WRIT OF CERTIORARI

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In the
Supreme Court of the United States
October Term, 1993

No. 93-862

Bellsouth Advertising And Publishing Corporation,
Petitioner,

v.

Donnelley Information Publishing, Inc., and
The Reuben H. Donnelley Corporation,
Respondents,

On Petition for Writ of Certiorari to the
United States Court of Appeals
for the Eleventh Circuit

MOTION OF WEST PUBLISHING COMPANY FOR LEAVE TO FILE A BRIEF IN SUPPORT OF PETITION OF BELLSOUTH ADVERTISING AND PUBLISHING CORPORATION FOR A WRIT OF CERTIORARI

West Publishing Company respectfully moves for leave to file the accompanying brief Amicus Curiae pursuant to Rule 37.4 of the Supreme Court Rules. Petitioner granted West written permission to serve an Amicus brief, but respondents denied West's request for permission, necessitating this motion.

Interest of Amicus Curiae

West is the leading American publisher of law-related compilations and has over 100 years experience preparing copyrighted compilations and protecting those compilations from infringement. West recently introduced West's Legal Directory, a WESTLAW database service that contains profiles of attorneys and law firms. Like BAPCO, West has selected and arranged the information in West's Legal Directory in a wide and creatively conceived variety of categories, including not only name and geographic location, but also size of firm, practice specialties, practice concentrations, representative clients and professional affiliations.

The Basis For West's Motion

West seeks leave to file an Amicus brief to highlight the need for this Court to grant certiorari in order to preserve the efficacy of this Court's recent decision in Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 111 S.Ct. 1282 (1991) ("Feist"). The decision below is inconsistent with Feist and, if it is allowed to stand, will undercut this Court's guidance in an important area of copyright law.

Indeed, while BAPCO fully discusses the direct conflict among the circuits created by the decision below, and the potential effect of that decision on "yellow pages" directory publishers, West focuses its Amicus brief on the widespread application of Feist in non-telephone directory cases.

A WESTLAW search reveals that the lower federal courts already have cited Feist at least 49 times, but that very few of those cases involved directories of any kind. The great majority of opinions in which Feist was cited involve

compilations that have nothing to do with telephone listings.[1] It is impossible to overstate the importance of Feist to every compilation publisher, and the need these publishers have for clear guidance from Feist.

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[1] See, e.g., Arica Institute, Inc. v. Palmer, 970 F.2d 1067, 1076 (2nd Cir. 1992) (sequence of labels in self-help training materials); Kregos v. Associated Press, 937 F.2d 700, 704 (2nd Cir. 1991) (baseball pitching form); Victor Lalli Enters. v. Big Red Apple, Inc., 936 F.2d 671, 673 (2nd Cir. 1991) (chart of winning numbers); Atari Games Corp. v. Oman, 979 F.2d 242, 245, 247 (D.C. Cir. 1992) (video game); Mason v. Montgomery Data, Inc., 967 F.2d 135, 141 (5th Cir. 1992) (real estate ownership maps); Schiller & Schmidt, Inc. v. Nordisco Corp., 969 F.2d 410, 413 (7th Cir. 1992) (business supply catalog); Financial Control Assocs. v. Equity Builders, 799 F.Supp. 1103, 1119 (D.Kan. 1992) (mortgage prepayment booklet); Budish v. Gordon, 784 F.Supp. 1320, 1333 (N.D. Ohio 1992) (tables of information on Medicaid); Khandji v. Keystone Resorts Management, Inc., 140 F.R.D. 697, 700 (D.Colo. 1992) (legal settlement brochure); Sem-Torq v. K Mart Corp., 936 F.2d 851 (6th Cir. 1991) (set of double-sided signs); Penelope v. Brown, 792 F.Supp. 132, 135, 139 (D.Mass. 1992) (compilation of English grammatical rules); Corsearch, Inc. v. Thomson & Thomson, 792 F. Supp. 305 (S.D.N.Y. 1992) (state trademark data); Lipton v. The Nature Co., 781 F.Supp. 1032, 1034 (S.D.N.Y. 1992) (Middle English "terms of venery").

Conclusion

Accordingly, West's Amicus brief is of value to the Court in weighing, in the broader context of all fact-based compilations, the reasons why it should grant certiorari in the case below. Therefore, West requests this Court grant West's motion and consider the following reasons set forth by West for granting BAPCO's petition.

Dated: December 28, 1993

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TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES ii

PRELIMINARY STATEMENT 1

INTEREST OF AMICUS CURIAE 2

SUMMARY OF ARGUMENT 3

ARGUMENT 4

I. THE CONFLICT BETWEEN THE CIRCUITS AS A RESULT OF THE DECISION BELOW WILL INHIBIT THE CREATION OF NEW AND USEFUL FACTUAL COMPILATIONS 4

II. THE DECISION BELOW PROVIDES THIS COURT WITH AN APPROPRIATE AND NECESSARY OPPORTUNITY TO CLARIFY THE SCOPE OF FEIST 8

CONCLUSION 11

TABLE OF AUTHORITIES

CASES Page

Basic Books, Inc. v. Kinko's Graphics Corp., 758 F. Supp. 1522 (S.D.N.Y. 1991) 10

Central Telephone Company of Virginia v. Johnson Publishing Co., Inc., 526 F. Supp. 838 (D. Colo. 1981) 4

Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 111 S.Ct. 1282 (1991) 3, 4, 6, 7, 8, 9

H.J. Inc. v. Northwestern Bell Telephone Co., 429 U.S. 229, 109 S.Ct. 2893, 2899 (1989) 10

Harper & Row, Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 105 S.Ct. 2218 (1985) 9, 10

J.R. O'Dwyer Company, Inc. v. Media Marketing International, Inc., 755 F. Supp. 599 (S.D.N.Y. 1991) 4

Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc., 945 F.2d 509 (2nd Cir. 1991) 4, 5, 6

Northwestern Bell Telephone Co. v. Bedco of Minnesota, Inc., 501 F. Supp. 299 (D. Minn. 1980) 4

Sedima, S.P.R.L. v. Imrex Co., 473 U.S. 479, 493, 497, 105 S.Ct. 3275, 3283, 3285 (1985) 10

Sony Corporation of America v. Universal City Studios, 464 U.S. 417, 104 S.Ct. 774 (1984) 9, 10

Southern Bell Telephone & Telegraph Co. v. Associated Directory Publishers, 756 F.2d 801 (11th Cir. 1985) 4

Southwestern Bell Media, Inc. v. Trans Western Publishing, Inc., 670 F. Supp. 899 (D. Kan. 1987) 4

STATUTES

Racketeer Influenced and Corrupt Organizations Act, 18 U.S.C. §§1961-1968 10

In the
Supreme Court of the United States
October Term, 1993

No. 93-862

Bellsouth Advertising And Publishing Corporation,
Petitioner,

v.

Donnelley Information Publishing, Inc., and
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Respondents,

On Petition for Writ of Certiorari to the
United States Court of Appeals
for the Eleventh Circuit

BRIEF OF WEST PUBLISHING COMPANY AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER BELLSOUTH ADVERTISING AND PUBLISHING CORPORATION'S PETITION FOR A WRIT OF CERTIORARI

PRELIMINARY STATEMENT

West Publishing Company ("West") submits this brief as Amicus Curiae in support of Petitioner Bellsouth Advertising & Publishing Corporation ("BAPCO"), pursuant to Rule 37 of the Supreme Court Rules.

INTEREST OF AMICUS CURIAE

West is the leading American publisher of law-related compilations and has over 100 years experience preparing copyrighted compilations and protecting those compilations from infringement. West recently introduced West's Legal Directory, a WESTLAW database service that contains profiles of attorneys and law firms. Like BAPCO, West has selected and arranged the information in West's Legal Directory in a wide and creatively conceived variety of categories, including not only name and geographic location, but also size of firm, practice specialties, practice concentrations, representative clients and professional affiliations.

SUMMARY OF ARGUMENT

In Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 111 S.Ct. 1282 (1991), this Court spoke in the clearest possible terms of the "minimal" level of creativity required to qualify a compilation for copyright protection, noting that, "choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimum degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws." 111 S. Ct. at 1289. At least four different times in Feist, this Court emphasized this minimal quantum of originality required for copyright protection.[2] Despite this repeated emphasis, the Eleventh Circuit found that a classified directory representing substantial intellectual judgment, in both the selection of the business categories included in the directory and in the distribution of listing or entries among the selected categories, was not sufficiently original to merit copyright protection. Feist's mantra of "minimal creativity" obviously fell on deaf ears in the Eleventh Circuit.

The decision below not only misconstrues Feist, but this misapplication may substantially chill the creation and publication of a wide variety of compilations. If not corrected by this Court, the decision below may alter longstanding, fundamental principles of copyright law upon which West and many other publishers have relied in creating products. Further, the conflict between the circuits caused by the decision below will pose enormous hardships upon publishers of compilations that are distributed nationwide.

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[2] "To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice." 111 S.Ct. at 1287; "[A] minimum degree of creativity" is sufficient. Id. at 1289; "[T]he originality requirement is not particularly stringent." Id. at 1294.; "[O]riginality is not a stringent standard" Id. at 1296.

ARGUMENT

I. THE CONFLICT BETWEEN THE CIRCUITS AS A RESULT OF THE DECISION BELOW WILL INHIBIT THE CREATION OF NEW AND USEFUL FACTUAL COMPILATIONS

As BAPCO notes in its petition, there is a direct conflict between the decision below and the decision of the Court of Appeals for the Second Circuit in Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc., 945 F.2d 509 (2nd Cir. 1991) ("Key Publications"). The decision below also contradicts every decision on the protectibility of "yellow pages" and other classified directories rendered before Feist.[3]

This conflict is intolerable for three principal reasons: (1) the nationwide distribution of many factual compilations renders a circuit conflict particularly onerous; (2) the recency and parity of the decision below and Key Publications will cause great uncertainty in the law and great difficulty for the lower federal courts; and (3) the extreme importance of Feist in determining compilation copyright issues necessitates that its guidance to the lower federal courts not be muddied by conflicting lower court interpretations.

First, the conflict introduced by the decision below will make it difficult for publishers of nationwide directories to distribute their works. Given the current conflict, it is

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[3] See Southern Bell Telephone & Telegraph Co. v. Associated Directory Publishers, 756 F.2d 801 (11th Cir. 1985); J.R. O'Dwyer Company, Inc. v. Media Marketing International, Inc., 755 F. Supp. 599 (S.D.N.Y. 1991) (directory of public relations firms); Southwestern Bell Media, Inc. v. Trans Western Publishing, Inc., 670 F. Supp. 899 (D. Kan. 1987); Northwestern Bell Telephone Co. v. Bedco of Minnesota, Inc., 501 F. Supp. 299 (D. Minn. 1980); Central Telephone Company of Virginia v. Johnson Publishing Co., Inc., 526 F. Supp. 838 (D. Colo. 1981).

apparent that equivalent levels of selection, coordination and arrangement of data contained in nationally distributed directories will receive widely disparate copyright protection in the Second and Eleventh Circuits.[4] The specter of such uneven protection will inhibit the creation of classified-type directories and other types of compilations for the national market, or will, at the very least, inhibit distribution of such directories and compilations within the Eleventh Circuit.

A comparison of the editorial decisions undertaken by the BAPCO and Key Publications compilers shows that there is no way to reconcile the different results of the two cases. For example, both the Plaintiff in Key Publications and BAPCO sought to exclude from their classified directory businesses which they did not think would remain in operation. Key Publications, 945 F.2d at 513; Pet. Br. at 3-4. Similarly, both the Plaintiff in Key Publications and BAPCO included in their directories classified category headings which were often used in competing directories and included category headings which were not generally found in other classified directories. Key Publications at 514; Pet. Br. at 5, 18. Further, the Plaintiff in Key Publications selected and arranged its 9,000 business listings among approximately 260 different categories selected by it, while BAPCO selected and arranged its 106,398 listings among the 3,795 different classified headings selected by it. Key Publications at 514; Pet. Br. at 10.

Publishers are thus faced with two cases involving identical editorial decisions that cannot be distinguished. Indeed, it appears from the record that BAPCO made considerably more subjective editorial decisions in selecting, coordinating and arranging the data in its directory than did

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[4]For example, under the current state of the law, the West's Legal Directory database conceivably could be subject to different levels of copyright protection depending on whether it is accessed from New York or Atlanta.

the Plaintiff in Key Publications, yet the Eleventh Circuit held BAPCO's editorial decisions to be insufficiently creative.

A second reason the conflict generated by the decision below is intolerable is that both of the conflicting decisions are of recent post-Feist origin, with each ostensibly carrying full weight as precedential authority in this area. There exists no guidance for the district courts in determining which of these competing decisions to follow: one decision is by a Court of Appeals acknowledged to be a leader and guide in the area of copyright law, while the other is an en banc decision. The decisions in both cases were reached through application of this Court's most recent decision in this area, Feist, so there is no basis to distinguish the decisions on that grounds. In short, there is no principled means by which the lower federal courts can decide which of these conflicting decisions to follow. Absent resolution of the conflict by this Court, compilation publishers will face great and unacceptable uncertainty as to whether the selection, coordination and arrangement of data contained in their publications will be protected by copyright.

Finally, the conflict is intolerable because it will dilute and diminish the guidance of Feist, this Court's first decision construing the copyright protection afforded "compilations" under current copyright law.

Feist emphasizes again and again that compilations are not fundamentally different from other types of works. Indeed, the basic holding of Feist is that compilations are subject to the same requirement of originality that is applicable to other works. Thus, the discussion of originality in Feist is properly understood as governing the standard of copyrightability that must be met, not just by compilations, but by all works seeking copyright protection. Since Feist is the only recent exposition of the originality requirement by this Court, virtually every decision on copyrightability now ultimately turns on the Feist opinion. Any substantial misreading of Feist, such as the decision below, therefore, threatens to

distort the entire framework of copyright law.

The decision below is not merely an example of the inevitable differences of opinion that arise in the application of a subjective standard. The en banc decision of the Eleventh Circuit seriously misinterprets the governing legal standard.

In describing the plaintiff's "white pages" directory in Feist, this Court referred to it as "entirely typical," and as "a garden-variety white pages directory." 111 S. Ct. at 1296. The court below elevated these purely descriptive references to a legal standard of originality.

> While the listings in BAPCO's yellow pages required somewhat more organization and arrangement than the white pages directory considered in Feist, BAPCO's claim of originality must be resolved by comparison to other business telephone directories. BAPCO did not deviate from the arrangement of the typical business directory, which employs an alphabetical list of headings to describe various types of business and then alphabetizes the listing under the appropriate headings.

Pet. App. at 9a n.13.

The application of the originality standard in Feist, however, rests on the Court's assessment of the quality of intellectual contribution embodied in the creation of the plaintiff's compilation, not on a comparison with other works. Indeed, this Court emphasized repeatedly in Feist that the patent-like novelty requirement employed by the court below was not part of the originality standard. "Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying." 111 S. Ct. at 1287; "A compiler may settle upon a selection or arrangement that others have used; novelty is not required." Id. at 1294; "[O]riginality . . .

does not require that facts be presented in an innovative or surprising way." Id. at 1296.

Thus, whereas this Court merely described the compilation being evaluated in Feist as "typical", the Eleventh Circuit has given independent substantive significance to the comparison with other compilations -- a significance that is directly at odds with this Court's own articulation of the applicable legal standard in Feist. Judge Hatchett, in his dissent below, recognized the majority's misreading of Feist: "In reasoning that BAPCO's selection of headings lack originality because many resemble NYPSA headings, the majority completely ignores the Feist Court's holding that an independent selection of data need not be "novel" in order to be deemed original," Pet. App. at 25a n.2.

The misinterpretation of Feist in the en banc decision below threatens to undermine the critical distinction between the standards of novelty and nonobviousness traditionally applicable to the grant of a patent and the much less stringent requirement of originality that is the governing standard of copyrightability.

For the above reasons, this conflict between the Second and Eleventh Circuits is not a "manageable" one; it is a crucial, intolerable conflict that will hamper the operations and business decisions of the nation's compilation publishers. Therefore, this conflict should be resolved by this Court granting BAPCO's petition and reversing the decision below.

II. THE DECISION BELOW PROVIDES THIS COURT WITH AN APPROPRIATE AND NECESSARY OPPORTUNITY TO CLARIFY THE SCOPE OF FEIST.

The decision below provides this Court with an appropriate opportunity to clarify Feist. That opportunity is all the more valuable because the discussion of compilation

copyrights in Feist was necessarily limited by the factual record in that case, i.e., "a garden variety white pages directory, devoid of even the slightest trace of creativity." Feist, 111 S.Ct. at 1296. The decision below, in contrast, involves a much more expansive factual record upon which to provide firmer guidance as to what constitutes the minimal creativity necessary for a compilation to be protected by copyright.[5] This Court stated in Feist that the "vast majority" of compilations will be sufficiently creative to be entitled to copyright protection. 111 S. Ct. at 1294. However, that statement may no longer be true if the Court allows the decision below to stand.

An important decision by this Court, such as Feist, in an area of law it has not previously addressed, often requires a subsequent, "bookend" decision to establish the parameters of the initial decision. For example, in Sony Corporation of America v. Universal City Studios, 464 U.S. 417, 104 S.Ct. 774 (1984) ("Sony"), the Court, for the first time, addressed the 1976 Copyright Act's "fair use" defense, holding that the taping of broadcast television programs for purposes of "time-shifting" was a fair use of the copyrighted works.

A year later, the Court accepted for review, and reversed, the Second Circuit's decision that a magazine's unauthorized publication of quotes from President Ford's memoirs was a "fair use" of the copyrighted book. Harper & Row, Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 105 S.Ct. 2218 (1985) ("Harper & Row"). Harper & Row provided the

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[5] In Feist, the compiler's selection of persons for inclusion in its directory was nothing more than its telephone-service subscriber list. Here, both parties agree that BAPCO included listings of businesses in its directory that were outside the geographic limits of BAPCO's corresponding white pages directory while also restricting the directory to companies with business telephone service. BAPCO also solicited selected national advertisers for inclusion in its yellow pages directory. See Pet. App. at 8a-10a.

Court with the opportunity to expand upon its fair use discussion in Sony by focusing on the different factual elements existing in the Harper & Row case. The result was a pair of fair use decisions that reached different results, but that have served together to settle much of the uncertainty over application of the fair use defense to a wide range of copyright infringement situations.[6]

Similarly, the decision below provides the Court with an opportunity to again provide bookends to a thorny area of copyright law -- the question of the level of creativity needed for a compilation to obtain copyright protection.[7] By taking this case, and reversing the Eleventh Circuit, this Court will give lower federal courts a substantial degree of certainty as they face future disputes involving the quantum of originality necessary to support a compilation copyright and the scope of protection accorded such a compilation.

In so ruling, this Court will have set forth and discussed

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[6]Thus, it is not surprising that a WESTLAW search of copyright cases decided subsequent to Sony and Harper & Row uncovered 63 reported decisions in which the two cases were discussed in tandem in evaluating an asserted fair use defense. For example, extensive use of the fair use analysis of both Sony and Harper & Row was made in the highly publicized fair use decision in Basic Books, Inc. v. Kinko's Graphics Corp., 758 F. Supp. 1522 (S.D.N.Y. 1991).

[7]This necessity to clarify an initial decision with cases presenting different sets of facts is a common occurrence. Another example occurred with the Court's interpretation of the Racketeer Influenced and Corrupt Organizations Act ("RICO"), 18 U.S.C. §§1961-1968. In 1985, the Court first addressed the "pattern of racketeering" element of a RICO offense. Sedima, S.P.R.L. v. Imrex Co., 473 U.S. 479, 493, 497, 105 S.Ct. 3275, 3283, 3285 (1985). Four years later, the Court again addressed the "pattern" issue, recognizing "the plethora of different views expressed by the Court of Appeals since Sedima demonstrates . . . developing a meaningful concept of 'pattern' has proved to be no easy task." H.J. Inc. v. Northwestern Bell Telephone Co., 429 U.S. 229, 109 S.Ct. 2893, 2899 (1989).

both an example of a compilation not sufficiently original to warrant copyright protection (a "garden variety white pages") and contrasted that compilation with one sufficiently original to warrant protection. Such a ruling would provide clear guidance to the lower federal courts by enabling them, in effect, to determine whether the compilation before them is more like a "white pages" or a "yellow pages" directory.

CONCLUSION

For the reasons set forth above, West submits that the Court should grant BAPCO's petition and reverse the decision below.

Dated: December 28, 1993

Respectfully submitted,

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No. 93-862

In The

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October Term, 1993

BELLSOUTH ADVERTISING & PUBLISHING CORPORATION,

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Respondents.

On Petition For A *Writ of Certiorari*
To The United States Court Of Appeals
For The Eleventh Circuit

MOTION AND BRIEF *AMICUS CURIAE* OF SPRINT PUBLISHING & ADVERTISING, INC. IN SUPPORT OF PETITIONER

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No. 93-862

In The

Supreme Court of the United States

October Term, 1993

BELLSOUTH ADVERTISING & PUBLISHING CORPORATION,

Petitioner,

vs.

DONNELLEY INFORMATION PUBLISHING, INC. and THE REUBEN H. DONNELLEY CORPORATION,

Respondents.

On Petition For A *Writ of Certiorari*
To The United States Court Of Appeals
For The Eleventh Circuit

MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE* ON BEHALF OF SPRINT PUBLISHING & ADVERTISING, INC.

COMES NOW, Sprint Publishing & Advertising, Inc. and respectfully petitions this Honorable Court for leave to file the annexed brief *amicus curiae* pursuant to Rule 37.4. Sprint Publishing & Advertising, Inc. (SPA) has requested consent from all parties for the filing of a brief *amicus curiae,* but has received only the consent of the Petitioner, a copy of which has been filed with this Court. In support of this motion, SPA states:

SPA is a Kansas Corporation.[1] SPA is engaged in the business of publishing classified telephone directories, commonly known as the "Yellow Pages". SPA currently publishes 278 separate classified telephone directories with a total circulation of approximately 12,000,000 copies each year. In excess of fifty of these directories are published independently of local telephone companies. The remainder of the SPA directories are published for telephone companies furnishing utility telephone services to specific operating territories. SPA distributes Yellow Pages directories in twenty states spread over a wide geographic area throughout the United States. SPA is thus in a unique position with respect to others in the industry who are typically either only an "independent" or a "utility" publisher, or who concentrate their activities in only a particular geographic area.

---

[1] SPA is a wholly owned subsidiary of DirectoriesAmerica, Inc., a Kansas corporation, which is in turn a wholly owned subsidiary of Sprint Corporation, a Kansas corporation.

SPA has historically regarded its Yellow Pages directories as protected by the copyright laws and thus protected from appropriation by others. Substantial creative effort is expended in formulating, compiling and publishing the Yellow Pages, and it is the selection and arrangement of the content of the SPA classified directories that give them value to the user.

Because SPA publishes its directories for distribution in twenty states over dispersed areas, SPA regards the *en banc* opinion as particularly disturbing. Because of the tension created between the different interpretations of this Court's precedent by the Second and Eleventh Circuits, and the underlying implications not only for the Yellow Pages but for all other compilations of information, SPA and other publishers must follow the copyright laws differently according to geography. A Yellow Pages directory published in Florida will receive less protection than a corresponding directory published in, for example, New York.

Further, SPA must now speculate whether other jurisdictions in which it publishes or seeks to publish directories will follow the Second Circuit or the Eleventh Circuit in determining copyright protection for Yellow Pages compilations. The problems created by this split include evaluating whether to protect existing copyrights and to what extent it may use the compilations of others in creating new directories. SPA has previously sought to enforce the copyright in its Yellow Pages directory, only

to be confronted with the decision below which essentially eliminates any protection for the underlying compilation in its Yellow Pages.

The interests of SPA thus transcend those of the parties in that it sees the controversy presented from the perspective of a publisher of directories akin to both Petitioner and Respondent. While Petitioner may advance the views typically held by the utility publisher and Respondent will espouse the views of the independent publisher, it is unlikely that either Petitioner or Respondent will present arguments for balancing the concerns for originality, with proper access to information, best represented by SPA which must do both with consistency. If SPA is not permitted to file a brief *amicus curiae* this perspective will be unaddressed.

Respectfully submitted,

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December 1993

TABLE OF CONTENTS

Page

INTERESTS OF *AMICUS CURIAE* 2

REASONS FOR GRANTING THE *WRIT* 3

I. The Decision Below Creates an Untenable Tension in the Circuits for Yellow Pages Publishers 4

II. The Decision Below Conflicts with this Court's Precedent in *Feist* 7

III. The Decision Below Conflicts with the Decisions in Other Circuits Regarding the Constitutional Standard of Originality 9

CONCLUSION 11

TABLE OF AUTHORITIES

Page

CASES—

Atari Games Corp. v. Oman, 979 F.2d 242 (D.C. Cir. 1992) 6, 9

Bellsouth Advertising & Publishing Corporation v. Donnelley Information Publishing, Inc., 719 F.Supp. 1551 (S.D. Fla. 1988), *aff'd*, 933 F.2d 952 (11th Cir. 1991), *vacated and reh'g en banc granted*, 977 F.2d 1435 (11th Cir. 1992), *rev'd*, 999 F.2d 1436 (11th Cir. 1993) (en banc) 5

Feist Publications, Inc. v. Rural Telephone Service Co., Inc., 499 U.S. 340, 111 S.Ct. 1282 (1991) ...4, 7, 9, 10, 11

Key Publications v. Chinatown Today Publishing Enterprises, Inc., 945 F.2d 509 (2nd Cir. 1991) .. 4, 5, 9

Los Angeles News Service v. Tullo, 973 F.2d 791 (9th Cir. 1992) 10

Mason v. Montgomery Data, Inc., 967 F.2d 135 (5th Cir. 1992) 10

STATUTORY PROVISIONS

Copyright Act, 17 U.S.C. § 101 5

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Respondents.

On Petition For A *Writ of Certiorari*
To The United States Court Of Appeals
For The Eleventh Circuit

BRIEF *AMICUS CURIAE* OF SPRINT PUBLISHING & ADVERTISING, INC. IN SUPPORT OF PETITIONER

Sprint Publishing & Advertising, Inc. (SPA) respectfully submits this brief *amicus curiae* in support of BellSouth Advertising & Publishing Corporation, the Petitioner for *certiorari*, whose consent has been provided to the Clerk of the Court under separate cover. Respondents have declined to give consent and therefore a Motion for Leave to File Brief Amicus Curiae is provided herewith.

INTERESTS OF *AMICUS CURIAE*

Sprint Publishing & Advertising, Inc. is a Kansas corporation engaged in the business of publishing classified telephone directories, known throughout the United States as the "Yellow Pages". SPA publishes 278 separate editions of its Yellow Pages directory with a total circulation of approximately 12,000,000 copies published and distributed each year. It publishes these Yellow Page directories in 20 states dispersed over a wide geographic area throughout the United States. SPA publishes directories in conjunction with the telephone utilities in many geographic areas, and also publishes over fifty independent Yellow Page directories.

SPA devotes considerable creative effort in producing directories which it believes are significant, useful and original compilations of information. In order to make each directory useful to both advertisers and consumers, considerable creative effort is devoted to the selection, arrangement and coordination of individual listings under appropriate headings for each directory.

The impact of the *en banc* decision below is particularly disturbing to SPA. By permitting the copying of Yellow Pages directories, other publishers no longer need to devote the substantial creative energies required to produce an independent Yellow Pages compilation. Instead, it is far easier to merely appropriate the arrangement, selection and coordination of an existing compilation of information. In fact, it is only the selection, arrangement and coordination which is appropriated, as

the raw listing data is already available from the White Pages or other alternative sources.

Given the contrary interpretation of this Court's precedents by other circuits, SPA must now operate under great uncertainty as to the protectability of its compilations, depending on the area of publication. If the present decision is permitted to stand, the protectability of Yellow Pages compilations will be determined according to their geographic origin, and SPA and others will face tremendous uncertainty in how to proceed with creating new directories and protecting existing directories.

REASONS FOR GRANTING THE WRIT

Unless resolved by a grant of *certiorari*, the decision below, in the words of the dissenting opinion, "transforms the classified publishing industry from a business requiring the production of a useful directory based on multiple layers of creative decisionmaking, into a business requiring no more than a successful race to a data processing agency to copy another publisher's copyrighted work-product." SPA is among those publishers which has already encountered this type of competition, which often results in inferior works necessarily based on the compilation set forth in Yellow Pages directories previously published and distributed by SPA.

The decision below places classified directory publishers in the untenable position of deciding whether to follow the Second Circuit or the diametrically opposed decision of the Eleventh Circuit regarding classified directories. Each of these two Circuits has read this

Court's ruling on the constitutionally-imposed threshold standard of "originality" regarding Yellow Page compilations differently. Moreover, the decisions in other Circuits which have applied this Court's decision in *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 111 S.Ct. 1282 (1991) to the protectability of compilations have diverged substantially from the views expressed in the *en banc* decision below. Thus, in light of the exceptional importance of this decision to not only directory publishers but to others seeking copyright protection for compilations, and given the constitutional foundation of the issue, it is critical that this Honorable Court grant *certiorari*.

I. THE DECISION BELOW CREATES AN UNTENABLE TENSION IN THE CIRCUITS FOR YELLOW PAGES PUBLISHERS

A direct and unreconciled conflict exists between the decision below and the decision in *Key Publications v. Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2nd Cir. 1991) over the interpretation of this Court's decision in *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340 (1991). Resolution of the question presented by the Petitioner will do more than resolve an academic question regarding the standard of originality necessary for protection under the Copyright Act by aiding SPA and others who must publish directories in multiple areas throughout the United States.

While some Yellow Pages publishers may distribute their directories in a relatively confined geographic territory, SPA and many others must now endeavor to apply

the Copyright Act, 17 U.S.C. § 101 et seq. on a Circuit-by-Circuit basis. The entire process of publishing a Yellow Pages directory in a new territory must now include a guess as to whether the decision below or that of the Second Circuit in *Key Publications v. Chinatown Today Publishing Enterprises*, 948 F.2d 509 (2nd Cir. 1991) will be applied.

Key Publications considered the question of copyrightability of a classified telephone directory using the *Feist* decision as a template. In applying the language of 17 U.S.C. § 101, it used three tests to evaluate the originality of the classified directory: "(1) the collection and assembly of preexisting data; (2) the selection, coordination or arrangement of that data; and (3) a resulting work that is original, by virtue of the selection, coordination or arrangement of the data contained in the work." *Key Publications*, 945 F.2d at 512. It found that the classified telephone directory under consideration satisfied each of those tests.

The underlying decision of the District Court also found that the Yellow Pages directory was protectable as a compilation. Following earlier precedent in the Circuit regarding copyrightability of Yellow Pages directories, the District Court also found that "because BAPCO has created a unique directory due to its method of selecting, coordinating and arranging its material, the Court concludes that BAPCO's compilation is an original work of authorship which is subject to a valid copyright." *Bellsouth Advertising & Publishing Corporation v. Donnelley Information Publishing, Inc.*, 719 F.Supp. 1551, 1557 (S.D. Fla. 1988), *aff'd*, 933 F.2d 952 (11th Cir. 1991), *vacated and*

reh'g en banc granted, 977 F.2d 1435 (11th Cir. 1992), *rev'd*, 999 F.2d 1436 (11th Cir. 1993) (en banc).

But the *en banc* holding herein concluded that the elements of selection, coordination and arrangement identified by the District Court and purportedly copied by Donnelly, as a matter of law, do not display the originality required to merit copyright protection (999 F.2d at 1444). SPA is now left to a Circuit-by-Circuit application of the copyright to its directories. Is the stricter application of the test for originality as espoused by the decision below to be followed in other Circuits? Or perhaps the view articulated by Judge (now Justice) Bader Ginsburg in *Atari Games Corp. v. Oman*, 979 F.2d 242, 247 (D.C. Cir. 1992) that "the vast majority of works make the [copyright] grade quite easily", and that nothing "beyond the 'minimal creative spark required by the Copyright Act and the Constitution'" will be required to protect a compilation.

SPA is faced with great uncertainty in undertaking the publication of a new classified directory in determining to what extent existing directories may be used as a resource for a new compilation. Similarly, may SPA protect its directories from copying by competitors who merely use a data processor to glean not only the factual data already available from the White Pages listings but also SPA's own selection, arrangement and coordination? And if so, in what jurisdictions do the different applications of the constitutional test of originality apply?

SPA believes that only resolution by this Court will resolve the conflict created by the decision below.

II. THE DECISION BELOW CONFLICTS WITH THIS COURT'S PRECEDENT IN *FEIST*

The decision of this Court in *Feist* was confined to the consideration of the copyrightability of telephone listings arranged in alphabetical order and expressly did not extend to the Yellow Pages portion of telephone directories. The *en banc* decision below improperly extended the holding in *Feist* to virtually eliminate copyright protection for classified telephone directories; that is, those Yellow Page directories which this Honorable Court expressly exempted from consideration.

Throughout her opinion in *Feist*, Justice O'Connor repeatedly and carefully restricted her analysis to the white pages portion of the Rural directory, which presents an alphabetical arrangement of listings (i.e., the name, address and telephone number). "In preparing its white pages, Rural simply takes the data provided by its subscribers and lists it alphabetically by surname. The end product is a garden-variety white pages directory, devoid of even the slightest trace of creativity." In so holding, this Court provided a bright line test to SPA and others which could be readily and easily applied. On the other hand, Justice O'Connor also pointed out that the white pages listings were not original to Rural "and therefore were not protected by the copyright in Rural's combined white and yellow pages directory." 111 S.Ct. at 1297.

Throughout the *Feist* opinion, Justice O'Connor emphasized that the threshold consideration for determining copyrightability in compilations is the statutory and constitutional requirement of originality. In the case

of compilations, "even a directory that contains absolutely no protectable written expression, only facts, meets the constitutional minimum for copyright protection if it features an original selection and arrangement." 111 S.Ct. at 1289. "These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws." *Id.*, 111 S.Ct. at 1289.

Notwithstanding a finding by the District Court setting forth in detail the elements which led to its finding that "BAPCO has created a unique directory due to its method of selecting, coordinating and arranging its material", the *en banc* decision below found that each of BAPCO's activities regarding selection, coordination and arrangement were unoriginal and "entirely typical" of the type of directory.

It is thus clear to SPA that the decision below interprets the requirement of a "minimal creative spark" quite differently from the holding in *Feist*. The unwarranted extension of *Feist* to Yellow Pages directories inevitably threatens the scope of protection available to all compilations. While the mere facts contained in those compilations have never been protectable, if the decision below is permitted to stand, few compilations (i.e., a work embodying an original selection, arrangement or coordination of those facts) will enjoy any protection from direct copying, as was admittedly the case in the controversy below.

Only by directly addressing the question presented by the Petitioner may this Court stem the unwarranted and unjustified extension of its holding in *Feist*.

III. THE DECISION BELOW CONFLICTS WITH THE DECISIONS IN OTHER CIRCUITS REGARDING THE CONSTITUTIONAL STANDARD OF ORIGINALITY

Since this Court's decision in *Feist*, the question of protectability of compilations has been addressed by at least four other Circuits. With the sole exception of the *en banc* decision below, the Circuits have found sufficient originality in the compilations presented to warrant copyright protection.

First, this Court should recognize that the panel decision below was cited favorably in the decision by Judge (now Justice) Bader Ginsburg in *Atari Games*, 979 F.2d at 245, and also by the Second Circuit in *Key Publications*, 945 F.2d at 515. Thus, the decision *en banc* reversing the panel decision and adopting a much stricter view of originality inherently conflicts with those decisions.

Moreover, the application of *Feist* by those other Circuits contrasts markedly with the *en banc* decision below. In *Atari Games*, the selection and arrangement of the graphic elements in individual screens and then selecting and arranging the sequence of those screens was not "mechanical," "garden-variety," "typical," "obvious," or so commonplace as to be "practically inevitable". In *Key Publications*, both the District Court and the decision of the panel on appeal agreed that the selection, coordination and arrangement of listings entailed the de minimis

thought needed to withstand the originality requirement. But the *en banc* decision below, notwithstanding a plethora of acts of selection, arrangement and coordination recited first by the District Court, then by the panel, and finally by the dissent, determined those acts to be unoriginal and practically inevitable, and thus wanting in originality.

Thus, the *en banc* decision below stands out as misapplying the tests for originality resulting in a far stricter test for copyrightability than warranted by *Feist*. Moreover, the holding stands in stark contrast to the recognition by other circuits that "the requisite level of creativity is extremely low; even a slight amount will suffice." *Los Angeles News Service v. Tullo*, 973 F.2d 791, 794-5 (9th Cir. 1992) (videotape); and also *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 142 (5th Cir. 1992) (maps), both quoting *Feist*, 111 S.Ct. at 1287 in finding sufficient originality to warrant copyright protection.

There is a distinct danger that the decision below will not only strip away the copyright protection for compilations in the Eleventh Circuit, but will be expanded to other Circuits which have not yet considered the application of *Feist*. Moreover, it is apparent that the decision below evinces a direct conflict with those Circuits which have already considered the application of *Feist* to copyrights. A full review of the decision below is necessary to enable SPA and others to conduct their business of creating compilations in a consistent manner throughout the United States.

CONCLUSION

For the foregoing reasons, a *writ of certiorari* should issue to review the *en banc* decision of the Eleventh Circuit Court of Appeals. The inevitable chaos created by conflicting interpretations of this Court's decision in *Feist* will be averted only by this Court's restoration of the proper statutory and constitutional determination of originality in compilations.

Respectfully submitted,

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On Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE* AND BRIEF *AMICUS CURIAE* OF UNITED STATES TELEPHONE ASSOCIATION IN SUPPORT OF PETITIONER

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On Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

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MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE* OF UNITED STATES TELEPHONE ASSOCIATION IN SUPPORT OF PETITIONER

United States Telephone Association ("USTA") hereby respectfully moves for leave to file the attached brief *amicus curiae* in this case. The consent of the attorney for petitioner, BellSouth Advertising & Publishing Corporation, has been obtained. The consent of the attorney for respondents, Donnelley Information Publishing, Inc., and The Reuben H. Donnelley Corporation, was requested but refused.

The interest of USTA in this case arises from the fact that most of its members are companies that, directly or through subsidiaries, publish and register with the Copyright Office telephone "yellow pages" directories. Yellow pages directories are important sources of income for these companies and help keep the costs of local telephone service down. The decision below calls into question the scope of copyright protection available for yellow pages advertising directories or directory sections. USTA believes that the attached brief will assist the Court in determining whether certiorari should be granted in this case.

Respectfully submitted,

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December 30, 1993

TABLE OF CONTENTS

	Page
INTEREST OF THE *AMICUS CURIAE*	1
SUMMARY OF ARGUMENT	2
ARGUMENT	3
CONCLUSION	6

TABLE OF AUTHORITIES

Cases: Page

Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991) 3

Harper & Row, Publishers, Inc. v. Nation Enterprises, 471 U.S. 539 (1985) 5

Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc., 945 F.2d 509 (2d Cir. 1991) 2, 3

Southwestern Bell Media, Inc. v. Trans Western Publishing, Inc., 670 F. Supp. 899 (D. Kan. 1987) 4

Statute:

47 U.S.C. § 151 5

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BRIEF OF *AMICUS CURIAE* UNITED STATES TELEPHONE ASSOCIATION IN SUPPORT OF PETITIONER

INTEREST OF THE *AMICUS CURIAE*

The United States Telephone Association ("USTA") is the principal trade association of local telephone companies in the United States. It was established in 1897. Local telephone companies, sometimes called exchange carriers, are the primary providers of local telecommunication services in most parts of the United States.

USTA's membership includes nearly 1100 of the nation's approximately 1350 local telephone companies. The membership is comprised of companies of varying sizes. Some of its members are large telephone companies

such as the seven Bell operating companies. The majority are small companies that provide fewer than 10,000 lines.

Most of USTA's members are companies that, directly or through subsidiaries, publish and register with the Copyright Office telephone "yellow pages" directories. Yellow pages directories are important sources of income for these companies and help keep the costs of local telephone service down. The decision below calls into question the scope of copyright protection available in such directories. USTA submits this brief to assist the Court in determining whether certiorari should be granted in this case.

SUMMARY OF ARGUMENT

The yellow pages are a vital public resource—providing useful consumer information and guidance to callers and a critical source of advertising for local businesses. They also provide significant revenues to local telephone companies, some or all of which may be used to help them to provide universal service at reasonable rates. The decision below destroys much of the economic incentive to create these directories. The creation of yellow pages is expensive and time-consuming. If yellow pages are denied the copyright protection they have enjoyed for years, the incentive to publish complete and accurate guides—customized to consumer preferences and expectations—would be eroded. The result would be a diminution in the quality of future directories. To assure the continued viability of this resource, the Court should grant certiorari and resolve the direct conflict between the decision of the court below and that of the Second Circuit in *Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991).

ARGUMENT

The court below held that yellow pages publishers are not entitled to copyright protection for their selection, coordination, and arrangement of business listings under the classified headings they choose for their directories. Petitioner has amply demonstrated that the decision below is contrary to this Court's decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), and in direct conflict with the decision of the Second Circuit in *Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991), and with the decisions of a number of other circuits applying *Feist* to other types of factual compilations. We will not repeat those points here. We write, instead, simply to stress the importance of this case to the yellow pages publishing industry (including USTA members) and to the public in general.

The yellow pages serve a number of important functions. The organization of listings under carrier-chosen headings enables callers to survey selected businesses providing the type of goods and services they are looking for in their immediate geographic area, and often in surrounding areas, without having to scan through the alphabetical "white pages" business listings and to guess, from the name of the business, what products and services are provided by the business. At the same time, the yellow pages provide a highly effective means for businesses to advertise. In fact, yellow pages have become one of the most significant and successful means for businesses to advertise their goods and services—especially for small businesses. Local advertisers represent about 88% of total yellow pages advertising.

When yellow pages are compiled, employees of the publisher typically make a number of discretionary determinations. First, they determine how expansive each directory will be, in terms of geographic scope, and how comprehensive the directory will be, in terms of the busi-

nesses that are listed. These initial decisions help determine how useful the directory will be, and they vary widely from one directory to the other. For example, C&P Telephone publishes a very comprehensive two-volume listing of businesses in the District of Columbia. It also publishes additional volumes covering suburban Maryland and Virginia. A competing publisher, by contrast, offers something called "The One Book," which is a highly selective listing of businesses throughout the Washington Metropolitan area. The One Book offers the convenience of a single, slender volume covering a wide area; C&P offers a more thorough (but more bulky) alternative.

The publishers also determine the general headings under which businesses are to be listed based on their perception of how consumers will use the book; here, too, substantial variation can be found. See generally *Southwestern Bell Media, Inc. v. Trans Western Publishing, Inc.*, 670 F. Supp. 899, 907 (D. Kan. 1987). And they determine, usually in consultation with the owners, what headings a particular business should be listed under and whether that business warrants listing in several geographic directories.

The collection, selection and arrangement of listings and advertisements for a yellow pages may not require the creativity of a Leonardo, but it does require a myriad of discretionary, editorial judgments. The result is an original work that displays sufficient creativity to warrant copyright protection.

The decision below, by denying such protection, destroys the economic incentive to create and consistently improve these directories. The creation of yellow pages is expensive and time-consuming. If the first compiler were unable to protect it under the Copyright Act from competitors who copied the guide, the first compiler would have little incentive to continue publication and improvement of a complete and accurate guide. The result would

be a diminution in the quality of the future yellow pages. As this Court has noted, " '[i]f every volume that was in the public interest could be pirated away by a competing publisher, . . . the public [soon] would have nothing worth reading.' " *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 559 (1985) (citation omitted).

The decision below has particularly harsh consequences for local telephone companies, which traditionally prepare yellow pages directories along with their provision of local telephone service. Yellow pages advertising revenue in the United States in 1992 exceeded $9.3 billion—roughly 10 percent of local telephone company revenues. In many cases, the revenue derived from yellow pages advertisements can be an important component of a local phone company's ability to provide universal service at affordable rates, the primary goal of national communications policy. 47 U.S.C. § 151. This is particularly true for the smaller, more rural telephone companies that comprise much of USTA's membership. Without copyright protection, local telephone companies will bear the costs associated with creating the directories and competitors will simply pirate them and then undercut advertising rates.

The decision below also threatens to handicap new innovations such as "electronic yellow pages." Yellow pages are just beginning to be offered in computer-accessible formats that permit quick searches and constant updates. These electronic directories, like their hard copy counterparts, will have unique headings and arrangements, along with such additional tools as menus and navigational aids. Such directories, in addition to providing a new public service, would represent an additional revenue source for the local telephone companies. Yet the information in computer databases is also easily pirated: respondent and similar companies would not even be put to the expense of manually copying information captured in electronic form. Uncertainty regarding the ownership

rights to such databases will accordingly inhibit their creation.

CONCLUSION

For the foregoing reasons and those stated in the petition itself, the petition for a writ of certiorari should be granted.

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(8)

Supreme Court, U.S.
FILED
JAN 6 1994
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12 pp

TABLE OF AUTHORITIES

Cases

Page

Atari Games Corp. v. *Oman*, 979 F.2d 242 (D.C. Cir. 1992) 3, 7

Key Publications, Inc. v. *Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991) 5, 7, 10

Tempo Music, Inc. v. *Famous Music Corp.*, 1993 U.S. Dist. LEXIS 17623 (S.D.N.Y. 1993) 5

Statutory Provisions

17 U.S.C. § 101 ..... 4, 5

17 U.S.C. § 103(a) 4

Other

46 Pat. Trademark & Copyright J. (BNA Sept. 16, 1993) 9

1 *Nimmer on Copyright* (1993) 8

Ira J. Blumberg, Feist *Is Expanded to Include Yellow Pages Copying*, 10 Computer Law Strategist (Oct. 1993) 10

Ralph Oman, *Reflections on the Changing Shape of Database Protection*, 40 Fed. Bar News & J. (1993) 8

IN THE

Supreme Court of the United States

OCTOBER TERM, 1993

No. 93-862

BELLSOUTH ADVERTISING
& PUBLISHING CORPORATION,
Petitioner,

v.

DONNELLEY INFORMATION PUBLISHING, INC. and
THE REUBEN H. DONNELLEY CORPORATION,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

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REPLY BRIEF FOR PETITIONER [1]

Respondent Donnelley Information Publishing, Inc. ("Donnelley") seeks to avoid certiorari by rewriting and downplaying the significance of a divided en banc decision recognized by the dissent, the classified directory industry, and the data compilation industry as a whole to be a ruling with dramatic nationwide impact.[2] Don-

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[1] Petitioner's Rule 29.1 statement appears at Pet. App. 115a.

[2] *See* Pet. App. 19a ("The majority's holding establishes a rule of law that transforms the multi-billion dollar classified publishing industry") (Hatchett, J., dissenting); Brief of Amici Curiae Ameritech Publishing, Inc., NYNEX Corporation, and Bell Atlantic Corporation in Support of Petitioner at 4, 11-13; Brief of Amicus Curiae United States Telephone Association in Support of Petitioner at 4-6; Brief Amicus Curiae of Sprint Publishing & Adver-

nelley's efforts simply confirm the need for this Court to grant the writ to resolve the conflict and confusion in the lower courts.

1. Donnelley's main effort to rewrite the decision below is its startling assertion that this case "presents no issue about copyrightability of yellow pages directories or any other type of fact compilation." Opp. at 12-13. Donnelley pins a great deal on this claim, repeating it no fewer than eight times (Opp. at 2, 8, 9, 10, 12-13, 20, 22, 25), and attempting to distinguish conflicting authority on this ground. *See, e.g.*, Opp. at 20, 22.

But Donnelley's assertion is simply a word game. Donnelley did concede copyrightability, but the whole issue is the extent of the protection conferred by the copyright. The Eleventh Circuit below held that BAPCO's copyright did not protect BAPCO's acts of selection, coordination, and arrangement in compiling its directory; the results of those acts of authorship were held to be not copyrightable.

Donnelley's concession that BAPCO has a valid copyright in other aspects of the yellow pages—the graphics or artwork, for example—in no way affects the key holding below that the compilation aspects of the work are not copyrightable. The holding is the same whether phrased in terms of BAPCO owning a copyright that does not protect the selection, coordination, and arrangement of its yellow pages (as Donnelley would prefer) or in terms of BAPCO's selection, coordination, and arrangement of its yellow pages not being copyrightable.[3]

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tising, Inc. in Support of Petitioner at 3; Brief of West Publishing Company as Amicus Curiae in Support of Petition for Writ of Certiorari at 3-4; Brief of Martindale-Hubbell, Inc. as Amicus Curiae in Support of Petitioner. The various briefs amicus curiae have been filed with motions for leave to file, necessitated by Donnelley's refusal to consent to their filing.

[3] Donnelley cannot even maintain its own word game throughout its Opposition. *See, e.g.*, Opp. at 14 ("the Eleventh Circuit held

That is why other courts have recognized that this case concerns the copyrightability of yellow pages directories. *See, e.g., Atari Games Corp.* v. *Oman*, 979 F.2d 242, 246 (D.C. Cir. 1992) (panel holding here *and* in *Key Publications* described as "yellow page telephone directory is copyrightable").

2. On the merits, Donnelley's position turns on two related propositions: (1) this case is like *Feist* because Donnelley copied only facts (Opp. at 13), and (2) BAPCO and the panel below erred in focusing on "whether BAPCO's directory as a whole was copyrightable." *Id.* at 8. The issue is fairly joined on both points.

a. The error of the en banc majority below, and the reason the decision is so problematic not only for the business directory industry but for the compilation industry generally, is precisely that the Eleventh Circuit agreed with Donnelley and regarded this case as just like *Feist*. It is not. *Feist* involved purely factual material—name, address, telephone number—selected and arranged in what this Court termed a practically inevitable manner involving no creativity. Individual names, addresses, and telephone numbers are not at issue here; BAPCO claims no copyright in such factual material. What is at issue—and what makes this case quite unlike *Feist*—are the results of BAPCO's creativity in selecting, coordinating, and arranging listings and headings in its directory.

It is not a "fact" that a business should be listed as a barber rather than or in addition to being listed as a hair stylist. It is not a "fact" that there should be four subheadings under "Appliances" rather than six, two, or none at all. It is not a "fact" that 1,772 selected businesses outside the area of the Miami directory should nonetheless be included in it. It is not a "fact" that those offering balloon bouquets should not be listed under

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that * * * constituent elements were unoriginal to BAPCO and therefore *uncopyrightable*") (emphasis added).

"Florists" as they want to be, or that a business using only residential telephone service should not be included at all.

These and the myriad other decisions about selection, coordination, and arrangement detailed in the Petition, *see* Pet. at 3-7, 17-21—none of which were involved in *Feist*—are what make BAPCO's directory protectible as a compilation. Donnelley did not simply copy facts—it copied the results of BAPCO's creativity. Perhaps the clearest example is the 1,772 businesses outside the Miami area selected for inclusion in the Miami directory by BAPCO. Because it simply copied BAPCO's directory, Donnelley also included those businesses in its database. There is no objective, factual reason for such inclusion; Donnelley simply copied BAPCO's selection. *See also* Pet. at 19 n.9 (Donnelley's claim that it copied only "facts" is refuted by its copying of erroneous listings).

b. The issue is also fairly joined on the question whether the directory should be considered "as a whole" in assessing compilation copyright protection. Donnelley, dismissing such an approach as a "*gestalt* theory," contends that the panel erred in focusing on "whether BAPCO's directory as a whole was copyrightable." Opp. at 8. Not to put too fine a point on it, that is *precisely* what the statute requires by its plain terms. Section 103(a) of the Copyright Act extends copyright protection to "compilations," and a "compilation" is defined in Section 101 as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work *as a whole* constitutes an original work of authorship." 17 U.S.C. § 101 (emphasis added).

The reason is clear: data compilations are compilations of facts. If a court did not consider the work "as a whole," it would always find that the individual elements are facts, and there would be no copyright protection for such compilations, contrary to the express directive of Congress. Consideration of the work "as a whole" neces-

sitates consideration of the manner in which the constituent facts are selected, coordinated, or arranged—and it is the selection, coordination, or arrangement that is protected, rather than the underlying facts. The point is a critical one to the future of compilation copyright protection. The fact that Donnelley can so boldly read the decision below as rejecting consideration of BAPCO's compilation "as a whole"—as mandated by the Copyright Act itself—confirms the need for this Court's review.

Not surprisingly, Donnelley's position is at odds with the law in the Second Circuit. While Donnelley criticizes BAPCO and the panel below for evaluating " 'the compilation as a whole,' " Opp. at 29 (quoting Pet. at 11), the Second Circuit in *Key Publications* emphasized that the pertinent inquiry was indeed "whether the arrangement of the * * * Directory, *viewed in the aggregate*, is original." 945 F.2d at 514 (emphasis added). And while Donnelley argues that the various "content-defining acts" engaged in by BAPCO in compiling its directory cannot give rise to copyright protection under *Feist*, the United States District Court for the Southern District of New York made precisely the opposite point just last month, ruling that "originality, for copyright purposes, looks to creative process rather than novel outcomes or results." *Tempo Music, Inc.* v. *Famous Music Corp.*, 1993 U.S. Dist. LEXIS 17623, at *19 (S.D.N.Y. 1993).

Donnelley's contention that BAPCO is seeking to copyright facts is a red herring. Donnelley is of course perfectly free to do whatever it wishes with the name, address, and telephone number of any business in BAPCO's directory, and perfectly free in compiling its own directory to designate a particular enterprise a bakery even if BAPCO has already done so. What BAPCO is entitled to is compilation copyright protection for its directory "as a whole," 17 U.S.C. § 101, and what Donnelley may not do is copy BAPCO's compilation—the results of BAPCO's selection, coordination, and arrangement of the

thousands upon thousands of pieces of information that are all readily available to Donnelley in raw form. Donnelley did not use that information to create its own directory but instead copied BAPCO's directory precisely because Donnelley wanted the benefit of BAPCO's selection, coordination, and arrangement, even though the uncompiled information available to Donnelley was far more current.

3. On the issue of the specific headings—only one of the several aspects of selection, coordination, and arrangement that went into compiling BAPCO's directory—Donnelley maintains that it is immune from liability because, while it "admitted" that it "copied the * * * type of business from every BAPCO listing," Pet. App. 18a n.23 (en banc majority), it did not use precisely the same designation in every instance. *See* Opp. at 5, 10. The disingenuous nature of Donnelley's claim is demonstrated by examination of the classification of the seven businesses identified on the sales lead sheets (stipulated to be representative of those Donnelley generated from BAPCO's directory) that were attached to the Eleventh Circuit's decision as Exhibit B and lodged with the Clerk here. Those seven businesses generated listings under 40 different headings in BAPCO's directory and under an identical number of headings in Donnelley's directory. Of the 40 headings in Donnelley's directory, 37 were *identical* in wording to BAPCO's headings, including such details as the "Etc." in the listing for "Water Companies —Bottled, Bulk, Etc." The only differences were one of the nine headings for Bliss Van Den Heuvel, which BAPCO titled "Gold Leaf" and Donnelley reproduced as "Gold Leaf Lettering," and two of the 18 different headings for Starr Enterprises, entitled "Air Conditioning Equipment—Room Units" and "Television & Radio Dealers" by BAPCO and "Air Conditioning—Room Units" and "Television Dealers—Retail" by Donnelley. These slight differences plainly do not insulate Donnelley from liability for its admitted copying. *See* Pet. at 18 n.8.

4. Donnelley's effort to minimize the conflict between the decision below and the Second Circuit's decision in *Key Publications, Inc.* v. *Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991), begins with its word game that there was no issue of copyrightability in the decision below, as discussed above. *See* Opp. at 22. Donnelley next tries to distinguish *Key Publications* on the ground that it involved a directory for the Chinese-American community. But the Second Circuit was quite clear that its holding did not turn on that fact. Judge Winter explained that the decision of the publisher to exclude certain businesses from the directory because of their questionable longevity—the very reason BAPCO excluded certain businesses from its directory, *see* Pet. at 4—"*alone* indicates thought and creativity in the selection of businesses included in the * * * Directory." 945 F.2d at 513 (emphasis added). And while Donnelley tries to distinguish *Key Publications* by arguing that the particular classifications at issue there were "significant[]," Opp. at 21, the Second Circuit expressly stated that "the individual categories chosen are irrelevant to our inquiry." 945 F.2d at 514.

The conflict between the court below and the Second Circuit is clear from a comparison of the opinions. *Compare, e.g., Key Publications*, 945 F.2d at 514 (fact that "[t]he format of the * * * Directory is common to most classified directories, and particular categories have, of course, been used in other classified directories" not impediments to copyright protection) *with* App. 9a-10a & n.13 (copyright protection denied because "BAPCO did not deviate from the arrangement of the typical business directory"). The conflict is also confirmed by how other courts and commentators have viewed the decisions. The D.C. Circuit recognized that the holding in *Key Publications* was that "yellow page telephone directory is copyrightable"—the same description it applied to the panel decision in this case, which was reversed by the en banc court. *Atari Games Corp.* v. *Oman*, 979 F.2d at 246.

And when the leading treatise on copyright law, *Nimmer on Copyright*, concluded that *Feist* "does not bar copyright protection for telephone book yellow pages," it relied on both the panel decision below and *Key Publications*. 1 *Nimmer on Copyright*, § 3.04[B] at 3-28–3-29 & n.53 (1993).

5. Donnelley's effort to portray the legal issue in this case as fact-specific is unavailing. Donnelley focuses on its particular method of copying BAPCO's directory, Opp. at 9, but the record confirms not only that Donnelley engaged in this method with respect to hundreds of other copyrighted directories, but also that the method is widely prevalent throughout the industry. *See* Affidavit of Gary R. Johnson, ¶ 11. By the same token, BAPCO's processes for compiling its directory are also typical throughout the industry, at least for those who do not copy the selection, coordination, and arrangement of others. *See* Brief of Amici Curiae Ameritech Publishing, Inc., NYNEX Corporation, and Bell Atlantic Corporation in Support of Petitioner, at 4-11 (describing industry-wide practice). The decision below was in no sense fact-specific, but instead "establish[ed] a rule of law" governing the entire classified publishing industry. Pet. App. 19a (Hatchett, J., dissenting). *See also* Pet. App. 15a (BAPCO's selection, coordination, and arrangement not entitled to copyright protection "as a matter of law").

Donnelley's contention that there is no confusion in the lower courts in the wake of *Feist* is readily refuted. The Register of Copyrights predicted that "*Feist* may generate new uncertainties around the application of the 1976 [Copyright] Act to databases," Ralph Oman, *Reflections on the Changing Shape of Database Protection*, 40 Fed. Bar News & J. 232, 234 (1993), and Donnelley does not even attempt to rebut BAPCO's lengthy list of commentators noting the inconsistent understandings of *Feist* in the lower courts. *See* Pet. at 27 n.15. In this case alone six of the appellate judges considering the issue after *Feist*

ruled one way, while three ruled the other way—hardly indicative of the easy and certain application of settled principles suggested by Donnelley.

Donnelley's effort to downplay the significance of the decision below is amply refuted at every turn. Donnelley itself had a very different view of the significance of this case below. Its counsel stipulated that the case involved a "question of exceptional importance in light of the increasing and vital importance of electronic means for information storage and retrieval," Statement of Counsel Pursuant to Eleventh Circuit Rule 35-6(c), at 1, and noted that "[c]orrect decision of [the issue presented] is of great importance, not only to the parties to this case but to a vast industry of publishers and database compilers whose businesses depend upon correct delineation of the delicate balance between free access to public domain information on the one hand and protection for original authorship on the other." *Id.* at 2. Donnelley further recognized that disagreement in the courts on the issues presented in this case "will create costly uncertainty and confusion in information-based industries that are increasingly central to the flow of commerce." Donnelley's Suggestion of Rehearing En Banc and Petition for Rehearing, at 7.

The amicus filings by Ameritech, NYNEX, Bell Atlantic, Sprint, and the United States Telephone Association confirm the significance of the case to the classified directory industry. By the same token, the amicus filings by West Publishing and Martindale-Hubbell confirm the broader significance of the decision below to the compilation industry generally. This significance is amplified by the fact that the compilation industry typically publishes nationwide, and is therefore particularly affected by disparate circuit rulings. In addition, although the decision is only a few months old, commentators have already noted its troubling impact.[4]

[4] *See, e.g.*, 46 Pat. Trademark & Copyright J. 421 (BNA Sept. 16, 1993) (Eleventh Circuit's "suggestion that the originality of

The divided en banc decision here is not the limited ruling Donnelley seeks to portray. The majority below ruled that this case was just like *Feist*, though it is not; that the court did not need to consider BAPCO's directory "as a whole," though the statute uses just those terms; and—despite Judge Hatchett's urgings—that it should not follow the Second Circuit's lead in *Key Publications*, which recognized that the compilation of a yellow pages directory "entailed the de minimis thought needed to withstand the originality requirement." *Key Publications*, 945 F.2d at 514.

CONCLUSION

For the foregoing reasons, and those in the Petition, this Court should grant the writ and reverse the decision below.

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BAPCO's business directory must be judged by comparison to other business directories raises the specter of a novelty standard for evaluating compilation copyrights"); Ira J. Blumberg, Feist *Is Expanded to Include Yellow Pages Copying*, 10 Computer Law Strategist (Oct. 1993), 1, 6 ("Apparently, any compilation that selects and organizes information in a fashion similar to other existing compilations will not merit copyright protection because it will lack originality.").